

O/083/18

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3182086

IN THE NAME OF MIDLAND PIG PRODUCERS LIMITED

AND

OPPOSITION 408864

BY MASSTOCK ARABLE (UK) LIMITED AND ORIGIN ENTERPRISES PLC

AND

TRADE MARK REGISTRATIONS 1491090 & 2503888

IN THE NAME OF MASSTOCK ARABLE (UK) LIMITED

AND

APPLICATIONS 501592 & 501594

BY MIDLAND PIG PRODUCERS LIMITED

TO REVOKE TRADE MARK REGISTRATIONS 1491090 & 2503888

FOR NON-USE

Background and pleadings

1. These consolidated proceedings consist, in part, of an opposition by Masstock Arable (UK) Limited and Origin Enterprises PLC (collectively, "Origin") to an application filed on 24th August 2016 ("the relevant date") by Midland Pig Producers Limited ("Midland") to register DALGETY as a trade mark for a wide variety of goods/services in classes 1, 6, 7, 12, 31, 35, 36, 39, 40, 42 & 44.

2. The trade mark had been published for opposition purposes on 23rd December 2016. A full list of the goods services covered by the opposed mark is set out in Annex A. The opposition is directed at all the goods/services in 1, 31, 35, 36, 40, 42 and 44.

3. The grounds of opposition are under:

(a) Section 5(1), s.5(2)(a) and s.5(3) of the Trade Marks Act 1994 ("the Act") based on earlier UK trade mark 1491090 – DALGETY – which is registered in class 31 in the name of Masstock (Arable) UK Limited. As the earlier mark had been registered for more than 5 years by the date of publication, the opponents made the required statement of use of the earlier mark. This claimed that the mark had been used during the five year period ending on the date of publication in relation to all the registered goods, i.e. 'all goods in class 31'.

(b) Section 5(4)(a) of the Act based on Origin's common law rights in the name DALGETY as a result of the use of that name in the UK since 1992.

(c) Section 3(6) of the Act based on an allegation that the application was filed in bad faith. This is because (i) Origin is the successor to Dalgety plc, which used the DALGETY name "for many years past", (ii) although use of DALGETY ceased in the UK, Origin continued to use the name DALGETY until 2015 on its website in relation to its Polish business, (iii) use of DALGETY by the applicant would deceive the public into believing that it is the successor of Dalgety plc, and (iv) Midland "could not possibly be using or

have a *bona fide* intention of using the trade mark” in relation to all of the goods and services listed in the application.

4. The other part of the consolidated proceedings consists of two applications under s.46(1)(a) and (b) of the Act by Midland to revoke Masstock Arable (UK) Limited’s earlier trade marks 1491090 and 2503888 (also DALGETY in class 31) for non-use. The trade marks concerned were registered on 12th November 1993 and 5th June 2009, respectively. Midland claims that the marks were never put to genuine use, or that such use was interrupted for various continuous periods of 5 years, and the registrations should therefore be revoked for non-use.

5. Midland denies the grounds of opposition to its trade mark application and puts Origin to proof of its case, including proof that earlier trade mark 1491090 had been put to use in the 5 year period ending on the date of publication of the opposed mark.

6. Masstock Arable (UK) Limited denies the grounds of revocation to the extent that trade marks 1491090 and 2503888 are registered in relation to *seed and seeds*. The denial is expressed in these terms:

“The registered proprietor opposes the application for revocation because the Trade Mark DALGETY is an iconic brand which the Opponent had used over a very long period and which is still associated in the minds of the trade and interested public in the United Kingdom with the Opponent. The Opponent is a subsidiary of Origin Enterprises UK Limited which in turn is a subsidiary of Origin Enterprises plc. The Opponent and United Agri Products Limited trade as Agrii. Agrii’s website is www.agrii.co.uk and refers to the fact that Agrii is built on the unification of several respected businesses during the last 30 years, all with their own valued reputation in UK farming and refers in its pedigree to the four businesses including Dalgety which now constitute Agrii (see attached Exhibit I).

The name and trade mark DALGETY also features on the Origin Enterprises plc website (see for example the attached Exhibit 2).”

The evidence

7. Only Origin filed evidence. The evidence consists of a brief witness statement by Mr Tom O'Mahony who has been a director of Origin Enterprises plc since 2006. He explains that his company is *"a leading agri-services group providing on-farm agronomy services, digital agricultural services and the supply of crop technologies and inputs that address the quality, efficient and output requirements of primary food producers."* In support of this claim he attaches a copy of the company's annual report for 2016 which shows that the company has operations in the UK, Ireland, Poland, Romania and Ukraine with revenues exceeding €1.5 billion.¹ Masstock Arable (UK) Limited is a subsidiary of Origin Enterprises plc and, together with United Agri Products Limited (another subsidiary), trades as Agrii.

8. According to Mr O'Mahony, Masstock and its predecessors used DALGETY between 1973 and 2007 in relation to *"a wide range of goods and services including the following: agronomy and plant breeding research; agronomy advisory services; farm business consultancy; supply of crop protection, arable seed (DALGETY Master Seeds) and fertilizer products; precision farming (DDF – DALGETY Digital Farming); fixed plant and on-farm seed processing; supply of forage crop (grass and maize) seed for livestock production."*

9. In 2007, *"Masstock ceased actively to use its trade mark DALGETY, adopting in its place MASSTOCK."* Later, in 2012, Masstock and United Agri Products Limited commenced trading in the UK under Agrii. Mr O'Mahony says that Agrii retained ownership of the domain name www.dalgety.co.uk and accessing that domain name leads to the website www.agrii.co.uk.

10. In 2008, Origin acquired Dalgety Polska. Since then, references to Origin's Polish subsidiary and the trade mark DALGETY have appeared on Origin's website. Mr O'Mahony says that extracts from the website are in exhibit 03, but all I can find are copies of Origin Enterprises plc's annual reports for 2011 to 2016. I note that there are references in these documents to the Polish subsidiary as *Dalgety*

¹ See exhibit 01

(Poland), *Dalgety Agra Polska* etc. The main activity of the business in Poland appears to be agri-services, but there is a reference (in the 2016 report) to 'Our Brand Products – Poland', which includes a picture of a product under the name NASIONA DALGETY. I also note that 'Dalgety Seeds' is listed as one of the brands used in Poland.

11. Mr O'Mahony also exhibits a page from the website www.agrii.co.uk entitled 'Our Heritage'. The narrative explains that Agrii is built on the unification of several respected businesses during the last 30 years, all with their own valued reputation in UK Farming.² Dalgety and Masstock are shown as two of the businesses which became Agrii. The page appears to be a link reached through the home page and then via the 'About Us' section of the site. There is no evidence as to when this page was added to the site and therefore how long it has been available to the public.

12. Finally, Mr O'Mahony exhibits a copy of a presentation entitled 'Agrii working for you' which explains, inter alia, the origins of the business and the historical link to Dalgety and others.³ The presentation is not dated as such, but I note that it includes references to events in June 2016. It cannot therefore have been produced prior to that date. There is no evidence as to who the presentation was shown to, or when.

Representation

13. Origin is represented by Ansons, Trade Mark Attorneys. Midland is represented by Forresters IP, Trade Mark Attorneys. Neither side asked to be heard. However, I have received written submissions from both parties.

² See exhibit 04

³ See exhibit 05

Midland’s applications to revoke trade marks 1491090 and 2503888 for non-use

14. It is convenient to start with the applications for revocation. 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) -

(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.”

15. 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.”

16. Midland submits that as the proprietor of the earlier marks admits that they have not been used since 2007, they must be revoked.

17. The proprietor appears to rely on four things in order to resist the applications for revocation:

- (i) The residual reputation in the UK associated with the DALGETY name;
- (ii) The historical references to Dalgety in Origin’s annual reports and on Agrii’s website;
- (iii) Continued ownership of the domain name www.dalgety.co.uk;
- (iv) The references to Dalgety Poland in Origin’s annual reports.

18. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*,⁴ 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 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. 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

⁴ [2016] EWHC 52

the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft '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. I find that any residual reputation that may exist in the UK under the DALGETY mark is, at least by itself, irrelevant to the issue of whether the proprietor has put the mark to genuine use since 2007. This is because showing that there is such a residual reputation does not show any more recent use of DALGETY by the proprietor or with his consent.

20. It is well established that the existence of a domain name or website does not mean that the name has been used as a trade mark. Therefore, mere ownership of the domain name www.dalgety.co.uk is also irrelevant. I could not find any historical

references to the original Dalgety business in Origin's annual reports. However, even if there are such references, they could not show genuine use of DALGETY. This is because such use is not "*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.*" No goods have been marketed in the UK under the mark since at least 2007. It follows that any use of DALGETY in the annual reports of Origin Enterprises plc to identify one of the predecessors of Agrii's business had nothing to do with creating or maintaining an outlet in the UK for goods bearing the mark.

21. For the same reason, I find that the use of DALGETY on the www.agrii.co.uk website does not show genuine use of the registered marks. Additionally, the evidence does not establish when the reference to DALGETY was added to Agrii's website. It could therefore have been created after the filing of the applications for revocation and therefore too late to assist the proprietor's defence of the registrations, even if it did show genuine use.

22. The same criticism applies to the use of DALGETY in the presentation entitled 'Agrii working for you'.

23. I find that the use of DALGETY in the annual report of Origin Enterprises Limited in relation to the business of its Polish subsidiary does not show genuine use of the mark in the UK either. This is because such use was plainly not intended to create or preserve a market for goods bearing the trade mark in the UK.

24. It follows that the proprietor has not shown any genuine use of the DALGETY marks in the UK since at least 2007. Therefore trade marks 1491090 and 2503888 must be revoked for non-use.

The dates of revocation

25. Midland asks for trade mark 1491090 to be revoked with effect from the earliest date possible from 13th November 1998/2008/2013, 17th December 2016 or 13th March 2017.

26. Midland asks for trade mark 2503888 to be revoked with effect from the earliest date possible from 6th June 2014, 23rd August and 17th December 2016.

27. In order to revoke the registration of the marks from dates earlier than the dates of Midland's revocation applications, I must be "*satisfied that the grounds for revocation existed at an earlier date.*" Although the evidence is scant, it seems likely that there was some use made of DALGETY in the UK up until 2007. The first continuous periods of five years commencing after 2007 and ending before the dates specified in the applications for revocation are:

13th November 2013 for 1491090;

6th June 2014 for 2503888.

The registrations will therefore be revoked from these dates.

Origin's opposition to Midland's trade mark application

The grounds of opposition under s.5(1), s.5(2) and s.5(3) of the Act

28. As the dates of revocation of Origin's marks pre-date the relevant date in the opposition (as well as the date of publication of the opposed mark), the grounds of opposition based on earlier trade mark 1491090 fall away and do not have to be considered.

The passing-off right ground

29. Section 5(4)(a) states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

30. The gist of Origin’s passing-off right case is that the use of DALGETY by Midland in relation to the goods/services to which the opposition is directed, would deceive the public into believing that it is the successor of the business operated in the UK up until 2007 by Dalgety plc and later Masstock Arable (UK) Limited.

31. The goods and services covered by the goodwill on which Origin relies are claimed to be:

“Agronomy & plant breeding research; agronomy advisory services; farm business consultancy: supply of crop protection, arable seed (Dalgety Master Seeds) and fertiliser products; precision farming (DDF - Dalgety Digital Farming); fixed plant and On farm seed processing; supply of forage crop (grass and maize) seed for livestock production.”

32. I do not understand what ‘precision farming’ is as a service to others. Further, I am not sure whether ‘supply of crop protection’ is a trade in goods or services.

33. The opposition is directed at all the goods/services in 1, 31, 35, 36, 40, 42 and 44, as shown in Annex A.

34. Leaving to one side the lack of clarity about two of Midland’s descriptions of the goods/services covered by the claimed goodwill under DALGETY, it is clear that some of the goods and services are identical to those covered by the opposed application, e.g. seeds in class 31, agricultural research in class 42 and agricultural services in class 44. I note that some of the other goods/services at which the

opposition is directed appear to be quite different to the trade in goods/services on which Origin relies, e.g. insurance services in class 36.

35. In the absence of any earlier use of DALGETY by Midland, the only relevant date for assessing the passing-off right claim is the date of Midland's application for registration (24th August 2016). The question of whether Origin could have prohibited Midland's use of the mark based on the law of passing-off must be assessed as at the relevant date.

36. The requirements to establish a passing-off right are well established and not in dispute. They are (a) goodwill in a business, (b) a misrepresentation by the defendant (intentional or otherwise) which is liable to deceive a substantial number of the claimant's customers or potential customers, and (c) resulting damage to the claimant's goodwill. Most passing-off cases concern an on-going business, but it is well established that goodwill can survive and still be protected for some time after a business ceases to trade under a name.⁵

37. Midland submits that (a) there is no evidence as to the extent of any goodwill that existed under DALGETY in 2007, (b) on Origin's evidence, the name was dropped in favour of MASSTOCK in 2007, (c) nine years had passed between then and the relevant date, and (d) any goodwill that existed would have "withered on the vine" by the latter date.

38. Origin submits that the reputation of DALGETY lives on, aided by continued references to the old business as one of the constituents of its successors and as the name of its Polish business.

39. In *Minimax GmbH & Co KG v Chubb Fire Ltd*,⁶ Floyd J. (as he then was) considered an appeal against a decision of the registrar to uphold an opposition to a trade mark application under s.5(4)(a) based on residual goodwill under the name Minimax. The judge considered the law, an earlier judgment by Laddie J., and gave

⁵ See, for example, *Ad Lib Club Ltd v Granville* [1971] F.S.R. 1

⁶ [2008] EWHC 1960 (Pat)

the following helpful summary of the relevant factors for assessing whether a passing-off right still exists. He said:

“14.in *Sutherland v V2 Music Ltd* [2002] EMLR 28 , Laddie J had to consider whether the goodwill generated by a funk music band called Liberty 1, which had been formed in the late 1980s, still subsisted in March 2001. Laddie J considered the relevant principles and reviewed the authorities. At paragraph 22 he said this:

“There is one other general matter to deal with before turning to the facts, namely the size of the claimant's reputation. At some point a reputation may be respected by such a small group of people that it will not support a passing-off action. Neither Mr. Purle nor Mr. Speck were able to formulate a test for this bottom level. Mr. Purle said it was a matter of fact and degree. I agree with that. The law of passing off protects the goodwill of a small business as much as the large, but it will not intervene to protect the goodwill which any reasonable person would consider trivial”.

15. It is difficult to define any minimum threshold. It will all depend on the facts. How big was the reputation when use stopped? How lasting in the public eye are the goods or services to which the mark is applied? How, if at all, has the person asserting the existence of the goodwill acted in order to keep the reputation in the public eye? The greater each of these elements is, the longer, it seems to me, it will take for any goodwill to dissipate.”

40. Turning to the matters identified in paragraph 15 of the judgment, I find it very difficult from Origin's evidence to assess how big the reputation was in Dalgety when use of that name ceased in 2007. Part of the difficulty is knowing when the use of the name started. Mr O'Mahony (who joined Origin in 2006) says it started in 1973, but the notice of opposition states that such use started in 1992. Additionally, the opponent has not provided any figures quantifying the size of the business at any time. There is no indication of market share. There is no evidence as to the extent of

(or any) recognition of the name around 2007 by third parties or in the media. There is no evidence from any customers.

41. Further, although Mr O'Mahony gives a description of the main goods and services that Dalgety provided in the UK up until 2007, there is not enough detail about the business to be able to evaluate which goods or services it was known (or best known) for. In this connection, I note that Origin's notice of opposition to Midland's application included an internet address which could be used to access an article on Wikipedia about the old Dalgety business. There are two problems with this. Firstly, the entry concerned has not been filed as evidence, and it is not for this tribunal to go searching for evidence to support Origin's case. Secondly, it is my understanding that anyone can add or update the information on Wikipedia. If that is so, it is obvious why information drawn solely from Wikipedia is likely to be regarded as unreliable evidence.

42. In addition, I note that the goods and services that Mr O'Mahony lists in his statement as having been provided by the old Dalgety business appear to have been goods/services intended for immediate use. So this is not the sort of case where goods bearing the mark DALGETY and marketed prior to 2007 would have remained in existence years later and remained in the public eye, such as in, for example, the trade in single malt Scotch whiskies or fire extinguishers.

43. The 'highpoint' of Origin's case appears to be that it has taken steps to keep the name DALGETY in the public eye by making references to that old business in annual reports, on websites and in presentations, and by retaining ownership of the domain name www.dalgety.co.uk. The difficulty with this evidence is that:

- (a) The references to Dalgety in the annual reports in evidence appear to be to Origin's Polish subsidiary;
- (b) The goodwill of the Polish business is separate to that of the old UK business and not situated in this jurisdiction;
- (c) Any reputation generated in the UK under DALGETY in relation to the business established in Poland in 2008 will not necessarily have kept the old UK business in the public eye;

- (d) The evidence of the heritage of Agrii (including DALGETY) being shown on its UK website is (i) not dated, and (ii) appears to have been given little prominence;
- (e) The Agrii presentation relied on is also undated and there is no evidence about who (if anyone) saw it;
- (f) Mere ownership of a domain name does not keep the name in the public eye;
- (g) There is no evidence that there was a functioning website at the domain address www.dalgety.co.uk, and although Mr O'Mahony says that anyone accessing that domain name would have been led to the Agrii website, there is no evidence that anyone actually was.

44. I acknowledge that it is possible that there was still a residual goodwill under DALGETY at the relevant date that would have been known to more than a trivial number of the Origin's customers or potential customers. However, the onus was on Origin to set out in detail the full scope of the old Dalgety business that generated goodwill in the UK, and to provide sufficient material to support the claim that a more-than-trivial residual goodwill still existed under DALGETY at the relevant date. Standing back and looking at Origin's evidence in the round, I find that it has failed to do either. Consequently, the opposition under s.5(4)(a) fails.

The bad faith ground of opposition

45. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

46. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*⁷ as follows:

⁷ [2012] EWHC 1929 (Ch)

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999]

RPC 367 at 379 and DAAWAT Trade Mark (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 48)."

47. It will be apparent from my description of Origin's pleading in paragraph 3(c) above that there is large degree of overlap between the facts relied on to support the s.3(6) and s.5(4)(a) grounds. Origin's failure to establish the facts necessary to support the s.5(4)(a) ground therefore also detracts from the primary case presented under s.3(6).

48. Admittedly, the existence of residual goodwill under DALGETY is not, as such, a prerequisite for making out a case of bad faith, which turns more on the intentions of the applicant. Having said that, the central allegation that the public are likely to be deceived into believing that Midland is the successor in business to Dalgety plc called for solid evidence of the primary fact relied upon, i.e. the residual goodwill and reputation of the original DALGETY business. And I have already found Origin's evidence to be insufficient to establish this fact.

49. Bad faith is a serious allegation. Section 3(6) is not there to sweep up objections which have been considered and rejected under other specifically applicable sections of the Act. As Professor Philip Johnson, as the Appointed Person, stated recently in *Youdan Trophy Limited v Hallam FC*⁸

“In response to a question from me, Mr Hicks submitted that section 3(6) cannot be the basis of an objection where it is better founded under another specific provision of the section, such as section 3(3)(b). I think this must be right. Findings of bad faith are not there for sweeping up assorted conduct, but to prevent the abuse of the trade mark system (see Melley’s TM Application [2008] RPC 20 at paragraph 51).”

50. Further, considering Origin’s central allegation again, this time from the perspective of Midland’s alleged bad faith, I must keep in mind that there is a presumption of good faith and that it is not enough to establish facts which are consistent with both good faith and bad faith. In the absence of persuasive evidence of the continued existence of the reputation and goodwill of the original Dalgety business, this presents particular difficulties for Origin’s primary case under s.3(6).

51. I have taken into account that Midland has filed no evidence or offered any explanation for its choice of DALGETY as a trade mark. In the face of sufficient evidence to make out a *prima facie* case of bad faith, these omissions could have been fatal. However, although I have found myself speculating as to Midland’s intentions in this matter, I have come to the conclusion that Origin has not established a *prima facie* case for Midland to answer. In these circumstances, merely having been caused to wonder about Midland’s intentions is not sufficient to justify a finding of bad faith. The primary basis for Origin’s s.3(6) ground is therefore also rejected.

52. Origin also alleges, almost as an afterthought, that Midland “could not possibly be using or have a *bona fide* intention of using the trade mark” in relation to all of the goods and services listed in the application. However, no evidence was tendered in

⁸ BL O-049-18

support of this allegation. And although the application covers a wide range of goods and services, it is not so wide as to mean that Midland's statement of 'intention to use' could not have been in good faith. I therefore reject the second part of Origin's s.3(6) case too.

Overall outcome

53. Trade Mark 1491090 will be revoked with effect from 13th November 2013.

54. Trade mark 2503888 will be revoked with effect from 6th June 2014.

55. The opposition to trade mark application 3182086 fails. The trade mark will proceed to registration.

Costs

56. Midland has been successful and is entitled to a contribution towards its costs. I note that in the written submissions filed on behalf of Midland it was said that its costs should be awarded "in full". I do not know whether this was a request for off-scale costs but, if it was, no reasons were offered for such a claim. I therefore reject it.

57. I calculate the costs award (on-scale) as follows:

£750 for filing two applications for revocation (including £400 in official fees) and considering Origin's counterstatements;

£300 for considering Origin's notice of opposition and filing a counterstatement;

£500 for considering Origin's evidence and filing written submissions.

58. I therefore order Masstock Arable (UK) Limited and Origin Enterprises PLC to pay Midland Pig Producers Limited the sum of £1550. This should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings (subject to any order of the appellant tribunal).

Dated this 2nd day of February 2018

**Allan James
For the Registrar**

Annex A

Class 1: Chemicals used in industry, agriculture, horticulture and forestry; peat; chemically treated peat; bacteria; fertilizers.

Class 6: Cages and holding areas for farm animals; metal building materials and frameworks for use in agriculture and animal breeding; pig farrowing crates; pig sties; pig pens; parts and fittings for all the aforesaid goods.

Class 7: Agricultural machinery and implements; parts and fittings for all the aforesaid goods.

Class 12: Vehicles; apparatus for locomotion by land, air or water; fork lift trucks; off-road vehicles; all-terrain vehicles; vehicle bodies; engines for land vehicles; tractors; earth-moving vehicles; trailers; parts and fittings for all the aforesaid goods.

Class 31: Agricultural, horticultural and forestry products; live animals and fish; food, feedstuffs and beverages for animals; fresh fruit and vegetables; seeds; live plants and flowers; straw mulch; straw litter; litter materials for animals; litter materials for pig breeding and rearing; additives, supplements and preparations for use with food and feedstuffs for animals.

Class 35: Retail services in store, online and wholesale relating to the sale of chemicals used in industry, agriculture, horticulture and forestry, peat, chemically treated peat, bacteria, fertilizers, cages and holding areas for farm animals, metal building materials and frameworks for use in agriculture and animal breeding, pig farrowing crates, pig sties, pig pens, agricultural machinery and implements, vehicles, apparatus for locomotion by land, air or water, fork lift trucks, off-road vehicles, all-terrain vehicles, vehicle bodies, engines for land vehicles, tractors, earth-moving vehicles, trailers, agricultural, horticultural and forestry products, live animals and fish, food, feedstuffs and beverages for animals, fresh fruit and vegetables, seeds, live plants and flowers, straw mulch, straw litter, litter materials for animals, litter materials for pig breeding and rearing, additives, supplements and preparations for use with food and feedstuffs for animals; business advice relating to farming and agriculture; information and advisory services relating to the aforesaid.

Class 36: Insurance services; insurance brokerage; real estate affairs; financial services; investment services; land and property sales, letting and development; property letting; provision of information relating to the above.

Class 39: Packaging, storage and delivery of food products and live animals.

Class 40: Production of energy; slaughtering of animals; energy production, using animal waste; waste processing, treatment and incineration.

Class 42: Research relating to environmental protection; agricultural research; research in the field of energy; environmental protection consultancy; material testing and quality control services relating to the production and supply of agricultural, horticultural, forestry, dairy, meat, fish, poultry and game products; farm quality assurance services; advice and assistance relating to agricultural, farming and food

production standards; writing of reports relating to agricultural, farming and food production standards; provision of information relating to food, agricultural, farming and food production standards; writing and analysis of reports relating to agricultural, farming and food production standards.

Class 44: Agricultural services; animal breeding; farming services; contract farming; rental of farming apparatus and equipment; information services relating to farming.