

O-438-17

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF:

**APPLICATIONS BY BLUE OCEAN TRADEMARKS NV (Nos 501072-4)
TO REVOKE ON THE GROUNDS OF NON-USE
THE FOLLOWING TRADE MARK REGISTRATIONS OWNED BY ALNAIR
LIMITED**

REGISTRATION 1583598 OF THE MARK:



**REGISTRATION 2029608 OF THE MARK:
BIG EASY REAL FRUIT MARGARITA BAR**


AND

**REGISTRATION 2384779 OF THE MARK:
BIG EASY THE ONLY BAR-B-Q WORTH COMING BACK FOR**

Background and pleadings

1. Alnair Limited (“the proprietor”) is the owner of all three trade mark registrations the subject of these proceedings. The marks were filed on 1 September 1994, 7 August 1995 & 17 February 2005 respectively, and they were respectively registered on 10 November 1995, 19 July 1996 & 12 May 2006. The marks and the services for which they are registered are as follows:



- i) 1583598 is for the mark  and is registered for “[r]estaurant services; all included in Class 42”¹.
- ii) 2029608 is for the mark **BIG EASY REAL FRUIT MARGARITA BAR** and is registered for “[r]estaurant and bar services” in class 43.
- iii) 2384779 is for the mark **BIG EASY THE ONLY BAR-B-Q WORTH COMING BACK FOR** and is registered for “[r]estaurant (operating)” in class 43.

2. Blue Ocean Trademarks NV (“the applicant”) seeks revocation of all three marks on the grounds of non-use. Beyond setting out its basic claims, including the periods in which it is claimed that there has been no use, there is nothing further of note in the applicant’s statement of case.

3. The proprietor filed counterstatements defending the three registrations. I note the following:

- i) 1583598 – It is claimed that the mark has been used in the UK since 1994. It is still used today but in a circular format rather than the rectangular format as registered – it is stated that they differ “only in very minor details”.

¹ At the time of filing of this mark, the Nice Classification system classified these services in class 42. Since then, Nice has re-classified them and they now fall in class 43 as per the other marks the subject of these proceedings. Even though the mark has not been re-classified, the nature of the services are the same as if they were classified in class 43, thus, nothing turns on this.

- ii) 2029608 – It is claimed that the mark has been used since 1993. Since 2013 the mark has been used “in a slightly different format but it is still in use to some extent”.
- iii) 2384779 – It is claimed that the mark has been used in all three periods of alleged non-use. The mark is not currently in use due to some re-branding that is ongoing, but the proprietor wishes to maintain the registration as there are plans to re-introduce it.

4. The cases were consolidated. Only the proprietor filed evidence. The applicant filed written submissions in reply. I then heard the case on 25 August 2017 at which the proprietor was represented by Ms Karen Hensman of Innovate IP and the proprietor by Ms Anne Wong of MW Trade Marks Limited.

The relevant periods

5. The periods of time in which non-use is alleged are the same in each case, namely, three distinct periods alleged under section 46(1)(b) of the Act, as follows:

- 26 August 2010 to 25 August 2015,
- 9 December 2010 to 8 December 2015, and
- 10 September 2010 to 9 September 2015.

Genuine use

Legislation and leading case-law

6. Section 46(1) of the Act reads:

“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.”

(5)

7. Section 100 is also relevant; it 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.”

8. 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 Bunderversammlung 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].”

9. In *Reber Holding GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-355/09, the General Court found that the sale of 40-60Kg per annum of specialist chocolate under a mark was insufficient to

constitute genuine use of a national trade mark, which was registered in Germany. On further appeal in Case C-141/13 P, the CJEU stated, at paragraph 32 of its judgment, that:

“not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question”.

10. The CJEU found that:

“the General Court conducted an overall assessment of that trade mark, taking into account the volume of sales of the goods protected by the trade mark, the nature and characteristics of those goods, the geographical coverage of the use of the trade mark, the advertising on the website of Paul Reber GmbH & Co. KG and the continuity of the trade mark’s use. It thus established a certain degree of interdependence between the factors capable of proving genuine use. The General Court therefore correctly applied the concept of ‘genuine use’ and did not err in law in its assessment of that use”.

11. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*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*” is, therefore, not genuine use.

The evidence

12. The proprietor’s evidence comes from Mr Paul Corrett, its founder and managing director. The first part of Mr Corrett’s evidence deals with the background to the operating of the BIG EASY restaurant. I note the following facts:

- The first BIG EASY restaurant was opened in Kings Road, Chelsea in 1991. A branch was opened in Covent Garden in 2014 and Canary Wharf in 2015.

There are plans² to open further restaurants in Brighton, Oxford, Bristol, Cardiff, Manchester, Edinburgh, Leeds, Glasgow, Liverpool and Newcastle.

- Sales figures for the BIG EASY restaurants have grown from just over £3 million in 2009/2010 to over £14 million in 2015/2016.
- The BIG EASY name has been mentioned in various press articles, as shown in Annex B of the evidence. The articles date from 2013 to 2016 and the publications include Esquire, Time Out, The Independent, Harpers Bazaar, GQ, The Telegraph, The Observer and Tattler.
- It is stated that BIG EASY has been continuously used at all of the restaurants since they opened. It is used as the main name of the restaurant and on all packaging, internal decoration and products.
- It is stated that the BIG EASY brand has been used continuously in social media and the number of followers has increased significantly (although no numbers are provided). It is stated that since 2013 there have been over 20k independent mentions of BIG EASY restaurants on Twitter alone.

13. The rest of Mr Corrett's evidence is broken down with reference to the use made of the three subject trade marks. I will break my summary down accordingly.

Evidence in respect of registration 1583598

14. The registered mark is set out below, with Mr Corrett explaining that it was filed in September 1994 "in black and white as was the standard practice at the time of application":

² Annex A of the evidence contains a business plan from March 2015 which makes reference to this planned expansion.



15. It should be noted that the representation of the mark as it currently stands on IPO electronic database is not the best in terms of clarity. The representation above is a scan of the mark held on the official paper file of the registration, specifically the image provided by the applicant for the purposes of publication in the trade marks journal. Irrespective of how the scan has come out above, I confirm that the decisions I make are based upon the mark as it was filed and provided by the applicant. I also note that the words “AMERICAN BAR-B-Q” and “SOUTH” have been disclaimed from the mark meaning that the applicant has no exclusive rights in those words. The disclaimers were added at the request of the trade mark examiner.

16. Mr Corrett states that the mark was used in the above format between 1991 and 2007 [before any of the relevant periods]. He refers to Annex C of his evidence which provides some examples of the mark in use in 1993, as follows:

- i) A letter on headed paper sent by Mr Corrett to an executive chef he was to employ which shows the mark exactly as registered (albeit the background is red as opposed to black).
- ii) A business card which depicts the mark as registered (again in red) save that the words “Put a lil South in yo’ mouth” are absent.
- iii) Another business card with the same words absent; additionally absent are the words AMERICAN BAR-B-Q & CRABSHACK from the scroll.
- iv) An item of blank letter headed paper showing the mark as registered (again in red).

- v) An item of staff uniform showing a virtually identical graphic element albeit the words “Put a lil South in yo’ mouth” have been replaced with the word LONDON and the words in the scroll do not include the word AMERICAN.

17. Mr Corrett states that since 2007 the mark has been used in a different format, as follows:



18. Mr Corrett states that it has the same dominant words (BIG EASY), the words BAR.B.Q & CRABSHACK, in the same font and style, the same star element and the same colour. He does not believe that the differences alter the distinctive character of the mark from the form in which it was registered. Annex D of his evidence is then put forward as showing examples of this variant mark in use, as follows:

- Two prints taken from the video sharing website YouTube. Alongside the words BIG EASY LONDON is a logo which appears to be made up of a circular element and a scroll. I say “appears” because it is very small and it is difficult to make out any words. It also appears that the top half of the circle has a contrasting colour to the red in the bottom half. Both videos were posted in 2014 and had 49k and 175k views respectively.
- What is described as a table card promoting the future opening of the Covent Garden branch of the BIG EASY restaurant. The card is said to have been used in the Kings Road restaurant in October 2013. The variant mark is depicted at the top of the card.

- What is described as an advertisement (where it was placed is not stated) said to be from January 2014. It contains the variant mark as above, albeit the word CRABSHACK in the scroll reads LOBSTERSHACK.
- A gift voucher for the restaurant said to date from September 2014 showing the variant mark.
- A photograph said to have been taken in November 2015 showing an advertisement (apparently it was 2 metres high) placed in the Canary Wharf shopping centre. Again, it is very small, but it does appear to show the variant mark. It is added that 1000 flyers were also handed out, although the flyer itself is not provided.
- An undated photograph of a beer pump showing the variant mark.
- Another advertisement, this one said to date from March 2015, which depicts the variant mark at the bottom. I note that the scroll is not in the contrast black colour as per the variant mark but is, instead, in a red colour similar to the rest of the background.
- Two examples of use on takeaway packaging, albeit the colours are reversed out, the packaging itself being red/pink.
- An article from the Caterer magazine (a trade publication) dated 7 October 2015 about the opening of the Canary Wharf branch of the restaurant. The article depicts the variant logo although, again, the scroll is not in contrast black. I additionally note that below the scroll are the words “Put a lil South in yo’ mouth”, albeit the words are quite faint as follows:



- A copy of the “Canary Wharf rum library” (a rum menu used in the Canary Wharf branch) with the variant mark on its reverse. This document is not dated. According to the article in the Caterer, this branch was set to open in November 2015.

Evidence in respect of registration 2029608

19. The mark as registered consists of the words **BIG EASY REAL FRUIT MARGARITA BAR**. The primary claim to use of this mark is made on the basis of the use of the words REAL FRUIT MARGARITA BAR (or more accurately combinations of the words in that phrase) in association with the words BIG EASY, as opposed to use of the words running through as per the mark as registered. Reference is made by Mr Corrett to the following evidence in Annex E:

- A photograph of the Kings Road restaurant in the window of which appears to be the words MARGARITA BAR in the form of a neon sign. The words BIG EASY appear as the main sign on a panel above the restaurant’s windows. It is claimed that the sign has been there for 20 years.
- What is said to be a table card from 2013, showing the variant mark as per the Caterer article (including the words “Put a lil South in yo’ mouth”, although this time it is much clearer). The card also makes reference to the restaurant “featuring our one of a kind fresh fruit margarita bar..”.
- Drinks price lists from 2009 and 2013 which include the text FRESH FRUIT MARGARITA and REAL FRUIT FROZEN MARGARITAS on BIG EASY menus (although I note that BIG EASY appears only at the bottom of the menus as part of a web address). Mr Corrett considers the use in association with BIG EASY and the sign MARGARITA BAR to support the registration.

20. The only other evidence comes in the form of a very short witness statement from Ms Karen Hensman, the proprietor’s trade mark attorney. She states that she went to the BIG EASY restaurant in Kings Road on 5 November 2011 for a client meeting. She states that at the time of her visit the BIG EASY REAL FRUIT MARGARITA BAR

signage was in place behind the frozen cocktail bar. She provides a photograph of the frozen cocktail bar behind and above which, she says, the signage was used. The signage cannot be seen in the photograph provided.

Evidence in respect of registration 2384779

21. The mark as registered consists of the words **BIG EASY THE ONLY BAR-B-Q WORTH COMING BACK FOR**. The primary claim to use rests, again, on a form of associated use with the BIG EASY name. The evidence in support of this mark consists of three menus from August 2013, August 2014 (dates at the bottom of the print support this) and New Year's Eve said to be of 2014/2015, but the date at the bottom reads December 2012. On all three menus there is a section headed "REAL HOME-SMOKED BAR-B-Q", below which are the words "Slow smoked over hickory wood and served with BAR-B-Q beans & coleslaw", below which, again, are the words "The Only Bar-B-Q worth coming back to". The menu does not prominently feature the words BIG EASY (or at least the provided page does not), although some of the other food items do. For example, one of the items in the menu section reads "Big Easy" Bar-B-Q Smoked Baby Back Ribs" and there is also a Twitter address in the bottom right hand corner (in very small script) reading www.twitter/bigeasytweet.

The applicant's submissions

22. For completeness, I highlight again that the applicant filed submissions in response to the proprietor's evidence. Briefly summarised, the main points are that:

- In relation to registration 1583598, the variant mark alters the distinctive character of the mark as registered. The various differences between the marks are highlighted, but most weight is placed on the absence of the words "Put a lil south in yo' mouth" and the different figurative compositions. It is highlighted that the absent words were not disclaimed (only the word SOUTH was) which demonstrates that the proprietor felt that this was a significant feature.

- In relation to registration 2029698, it is submitted that the use relied on is use of various descriptions, not trade mark use, none of which comprise the mark as registered. In relation to Ms Hensman's evidence, it is highlighted that it is not dated and that incorrect annex naming has been used. It is submitted that her statement is extremely vague and falls a long way short of being evidence of use.
- In relation to registration 2384779, it is submitted that the absence of BIG EASY (a significant part of the mark) from the use made means that such use is not an acceptable variant.



Decision in relation to registration 1583598 -

Can the variant forms of use of the mark be relied upon?

23. Before deciding whether there has been genuine use, I must first determine if there has been any actual use in the relevant period upon which the proprietor can rely. I say this because it is accepted by the proprietor that there has been no use of the mark in the form in which it is registered since at least 2007. Indeed, the only examples of use come from an even earlier date.

24. There has, however, been use of an updated version(s) of the mark. The question that, therefore, arises is whether the updated version(s) can be relied upon by the proprietor under section 46(1)(2) of the Act which, essentially, allows a proprietor to rely on 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”. In terms of understanding how to apply this test, it is useful to note the decision of Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person in *Nirvana Trade Mark*, BL O/262/06, where he summarised the test as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

25. Although *Nirvana* was decided prior to the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains good law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered.

26. I set out below the mark as registered and the main variant form of use:



27. Having identified the marks as registered/used, the first part of the second question in *Nirvana* is to consider "what is the distinctive character of the registered trade mark". Ms Wong highlighted a number of features of the mark as registered which she felt were important: the words BIG EASY, the star, the scroll (and the 3-d feel it creates) together with the writing contained within, the strapline "Put a Lil South

in Yo' Mouth" and the flag-like feel of the mark. Ms Hensman focused more on the dominant words BIG EASY and its basic stylisation (a star and scroll); in terms of the strapline she felt that it was not a dominant or distinctive³ element of the mark.

28. In terms of the distinctive character of the registered mark, I accept that the words BIG EASY are its dominant and distinctive feature. However, this is not, in my view, the only thing that contributes to the distinctive character of the mark. The overall get-up, but most notably the star and the scroll also contribute, although, I stress that this is to a much lesser degree than the words BIG EASY. The words in the scroll, AMERICAN BAR-B-Q & CRABSHACK, do not contribute to the distinctive character of the mark as they are not only subordinate, but they will also just be perceived as a description of the services provided. Whilst I understand what Ms Wong means when she referred to the 3-d feel of the scroll, I doubt that this is something the average consumer would regard as a distinctive feature of the mark, nor do I think the average consumer would see a flag-like appearance either, it is just a plain rectangular border.

29. That then leaves the strapline. Ms Wong highlighted two matters which she submitted showed that the proprietor itself regarded the strapline as distinctive: i) the fact that when it entered a disclaimer, it did so only in relation to the word SOUTH (not the whole strapline) and, ii) that the proprietor actually registered the strapline alone (no. 1512749, filed in 1992 and registered in 1993) again with a disclaimer of the word SOUTH; the mark expired in 2009.

30. I accept that the registration of the strapline alone is indicative that the proprietor considered it to be distinctive. The disclaimer of the word SOUTH is less indicative as this was simply something that was agreed upon during examination. However, even accepting, as I do, that there is some (although I would say quite limited) inherent capacity to distinguish in the words alone⁴, the question before the tribunal relates to

³ In relation to distinctiveness, Ms Hensman relied on Practice Direction 1/06 and the case *Das Prinzip Der Bequemlichkeit* C-64/02P and the included adage that "...average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans".

⁴ I bear in mind the judgment in *Audi AG v OHIM*, Case C-398/08 P, where the CJEU held that slogans can be distinctive if they are not descriptive and their capacity to identify trade origin is discernible, even if secondary to a promotional function.

the distinctive character of the mark the subject of these proceedings. Ms Hensman stressed that the strapline was not a dominant part of the mark. Of course, it is not necessary for an element of a mark to be the dominant element for it contribute to its distinctive character. However, in this case the words are not only limited in inherent distinctive character, but, more importantly, they are, in my view barely discernable even upon close inspection. They are small and they are faint; they are used in a script which does not lend itself to easy reading. The contrast between the shading of the words and the shading of the background further diminishes the capacity to contribute to the distinctive character of the mark. Taken together, all these factors indicate to me that the strapline will not register/nor has any real capacity to register in the mind of the average consumer and I come to the view that it ought not to be regarded as an element which contributes to the distinctive character of the mark as registered.

31. The next step is to enquire “what are the differences between the mark used and the registered trade mark”. As far as I can see, the differences are:

- i) The words/scroll/star are presented within/on a circular as opposed to a rectangular shape.
- ii) The words BIG EASY, although still having the same dominance and position at the top of the mark, have a curved (as opposed to squared) orientation to match the circle; the font is also slightly different.
- iii) The scroll is in a similar (albeit slightly lower) overall position but has a slightly different, flatter feel.
- iv) The words within the scroll read BAR-B-Q & CRABSHACK as opposed to AMERICAN BAR-B-Q & CRABSHACK.
- v) The strap-line “Put a lil South in Yo’ Mouth” is missing.
- vi) The mark is used in a red colour scheme, whereas it is registered in black and white.

32. That then leaves the question as to whether the “differences identified in (b) [the second question] alter the distinctive character identified in (a) [the first question, regarding the mark as registered]. I come to the view the presentational differences resulting from the change from a rectangular shape to a circular shape do not alter the distinctive character. I come to the same view in relation to the curved orientation of the words BIG EASY and its slight change in font and the shape (and position) of the scroll. These are all pretty minor adaptations which do not alter the distinctive character of the mark as registered (and as I assessed earlier). The same applies to the absence of the word AMERICAN from the words within the scroll – the distinctive character is not altered by the removal of this non-distinctive word.

33. I next consider the issue of colour. In relation to this, Ms Wong referred me to the Common Communication (“CC”) of the Trade Mark Offices of the EU regarding the scope of protection of black and white marks. In relation to use the CC states that:

“For the purposes of **USE**, a change only in colour **does not alter the distinctive character of the trade mark** as long as:

- The **word/figurative elements coincide** and are the **main distinctive elements**.
- The **contrast of shades is respected**.
- Colour or combination of colours does **not have distinctive character in itself**.
- Colour is **not one of the main contributors to the overall distinctiveness** of the mark.

This goes in line with the MAD case (Judgment of 24/05/2012, T-152/11, ‘MAD’, paras. 41, 45), where the Court considers that use of a mark in a different form is acceptable, as long as the arrangement of the verbal/figurative elements stays the same, the word/figurative elements coincide, are the main distinctive elements and the contrast of shades is respected.”

34. I note that the authors of Kerly's Law of Trade Marks and Trade Names (15th Ed.) are critical of this CC. The relevant part of Kerly's states:

"Marks registered in black and white but used in colour

S8-082a - Marks registered in black and white but used in colour Following the CJEU ruling in *Specsavers v Asda* (C252/12), OHIM announced a new **common** practice for trade marks registered in black and white (**Common Communication** on the **Common** Practice of the Scope of Protection of Black and White Marks, April 15, 2014). This **common** practice has been adopted by the IP offices of all Member States except for Italy, France and Finland (which did not participate) and Sweden, Denmark and Norway, which opted out). This **common** practice is said to affect issues of priority, relative grounds and genuine use, but not, apparently use for the purposes of acquired distinctiveness. So far as the UK is concerned, it is said only to apply to marks applied for after the implementation date namely July 15, 2014 and to proceedings filed after that date. Previously, marks registered in black and white were treated as registered for all colours. Under the new practice, such marks will now be treated much more literally as registered in the black and white form shown. It is questionable whether this new practice is consistent with the CJEU ruling in *Specsavers*. It is also questionable as to whether the CJEU ruling required a change in practice at all. As far as we can see, this **common** practice will just create an unnecessary mess. We also question whether it is legitimate because many black and white marks were applied for and maintained for many years on the basis of the long-standing understanding that black and white marks covered all colours.

S8-082b

This statement of practice does not bind tribunals and courts, which is just as well because it may well produce incorrect results (cf. the facts in *Specsavers*, where the overlapping ovals were used in green). This new practice means that owners of new marks can no longer depend on black and white registrations covering uses in colour, or that their use in colour will constitute genuine use of a new registration in black and white. Thus the prudent course now will be to

register marks in colour and in black and white, and to ensure use in both forms.”

35. As the UK is a party to the CC it is necessary to take it into account and apply it in a way that is consistent with the case-law. Ms Wong accepted it was not binding but was useful as a guide. The CC seems to deal primarily with whether the use of essentially the same mark, albeit used in colour as opposed to black and white, represents use of the registered mark. However, what I am considering here is a variant mark question which must be considered on its merits. I come to the view that the inclusion of the red colour scheme in the mark as used does not alter the distinctive character of the mark as registered as that colour scheme does not have distinctive character in and of itself and is not a major contributor to the overall distinctiveness of the mark.

36. The final difference in the form as used is the absence of the strapline. I have already found that the strapline, for various reasons, does not contribute to the distinctive character of the registered mark. It follows from this, and is a logical conclusion, that its absence from the mark as used does not alter the distinctive character of the mark as registered. The variant form of use may be relied upon. This finding also applies to the variant forms of use where the scroll is not depicted in a contrasting colour or where there are other, very small, presentational/wording differences (including the change from CRABSHACK to LOBSTERSHACK, in one of the examples).

37. There is also one other form of use to consider, which I set out below.



38. The findings I have already made mean that this variant form may similarly be relied upon for the reasons already given. The only real difference in the assessment

is that the strapline is present in this form of use (albeit split onto two lines) so, in fact, there is one less difference. Indeed, even if I am wrong to have regarded the first variant mark as an acceptable variant, I would still consider this mark to be an acceptable variant because the main differences certainly do not alter the distinctive character as registered. This variant form of use may also be relied upon.

Has there been genuine use in the relevant periods?

39. Ms Wong was critical of the proprietor's evidence. In connection with her criticisms reference was made in her skeleton argument to the decision of Mr Daniel Alexander QC (sitting as the Appointed Person) in *PLYMOUTH LIFE CENTRE* (BL O-236-13), when in paragraph 22 he stated:

“.....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.”

40. I take account of the caution expressed by Mr Alexander, but nevertheless must consider the evidence that has been filed and consider whether genuine use is established. Specific criticisms made were on the basis of the lack of clarity of certain marks in use, that, in fact, there were further variations of the variant mark, that some of the exhibits had no independently verifiable dates, that the turnover figures relate to the business as a whole and is not, therefore, broken down with reference to the marks at issue here.

41. In relation to any slight differences in the variant marks used, I have touched on this earlier. To the extent that there may be some examples of the variant mark which do not match exactly the one set out in the proprietor's witness statement, the further differences are extremely minor and make no material difference. They are all capable of being relied upon. The criticism about the sales figures relating to the business as a whole is, in my view, unjustified. As Ms Hensman submitted, the figures set out demonstrate the scale of the business as whole, figures which are far from insignificant. Further, it seems reasonably clear from the evidence that the updated logo is a key component of the business and how the proprietor presents itself to the public, and that this was the case during the relevant periods. Although not all of the exhibits have an independent mechanism to verify the dates, the witness has confirmed these dates and I see no reason to disbelieve his evidence. Whilst the clarity of some of the prints is not great, they are clear enough to show the variant mark and the evidence as a whole provides corroboration of this. I come to the view that genuine use has been established. The mark is registered for restaurant services. This is what the proprietor clearly provides. Even taking into account the guidance set out in the case-law⁵ regarding fair specifications, I consider that "restaurant services" is a fair specification to reflect such use. Accordingly, the revocation claim fails in its entirety.

42. I should add that even if I am wrong to have concluded that the first variant form of use is an acceptable variant and that the proprietor should only have been able to rely on the second variant, I would come to the same conclusion. The table card showing the second variant mark was used at some point in 2013, so in all three periods of alleged non-use. Whilst I accept that such use may not have been long-standing, it is clearly not sham use for the purpose of simply preserving the rights in the mark and is the sort of use aimed at creating/preserving an outlet for the services. The use is aimed at promoting a new branch of the restaurant in one of its existing branches. Whilst I accept that not all commercial use is genuine use, I consider in this case that the test is met. I should add that the use in the Caterer magazine does not assist because it only relates to use in one of the periods and is, as Ms Wong submitted, extremely unclear.

⁵ See, for example, *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch),

Decision in relation to registration 2029608 – BIG EASY REAL FRUIT MARGARITA BAR

43. The proprietor's position is that this registration has been used on account of the use of signs such as MARGARITA BAR/ FRESH FRUIT MARGARITA/REAL FRUIT FROZEN MARGARITAS in conjunction with the words BIG EASY. Beyond what I come on to say below about Ms Hensman's evidence, it was accepted at the hearing that none of the evidence showed the registered trade mark being used as a whole. The conjunctive use argument was put on the basis of the secondary element of the mark, REAL FRUIT MARGARITA BAR (or more accurately variants of those words) having been used on BIG EASY menus or in the BIG EASY restaurant itself. There was no suggestion that the proprietor could rely on use without the secondary part of the mark having been used. Such an approach must be correct because regardless of how distinctive the secondary part of the mark may be, it still forms part of the mark as a whole creating a particular identity.

44. Whilst the case-law countenances the possibility of the use of marks in a jointly affixed manner, that is in circumstances where the registered mark is one element of a mark used along with another element, or as part of a larger composite mark. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its

independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)"

45. However, the case put to me is not on a par with the above circumstances. In fact, it is almost the reverse scenario because the claimed use relates to a separation of the two components as registered BIG EASY and REAL FRUIT MARGARITA BAR. The argument put forward is that the association between the use of the two components is sufficient. I do not consider that this is so. The mark is the mark. In the absence of use of the mark as a whole, or at the very least a form of use which demonstrates something akin to joint-affixing of the two components (which could at least be argued to be a variant of the mark as a whole if there was a degree of

separation), genuine use of the registered mark has not been established. The position is not helped by the fact that no use of the words REAL FRUIT MARGARITA BAR has ever been made.

46. I noted above Ms Hensman's evidence. She attests to seeing a sign BIG EASY REAL FRUIT MARGARITA BAR when she made a client visit to the proprietor on 5 November 2011. However, I agree with Ms Wong that little can be taken from this. Whilst Ms Hensman may have seen something, without providing any form of evidence showing the tribunal what she saw, and its exact form of use, particularly in circumstances where the proprietor's main witness can provide nothing, is not something which ought to be relied upon alone. The grounds for revocation succeed.

Decision in relation to registration 2384779 - BIG EASY THE ONLY BAR-B-Q WORTH COMING BACK FOR

47. The proprietor suffers from the exact same problem as per the previous mark. There is no use of the whole mark as whole. There is no use of **BIG EASY** in close enough proximity to **THE ONLY BAR-B-Q WORTH COMING BACK FOR** to be considered as a form of joint-affixing that would save the registration. I need say no more than this. The grounds for revocation succeed

Conclusion

48. The following conclusions apply:

- i) Registration 1583598 may remain registered.
- ii) Registration 2029608 is revoked with effect from 26 August 2015.
- iii) Registration 2384779 is revoked with effect from 26 August 2015.

Costs

49. The applicant has been successful in two of its three applications. It is entitled to a contribution towards its costs, albeit a reduced one given that it failed in relation to the third application, the proprietor being successful in that. My assessment is set out below:

Official fees x 2 (for revocation) - £400

Preparing statements of case -£300

Considering evidence and filing reply submissions - £500

Preparation for and attending the hearing - £300

Total - £1500

50. I order Alnair Limited to pay Blue Ocean Trademarks NV the sum of £1500 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of September 2017

Oliver Morris
For the Registrar,
The Comptroller-General