

**O-372-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK REGISTRATION NOS. 2490862A & 2490862B  
IN THE NAME OF SIMON BUCKLEY  
FOR THE TRADE MARKS**

**HEROES BITTER**

**&**

**HEROES LAGER  
HEROE LAGER  
(SERIES OF 2)**

**AND THE APPLICATION FOR CANCELLATION THEREOF  
UNDER NOS. CA00501586 & CA000501587  
BY  
HEROES DRINKS COMPANY C.I.C.**

## **Background & Pleadings**

1. Simon Buckley is the Registered Proprietor for UK Trade Mark nos. 2490862A for the mark HEROES BITTER and no. 2490862B for the marks HEROES LAGER and HEROE LAGER (series of two marks). The marks were filed on 23 June 2008 and registered on 15 May 2009. They are registered in Class 32 for the following specification: *Beer; ale; stout; porter and lager; shandy, all included in Class 32.*

2. Heroes Drinks Company C.I.C. ('Heroes Drinks') seeks revocation of the registered marks, in full, on the grounds of non-use based on Section 46(1)(b) of the Trade Marks Act 1994 ('the Act') in respect of the time period 5 November 2011 to 4 November 2016, with an effective revocation date of 5 November 2016.

3. Simon Buckley filed a counterstatement denying the claim and stating the trade marks have been used since 2010 on bottled lager and cask ales.

4. Both parties are representing themselves in these proceedings and both filed evidence. This will be summarised to the extent that it is considered necessary. No hearing was requested and so this decision is taken following consideration of the papers before me.

## **Registered Proprietor's evidence**

5. Simon Buckley filed a short witness statement dated 28 September 2017 in which he gives the following information,

“...the trade marks have been used since 2010 on a frequent basis, as set out in the TM8”.

6. For the sake of clarity, the relevant information presented in the TM8 is as follows:

“Heroes lager was first launched in a 275ml bottle in 2010 and again in 2011 when it was sold via the pub estate of the former Welsh Estates. This was

effectively the test marketing of the brand. The brands have then be [sic] sold through estate of beer brands Ltd, which were sold as cask ales and several cask ale variants followed. Including Heroes damn Good Ale. Heroes Golden Bitter was sold in June 2014, as a variant of Heroes Bitter”.

7. Mr Buckley also attaches 3 copy invoices to his witness statement. The earliest invoice dates from 6 April 2010 and is for an order of 130 cases of Heroes Lager and 403 cases of Heroes Golden totalling £1066. The copy invoice is addressed to Welsh Brands Ltd of 1 Rhosmaen Street, Llandeilo, SA19 6LU which happens to be the same street, town and postcode as the recorded address for Mr Buckley. I also note that this invoice pre-dates the relevant time period outlined above in paragraph 2.

8. The remaining two copy invoices are both dated 5 June 2014 and so are within the relevant time period. The invoice numbered ‘9’ is for an order of 208 cases of Heroes Lager and 175 cases of Heroes Golden totalling £679 and addressed to Beer Brands Ltd of 1 Rhosmaen Street, Llandeilo, SA19 6LU which as I have already noted is the same address as Mr Buckley’s. The invoice numbered ‘10’ is for an order of 100 cases of Cask Damn Good Ale and 138 cases of Cask Golden ale totalling £657 and is also addressed to Beer Brands Ltd. I note that the word ‘Heroes’ is not present on this particular invoice.

9. Mr Buckley also attaches a photograph of a Heroes Lager bottle (reproduced below) which he states “was sold at that time”. I take this statement to mean the bottled product was sold in 2014 as per the copy invoice referred to above.



10. Mr Buckley gave no further information in the witness statement as to other sales, turnover or advertising expenditure generated from the goods provided under the registered trade marks.

### **Heroes Drinks evidence**

11. The Heroes Drinks evidence takes the form of a witness statement made by Christopher Gillan, the managing director of the applicant. There are a number of annexes attached to Mr Gillan's witness statement. I do not intend to summarise them save for the most pertinent of these annexes, labelled N, O, P and Q, which show documentation from Companies House stating that Simon Buckley was a director and shareholder for Welsh Estates Ltd until it was wound up in January 2011 which is outside the relevant time period. Mr Buckley was also a director in Beer Brands Ltd until his resignation in February 2015 but was still a shareholder as at June 2015, which is within the relevant time period and is also relevant to the invoices outlined above in paragraph 8.

### **Legislation**

12. 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.”

13. 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.”

### **The case law regarding genuine use**

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

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].”

15. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the



first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

16. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

## Decision

17. It is clear from the guidance given above that I must consider a number of factors when assessing whether genuine use of the mark has been shown from the evidence provided.

18. Heroes Drinks have criticised Mr Buckley’s evidence several times in its witness statement dated 30 January 2018. It submits that,

“It is also somewhat questionable that he has provided invoices from Simon Buckley Brand Management to Beer Brands Ltd and Welsh Estates Ltd, both of which Mr Buckley is both a shareholder and director” (para 17).

And

“The image provided by Mr Buckley is not clear and is only for Heroes Lager” (para 18).

And

“Mr Buckley claims to have created the brand Heroes in support of military charities which further claims to have been used on a frequent basis but has failed to provide supporting evidence such as invoices from an independent companies [sic] for the provision [of] services associated to the products such as label production, bottling charges, production of caps or even the sale of the product” (para 20).

19. I agree with Heroes Drinks' points outlined above. In such cases of non-use, the onus is on the Registered Proprietor to provide 'sufficiently solid' evidence to refute the claims made. In this case there are a number of particular deficiencies within the evidence provided. Specifically, there is a lack of turnover figures resulting from sales other than from the three copy invoices provided (one of which pre-dates the relevant period). There is also no evidence relating to advertising or information relating to a take-up of the goods from the trade, whether examples of it or expenditure figures from promoting the goods. There are no details at all as to the geographical spread of pubs/bars or other customers purchasing or distributing these goods. Indeed the only sales for which evidence has been provided are to companies in which it has been established that Mr Buckley has played a leading role and presumably had an economic stake. Mr Buckley has claimed the marks have been used "on a frequent basis" but his evidence does not support this. Whilst the use of a mark does not have to be quantitatively significant to be genuine, the only possible evidence of any sales within the relevant period takes the form of two invoices totalling some £1336.00, only one of which refers to the **Heroes Lager** mark under attack and both of which have been shown to have been issued to companies in which Mr Buckley plays or played a leading role. Even had the invoices shown use of the mark to a third party, it would in no way persuade me that such use is justified in the relevant sector for creating or preserving a market share in those goods, a

market which must, on any reckoning, be vast. I find that the evidence provided does not satisfy the criteria on genuine use of the marks as set out in paragraph 13. In my view Mr Buckley has failed to discharge the burden placed on him to provide evidence of genuine use in respect of any of the goods for which the trade marks are registered.

## **OUTCOME**

20. The application for revocation on the grounds of non-use succeeds under sections 46(1)(b). Consequently, trade mark nos. 2490862A & 2490862B are revoked in their entirety under section 46(6)(b), the effective date of revocation being 5 November 2016.

## **COSTS**

21. As the applicant has been successful, it is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs on the following basis:

£200 Application fee

£200 Preparing a statement and considering the counterstatement

£500 Considering evidence and preparing submissions

**£900 Total**

22. I order Simon Buckley to pay Heroes Drinks Company C.I.C. the sum of £900. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of June 2018**

**June Ralph**

**For the Registrar  
The Comptroller-General**