

o/077/18

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 2276121

IN THE NAME OF AGAINST THE GRAIN LTD

FOR THE FOLLOWING TRADE MARK:



IN CLASS 30

AND

AN APPLICATION FOR REVOCATION

UNDER NO. 501642 BY AGAINST THE GRAIN GOURMET FOODS, LLC

Background and pleadings

1. The trade mark shown below (registration number 2276121) stands registered in the name of Against the Grain Ltd (“the proprietor”):



The application was filed on 25 July 2001 and was published for opposition purposes on 10 October 2001. The registration procedure was completed on 25 January 2002 and the mark stands registered for the following goods:

Class 30 Cakes; biscuits; cookies; bread; pastry; baked products; baker's confectionery.

2. Revocation of the mark in full is sought by Against the Grain Gourmet Foods, LLC (“the applicant”) on the grounds of non-use. Under section 46(1)(a) of the Trade Marks Act 1994 (“the Act”), the applicant claims non-use in the five-year period following the date on which the mark was registered, i.e. 26 January 2002 to 25 January 2007, and seeks an effective revocation date of 26 January 2007. It also alleges, under section 46(1)(b), non-use in three separate periods: between 20 January 2008 and 19 January 2013, seeking an effective revocation date of 20 January 2013; between 24 January 2008 and 23 January 2013, seeking an effective revocation date of 24 January 2013; and between 20 April 2012 and 19 April 2017, seeking an effective revocation date of 20 April 2017.

3. The proprietor filed a counterstatement defending its registration for some of the goods in the specification, namely “biscuits, cookies, baked products, baker's confectionery”. The defence is based on a claim that “the registered trade mark has

been put to genuine commercial use within all of the periods identified by the applicant for revocation”. No claim is made in the counterstatement to there being any proper reasons for non-use.

4. Both parties have been professionally represented throughout, the proprietor by TLT LLP and the applicant by Appleyard Lees IP LLP. Only the proprietor filed evidence. The applicant did, however, file written submissions during the evidence rounds. Neither side asked to be heard but both parties filed written submissions in lieu. This decision is made following a careful reading of all of the papers. I do not intend to recount the parties’ submissions here but will refer to them as appropriate later in this decision. The evidence is summarised to the extent I consider necessary.

The evidence

5. This consists of two witness statements filed on behalf of the proprietor. The bulk of the evidence is provided by the proprietor’s managing director and founder, Lisa Worthington-Larsson. There is an additional witness statement provided by Elizabeth Lowe, a trade mark attorney at TLT LLP.

6. Ms Worthington-Larsson states that the proprietor has “marketed and sold bakery products in the UK” since 2004.¹ She provides sales figures as follows:

Year	Annual sales
2004	£3,309
2005	£45,136
2006	£71,172
2007	£107,245
2008	£101,308
2009	£111,151

¹ §2.

2010	£125,855
2011	£56,732 [said to represent a 5-month period, due to a change in accounting periods]
2012	£130,093
2013	£176,618
2014	£181,410
2015	£203,910
2016	£206,372

7. Over eighty invoices are provided at exhibit LWL1, which Ms Worthington-Larsson describes as “samples of sales invoices”.² They are all from Island Bakery Organics Limited, a company said by to be the licensed manufacturer and distributor for the proprietor.³ The recipients have addresses throughout the UK. With one exception (p. 30), all of the invoices include references to goods identified as “Against the Grain” or as “ATG”. Ms Worthington-Larsson indicates that “ATG” is an abbreviation of “Against the Grain”.⁴ The goods themselves include products such as “Almond Cookies”, “Ginger Crunches” and “Chocolate Orange Cookies”.⁵ The invoices are dated between February 2005 and April 2017, although the majority have dates after May 2012. The sums involved vary. Some of the invoices show figures as low as £33 for goods sold under the mark.⁶ However, the majority of the invoices shows sums of several hundred pounds for goods identified by the words “Against the Grain” or the abbreviation “ATG”, and some record figures in excess of £1,000.⁷

8. Ms Worthington-Larsson provides annual promotional and marketing figures for the period 2005-2014.⁸ She explains that the figures for 2015-2017 were not readily

² §4.

³ §1.

⁴ §4.

⁵ See, for example, p. 39.

⁶ For example, p. 18.

⁷ Examples of the former can be seen at pp. 32, 35, 41, and the latter at 47, 65, 70, 71, 76.

⁸ §9.

available because of a change in promotional and marketing practice, though she does not explain what that change entailed. The figures range from a low of £725 in 2005 to £8,991 in 2014.

9. Exhibit LWL2 consists of images from 19 magazines and catalogues where the proprietor's goods are advertised or mentioned. They are dated between December 2004 and December 2011. Some are specialist or local magazines (e.g. *Fine Food Digest* (pp. 103-104), *Cotswold Fayre* (pp. 111-112)) but there are also articles from national publications, including *You* magazine (pp. 117-118), *Woman & Home* (pp. 127-128) and *Country Living* (pp. 131-132) as well as three examples from the *Telegraph* (pp. 113-114, 119-121, 125-126). The name "Against the Grain" is used to describe the goods, all of which are biscuits/cookies. Where there is an image of the product, the form of the mark and its presentation on the packaging appear to be consistent throughout, though not all of the images are particularly clear. An image of the mark is reproduced below:⁹



10. Exhibit LWL3 consists of wholesale price lists and catalogues from five companies. Whilst there are no further details about the companies (such as their location) and not all of the prices are clearly in sterling, I note that all of the companies appear to be named on the invoices at LWL1, with delivery addresses in the UK. The price lists are dated between September 2013 and June 2017. All list biscuits/cookies under the name "AGAINST THE GRAIN", whilst the price lists from a company called Hider also feature images of the proprietor's packaging, as well as the mark shown at paragraph 9, above.

11. Exhibit LWL4 consists of archive web prints from sites which appear to be operating in the UK (goods are shown priced in sterling and telephone numbers are consistent

⁹ This image is taken from the proprietor's submissions, as it gives a clearer reproduction than the images in the evidence itself. However, there appears to be no material difference between the various images. See, for example, pp. 104, 108, 116, 121.

with UK number formats). The goods are identified as biscuits. The words “Against the Grain” are visible throughout. A number of the sites include images of the packaging. The images are not particularly clear but the use of the mark appears to be consistent with that shown elsewhere in the evidence. The dates range from 7 September 2011 to 21 March 2017.

12. Exhibit LWL5 consists of four show catalogues for events at which Ms Worthington-Larsson states that the proprietor has exhibited. They are dated between March 2006 and June 2013. The trade mark itself is not visible, though the proprietor is mentioned by name.

13. Exhibit LWL6 consists of letters addressed to “to whom it may concern” which appear to have been solicited for these proceedings. They are hearsay and will be treated accordingly (Tribunal Practice Notice (“TPN”) 5/2009 refers).

14. The remaining witness statement in the proprietor’s evidence is that of Ms Lowe. She provides an image, as the single exhibit to her statement, of “packaging used for products sold under the trade mark AGAINST THE GRAIN”.¹⁰ She does not specify whether this has been the same mark used throughout the relevant periods. The mark is as follows (the reproduction is not very clear but it appears to be identical to the mark at paragraph 9, above. The words underneath “AGAINST THE GRAIN” read “WHEAT DAIRY & GLUTEN FREE”):



15. That concludes my summary of the evidence, insofar as I consider it necessary.

¹⁰ §4.

Decision

16. Section 46(1) of the Act states that:

“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) An application for revocation may be made by any person, and may be made 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”.

17. Section 100 is also relevant, which 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”.

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

“217. *The law with respect to genuine use.* 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 Laboratoires 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. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

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]”.

19. 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 not, therefore, genuine use.

20. Given the proviso at s. 46(3) of the Act, if the proprietor can establish genuine use in the most recent period (i.e. 20 April 2012-19 April 2017), the registration will not be revoked. I will, therefore, concentrate initially on that period and will return to consider the earlier periods only if necessary.

21. The applicant’s criticisms of the proprietor’s evidence focus on the form in which the mark has been used, a matter to which I will return shortly. However, it also complains that the invoices at LWL1 are in the name of Island Bakery Organics Ltd and, as regards the explanation provided by Ms Worthington-Larsson, states that:

“We have seen no evidence in these proceedings before the UKIPO, by way of licence agreement of any other relevant documentation, that Island Bakery Organics is in fact the licenced [sic] manufacturer and distributor for the Registered Proprietor. It is submitted that, in the absence of any such evidence, the mark has not been put to genuine use by the Registered Proprietor”.¹¹

22. If the applicant wished to challenge the truth of Ms Worthington-Larsson’s narrative evidence, it could have filed evidence to undermine her testimony or requested cross-examination. It has done neither and it is, therefore, not appropriate for the applicant to invite the registrar to doubt the veracity of Ms Worthington-Larsson’s statement. I accept Ms Worthington-Larsson’s evidence on the relationship between the two companies.

¹¹ Submissions in lieu, §6.

23. I note the applicant's concerns regarding the invoices at exhibit LWL1 that:

"the acronym ATG does not show genuine use of the trade mark as registered.

[...]

It is further disputed that "...*it is in any case common practice to abbreviate a registered trade mark on business papers such as invoices...*". It is submitted that it is not common practice to abbreviate registered trade marks in the manner described by the Registered Proprietor, particularly when the registered mark is a figurative mark. The Registered Proprietor can of course choose to use abbreviations. However, the Registered Proprietor must then accept that they are using a trade mark which is very different from the mark as registered".

24. In my view, it is entirely usual for invoices to omit figurative elements of trade marks or to use abbreviations to identify the particular brands or goods. The purpose of an invoice is to record a sale which has been made, not to market goods under a particular trade mark. The invoices do not assist the proprietor in showing that the mark was used in the form as registered but they do serve the purpose of showing the level of sales for goods classed by the proprietor as "AGAINST THE GRAIN" products, particularly given Ms Worthington-Larsson's explanation that "ATG" is an abbreviation of "AGAINST THE GRAIN". In terms of the sufficiency of use, Ms Worthington-Larsson's clearly presented evidence paints a picture of modest but increasing sales since 2004. The figures provided by Ms Worthington-Larsson are supported by the (sample) invoice evidence, which shows sales throughout the relevant period to a number of locations across the UK. There is also evidence of media coverage and advertising in both local and national publications, as well as the proprietor's presence at exhibitions. Taking account of the evidence as a whole, I am satisfied that there have been sales which, while modest, are of a level sufficient to constitute genuine use.

25. There is no evidence that the mark has been used in the form as registered. The applicant submits that the form of the mark which has been used differs significantly from the registered mark. In its submissions in lieu, it states:

“19. It is submitted that one needs only look at the two marks in the table above to appreciate the significant differences (particularly visually, but also on a conceptual level, and even to an extent, phonetically) between the respective marks. It is submitted that the visual impression, for example, of the respective marks is significantly different in each case and certainly does not satisfy the requirements of Section 46(2) of the Act [...]”.

26. The applicant claims that the double border and the background in the registered mark are distinctive elements, and that their absence from the mark as used alters the distinctive character of the trade mark.¹² It has included in support of its arguments prints from the Register showing trade marks which are geometric shapes and which have achieved registration without being required to show acquired distinctiveness (and which have therefore been deemed to have some inherent distinctive character). The point is noted but the marks are quite clearly different from the devices at issue in these proceedings. The applicant also claims that the stylised “G” at the top of the registered mark “appears two-toned to complement the different coloured backgrounds to the mark”.¹³

27. The proprietor submits that the distinctive elements in the registered trade mark are the words “AGAINST THE GRAIN” (including a reversed letter ‘G’ in upper case) and the stylised, reversed letter “G”.¹⁴ It contends that the other elements in the registered mark, namely the abbreviation “LTD”, the words “WHEAT, DAIRY AND GLUTEN FREE” and the background and border, are descriptive or non-distinctive and that the distinctive character of the trade mark is unaffected by their omission.¹⁵

¹² Applicant’s submissions in lieu, §§23-24.

¹³ *Idem*, §24(iii)

¹⁴ *Idem*, §18.

¹⁵ Proprietor’s submissions in lieu, §30.

28. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under s. 46(2) of the Act 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”.

29. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound 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. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

30. In *hyphen GmbH v EU IPO*, Case T-146/15, the General Court (“GC”) held that use of the mark shown on the left below constituted use of the registered mark shown on the right:



31. The court set out the following approach to the assessment of whether the addition of additional components is likely to alter the form of the registered mark to a material extent.

“28 [...] a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE*

NAVARRA), T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).

32 It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009”.

32. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance, the Court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.

33. In *Menelaus BV v EUIPO*, Case T-361/13, where the GC found that use of the marks shown on the left and middle below constituted use of the registered mark on the right:



34. The court held that the word VIGAR was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

“73 [The first sign] sign differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term ‘vigar’, are minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

74 That finding is not called into question if the second form of use, reproduced in paragraph 63 above, is taken into account inasmuch as, even though, in that case, the basic background disappears and the word ‘spain’ is present, the latter will be understood as a merely descriptive addition”.

35. I also note the decisions of the GC in *LTJ Diffusion v OHIM*, case T-83/14 and *PAL-Bullemann v EUIPO*, case T-397/15, as well as in *Sony Computer Entertainment Europe v OHIM*, case T-690/14, to which the proprietor directed me. In the latter case,

the GC held that the trade mark on the left, below, was in a form which did not alter the distinctive character of the registered mark on the right:



36. In particular, the Court held at [47] that the distinctive character of the registered mark “is essentially derived, not from its figurative elements, but from its word element ‘vieta’”. The figurative elements were said to “have only weak distinctive character and occupy merely an ancillary position in [the] overall impression”, whilst the rectangular border and the small rectangles did not “present any originality”.¹⁶

37. The registered trade mark and the mark as used in the instant proceedings are shown below:

Registered trade mark	Trade mark used
	

38. The first question to be answered is “what is the distinctive character of the registered trade mark?”. The device element at the top of the registered mark is a distinctive element. The parties describe this device as a reversed, stylised letter “G” but

¹⁶ At [48].

it is unlikely that the average consumer will recognise the device as a letter. The applicant has suggested that the device is in different shades of grey in the mark as registered, with a lighter shade on the dark background and a darker shade on the white background.¹⁷ I do not consider that there is any change in colour within the letter but, even if there is, it is unlikely to be noticed by the average consumer and does not add to the distinctiveness of the device. The words “AGAINST THE GRAIN” are also distinctive. The device and the words “AGAINST THE GRAIN” are, in my view, equally dominant in the mark. The abbreviation “LTD”, given its relative size and that it simply indicates corporate status, is likely to be given no trade mark significance. The words “WHEAT, DAIRY & GLUTEN FREE” are descriptive in relation to the goods at issue and have no distinctive character. The border, notwithstanding the fact that it is a double border, is a banal surround which has no distinctiveness. Whilst I acknowledge that the fifty-fifty split of the background is visually striking, it is no more than an elaborate background which, again, has little or no distinctiveness.

39. The first difference between the mark as registered and the mark as used is the change in position of the stylised letter “G”, which in the mark as used has been positioned on the left of the words “AGAINST THE GRAIN” rather than above them. This has no effect on the distinctive character of the mark. Further differences between the respective marks are the absence of the letters “LTD”, the border, and the background consisting of a black and a white rectangle. In terms of their relative distinctiveness, all of these elements are, at best, weakly distinctive and play a subordinate role to the large, stylised letter “G” and the words “AGAINST THE GRAIN”. Taking all of the above considerations into account, I find that, whilst the average consumer is likely to register the differences, the alterations are such that the distinctive character of the registered mark is not affected. The form used is an acceptable variant of the registered mark.

¹⁷ Submissions in lieu, §23(iii).

40. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed

independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46”.

41. The proprietor has not made any submissions on this issue, other than an assertion that the evidence supports the claim of use in its counterstatement. The applicant has commented only briefly. It submits that “confectionery” means “sweets and chocolates considered collectively” and that “[there] is no mention of “cookies” or “biscuits” or even “baked products” under this definition”.¹⁸ As a consequence, it considers that the proprietor has not used the mark in respect of “baker’s confectionery”.

42. I am not persuaded that “confectionery” as defined by the applicant is analogous to “baker’s confectionery”. For one thing, bakers rarely, if ever, produce sweets and chocolates. It seems to me more likely that “baker’s confectionery” is a reference to “confections” construed more widely, such as pastries and cakes. It is unnecessary for me to make a firm finding, however, as the evidence shows use of the mark only on or in relation to biscuits and cookies. There is no evidence of use in relation to any other goods, at any time since registration. Whilst I acknowledge that there may be a slight difference between a biscuit and a cookie, I consider that the average consumer is likely to consider “biscuits” and “cookies” as interchangeable terms which are subcategories of the wider term “baked products”. That finding garners some support from the proprietor’s evidence, where the goods are offered under headings such as “biscuits, cookies and oatcakes” (e.g. p. 145), “biscuits, crackers & crispbread” (e.g. p. 235) and “bread, biscuits & cakes” (p. 253). Given that the use shown is for goods in a discrete

¹⁸ §21.

subcategory, I do not consider it appropriate for the proprietor to retain the wider terms “baked products” or “baker’s confectionery”. A fair specification is “biscuits; cookies”.

Conclusion

43. The trade mark will be revoked for “cakes; bread; pastry; baked products; baker’s confectionery” with an effective date of 26 January 2007. It will remain registered for “biscuits; cookies”.

Costs

44. The application for revocation has succeeded in part. On the face of it, the applicant appears to have had the greater measure of success. However, much of its success is due to the proprietor’s admission in its counterstatement that there had been no use in relation to certain goods in the specification. As no notice was given by the applicant to the proprietor of its intention to file the application for revocation,¹⁹ it would be inappropriate to make an award against the proprietor in respect of the undefended goods. In terms of the goods for which the registration was defended, the parties have achieved an equal measure of success. I direct that they bear their own costs.

Dated this 1st day of February 2018

**Heather Harrison
For the Registrar
The Comptroller-General**

¹⁹ TM26(N), box 6.