

**O/248/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 2182923  
IN THE NAME OF JATINDER SINGH WASU FOR THE TRADE MARK**



**(A SERIES OF 6 MARKS)**

**IN CLASSES 30, 39 AND 43**

**AND**

**THE APPLICATION FOR REVOCATION THERETO UNDER NUMBER 501937**

**BY**

**ZAMIR HUSSAIN**

## Background

1. Trade mark registration 2182923 has been registered since 30 June 2000 as a series of six trade marks, as shown on the cover page of this decision, in relation to the following goods and services:

Class 30: *Pizzas; bread; pasta; preparations made from cereals, bread, pastry, pasta; cakes and confectionery; puddings; sandwiches; sauces; pies.*

Class 39: *Transport and delivery of goods; transport and delivery of food and drink.*

Class 43: *Catering services for the provision of food and drink; restaurant services; bar services; take-away food services; preparation of food and drink.*

2. Nothing in this decision turns upon the marks being a series. For convenience, I will refer to them in the singular (“the mark”). The registration currently stands in the name of Jatinder Singh Wasu. This decision concerns an application by Zamir Hussain to revoke the trade mark registration on the ground that the trade mark has not been put to genuine use by its proprietor or with its consent. Mr Hussain filed his application to revoke the registration on 12 January 2018 under section 46(1)(b) of the Trade Marks Act 1994 (“the Act”) claiming that the registration was not put to genuine use in the following three five-year periods:

Start date	End date	Effective revocation date
1 August 2011	31 July 2016	1 August 2016
23 December 2011	22 December 2016	23 December 2016
6 July 2012	5 July 2017	6 July 2017

3. The application form TM26(N) records that Mr Hussain gave notice to Mr Wasu of his intention to seek revocation on 27 November 2017. Mr Hussain states that the notification letter was sent by Royal Mail recorded delivery and was returned marked “RTS”.

4. Mr Wasu filed a defence and counterstatement, denying the grounds and stating that the registration had been used by The Perfect Pizza Company Ltd (Mr Wasu's predecessor-in-title) and then with the consent of Mr Wasu during at least 2014 and 2015.

5. Mr Wasu is professionally represented by Appleyard Lees IP LLP. Mr Hussain was initially represented by UK Law Limited, but has represented himself since Mr Wasu filed his initial evidence. A hearing was held on 4 March 2019, at which Mr Wasu was represented by Mr Graham Johnson of Appleyard Lees IP LLP via video conference, whilst Mr Hussain attended in Newport.

### **Evidence**

6. Mr Wasu's first witness statement is dated 26 June 2018. Mr Hussain filed a witness statement dated 3 October 2018. Mr Wasu filed reply evidence by way of a witness statement dated 4 December 2018.

7. Mr Wasu states that the registration was assigned to Aspire Cuisine Limited by Perfect Pizza Limited on 1 August 2011. Aspire Cuisine Limited subsequently changed its name to The Perfect Pizza Company Ltd. Mr Wasu states that he was a director of The Perfect Pizza Company Ltd from 21 July 2011 until the appointment of administrators on 30 January 2015. On the latter date, The Perfect Pizza Company Ltd assigned the registration to Mr Wasu. He states that he has been an LLP Designated Member of Perfect Pizza Restaurants LLP since 12 January 2012.

8. Mr Wasu states that, in 2011, The Perfect Pizza Company Ltd developed a new logo but also continued use of the registered mark and consented to the use of the registered mark by franchisees. He refers to a 'specific example' of use during 2014 at a franchised takeaway restaurant in Fordhouses, Wolverhampton. Mr Wasu states that the franchise was terminated in 2014 and that the takeaway restaurant was subsequently operated by Perfect Pizza Restaurants LLP in 2015, 2016 and 2017. He states that in these three years the mark was used with his consent and the restaurant had an annual turnover in the region of £200,000. A valuation report was commissioned in 2014 for The Perfect Pizza Company Ltd (the then owner of

the mark). The report, dated 20 May 2014, comprises Exhibit JW1 and includes a schedule of photographs, including one of the service counter:



Fabricated Service Counter

Equipment for pizza-making is listed amongst the assets. I note that, at point 3.1, the report states “The company trades as a fast food takeaway premises on Stafford Road in Wolverhampton.”

9. Exhibit JW2 is described as a statement for costs payable to The Perfect Pizza Company Ltd by the Fordhouses restaurant under the franchise agreement during April and May 2014. The statement is dated 23 May 2014. The trade mark which appears on the statement is this:



The Perfect Pizza Company Ltd  
Bank House  
269-275 Cranbrook Road  
Ilford  
IG1 4TG

020 3137 8989  
020 3137 5272

## Remittance Advice

Remit to:-

The Perfect Pizza Company Ltd  
Bank House  
269-275 Cranbrook Road  
Ilford  
IG1 4TG

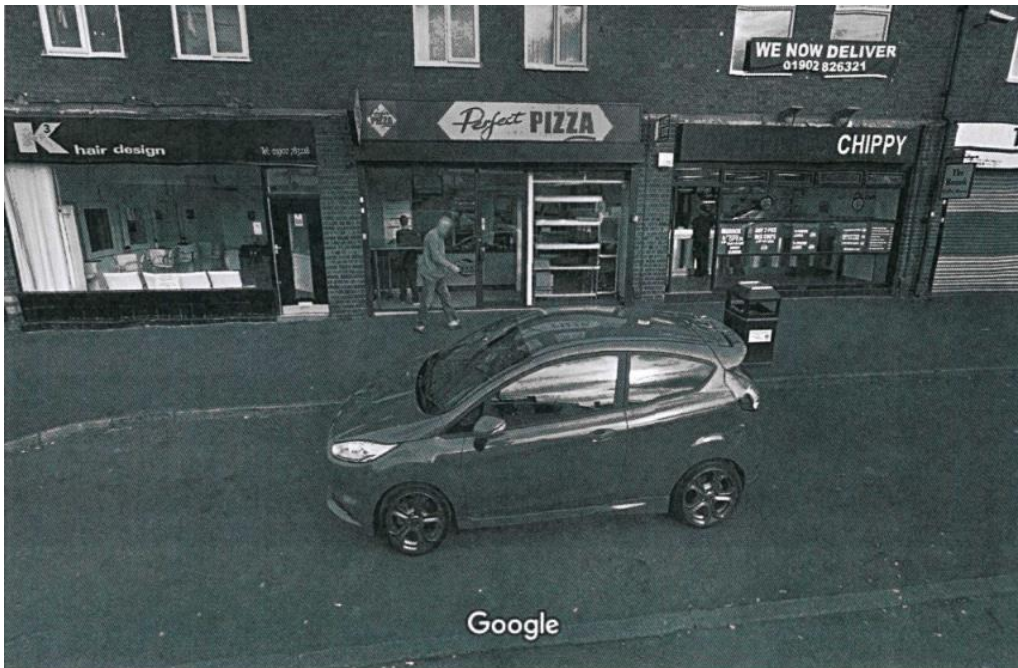
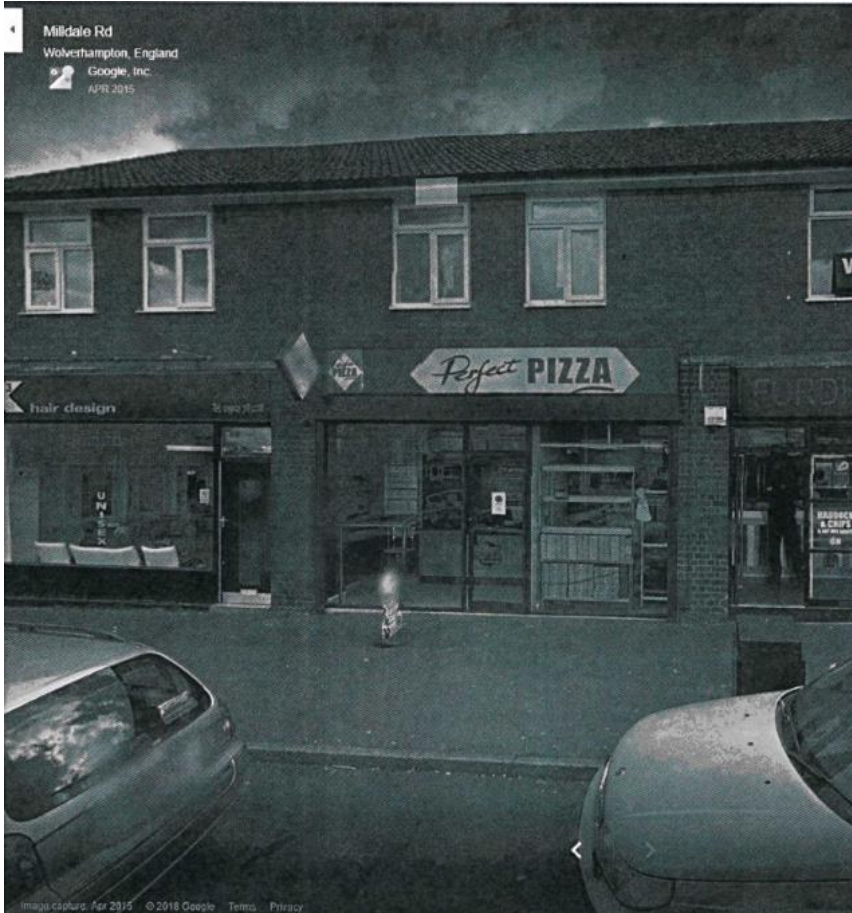
020 3137 8989  
020 3137 5272

10. Exhibit JW3 consists of extracts from a contract of employment relating to the Fordhouses restaurant between the manager and Perfect Pizza Restaurants LLP, dated 30 June 2014. Mr Wasu states that the registered mark was used at this time with his consent, continuing into 2015 and beyond. The trade mark on the cover page of the employment contract is this:



11. Mr Wasu states that after the Fordhouses restaurant franchise agreement was terminated, in 2014, elements of the store interior were updated when Perfect Pizza Restaurants LLP took over operation but the exterior store signage was not altered. Exhibit JW4 comprises a copy of a Google Maps street view image captured in April 2015. Mr Wasu states that the registered mark can be seen to the left-hand side of the sign above the restaurant and that the door is partially open, indicating trading. Mr Wasu was the owner of the mark at this time and he states that the use was with his consent, as it was throughout 2015, 2016 and 2017. The 2015 image is shown

below, with a similar Google Maps image from April 2017 exhibited at JW5, also shown below (with a customer inside the premises):





12. Mr Wasu states that the registered mark was in use by other franchised restaurants and by The Perfect Pizza Company Ltd, including website use. Mr Wasu describes Exhibits JW6 and JW7 as internet archive results for perfectpizza.co.uk dated 5 October 2011 and 10 July 2012, showing use of the mark:



Mad about pizza

Order Perfect Pizza we're mad about pizza. Order your delivery or takeaway online from Perfect Pizza, the home of the **Mega Deep Pan** and we will give you the best possible deal automatically. That's our **Perfect Price Promise**.

### 20% off box sets

Spend £20 and get your 20% off DVD boxsets voucher

[Order Now >>](#)

[T&Cs: apply](#)

### Perfect Pizza Points

Collect for FREE PIZZA  
Get Perfect Pizza Points every time you order

[Show me how! >>](#)

[T&Cs: apply](#)

### Monday Tuesday Madness

Buy One Get One FREE - every Monday and Tuesday  
Plus FREE delivery

[Order Now >>](#)

### **Our bestsellers**

#### Meat Feast



Now you can collect Perfect Pizza Points for FREE PIZZA online. Start collecting now!  
Spicy pork, ham, pepperoni and smoky sausage.

[Tasty!  
Register NOW](#)



MAD ABOUT PIZZA

Deals Menu Store f

DELIVERY COLLECT

# Perfect for 2012...

- Tasty NEW 'Classic Crust' base
- NEW sizes and extra value deals
- NEW Perfect Pepperoni pizza
- Plus a fresh NEW look



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Visit us on Facebook to tell us how we're doing

POINTS MA  
Love FREE pizza

Register now and every time you order online you'll collect Perfect Pizza Points for FREE PIZZA.

Perfect PIZZA  
Points  
REGISTER NOW

Now 10 slices (13.5") - perfect for hungry bellies!  
Or try (NEW!) Medium with 8 slices (11.5") it's brilliant value!



About us Contact Franchise information Privacy policy Sitemap Perfect Pizza Points Terms & Conditions

Join us on Facebook

Web design by STEEL

5w7-2

13. Mr Hussain's witness statement is dated 3 October 2018. This was filed following a case management conference (held on the same day) at which I allowed Mr Hussain further time to file his evidence, which had been due on 4 September 2018. The reason Mr Hussain requested extra time was the law firm he had originally appointed to represent him turned out to deal only with immigration law, a fact he had not known at the time, and that he had experienced a lack of professional advice. Mr Hussain's evidence was to hand by the time of the case management conference and was filed the following day.



14. Some of Mr Hussain's evidence is not relevant to the issues to be decided, or consists of submissions, so I note here only the facts which I consider to be relevant.

15. Mr Hussain explains that he was a franchisee of 'Perfect Pizza' in 2003, trading at 283 Barking Road, London E13 8EQ. He states that the franchise agreement came to an end in 2008 or 2009. Despite this, Mr Hussain states that, since that time, he has been trading under the name Perfect Pizza and in the form of the contested trade mark. His evidence shows various documents emanating from Mr Wasu in 2012 which show that Mr Hussain has continued to trade with some sort of quasi-franchisor/franchisee relationship existing between him and Mr Wasu (or Mr Wasu's company).

16. Mr Hussain states that Mr Wasu applied for the new trade mark (2605544) on 23 December 2011 and that he sent letters to all franchisees instructing them to alter the main outside boards and the projected signs in front of the franchised stores to reflect the new trade mark (2605544). Mr Hussain adds that Mr Wasu made the same instructions in relation to the ordering software. Exhibit ZH6 comprises an email sent by Mr Wasu, dated 8 February 2012 to 'plaiستowperfectpizza', and Exhibit ZH8 is a letter sent by Mr Wasu's company, dated 1 August 2012, both shown below:

Jat Wasu (The Perfect Pizza Company Ltd)

Wed 08/02/2012 22:15

JAT WASU

To:plaiستowperfectpizza@hotmail.com <plaiستowperfectpizza@hotmail.com>;



Zaheer,

Jat Wasu (The Perfect Pizza Company Ltd) has created a new File called 'PPC Brand Colour Pantone References.png' in folder '[Franchisees ALL Noticeboard/Marketing Alerts](#)'.

[Click here to download](#)



Ltd  
Gailey Park, Gravelly Way  
Standeford  
Wolverhampton WV10 7GW

Tel: 01902 797 100  
Fax: 01902 797 111  
www.perfectpizza.co.uk

**TO ALL FRANCHISEES**  
**FROM: MARKETING**

1 August 2012

## **WEBSITE MAINTENANCE**

Some maintenance work is required on the website – this is standard maintenance but it does require the site to be ‘down’ to administer.

As a result, the website will be offline from MIDNIGHT TONIGHT [weds 1<sup>st</sup> Aug] and will be back online for store openings tomorrow.

Those stores who are usually open beyond midnight, the holding page will have your opening hours and phone numbers on there so that customers have an easy reference for calling their order in.

Any queries, please email me on: [tracey.berman@perfectpizza.co.uk](mailto:tracey.berman@perfectpizza.co.uk) as soon as possible.

In addition, in the unlikely event that you experience any problems with the website orders tomorrow – please contact me urgently on 01372 220 938.

Regards  
Tracey

17. ‘Plaistowperfectpizza’ is Mr Hussain’s store, the address of which is shown on a menu in Exhibit ZH7 as 283 Barking Road.

18. Mr Hussain states that Mr Wasu also changed all packaging materials, menus and till receipts to show the new trade mark. Exhibit ZH7 comprises menus which carry the new trade mark, as shown in the image below:



One of the menus also shows the contested mark, together with an explanation that the logo has changed (below, on the left). This is the only time this mark appears in the menu; all the other logo use is of the new trade mark (as shown on the right).



19. The menus are undated; however, the menu which details the fact that the logo and colours have changed also carries a promotional offer expiring on 2 April 2012. The new trade mark can also be seen in a photograph produced by Mr Hussain (Exhibit ZH9), inside the shop on the counter (the photograph replicates the one exhibited by Mr Wasu, from April 2017):



20. At Exhibit ZH10, Mr Hussain exhibits ten invoices sent to his store from Mr Wasu's company. They are dated between 12 February 2012 and 15 November 2013. Only the first invoice shows the contested mark; the others all show the new trade mark, with the second invoice being dated a week later, 17 February 2012 (showing the new mark).

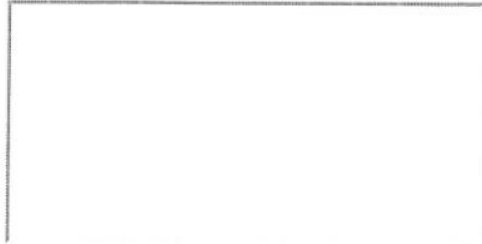
21. Exhibit ZH11 contains screenshot prints from the websites of ten stores. The screenshots all show the new trade mark and not the contested trade mark. The screenshots are dated 2 October 2018; however, they all bear a 2012 copyright date. Exhibit ZH11 also contains Wayback Machine prints from [perfectpizza.co.uk](http://perfectpizza.co.uk), from 15 February 2012 (shown below), 29 June 2012 and 10 July 2012 which show the new mark and refer to a 'fresh new look'. The contested mark is not shown.



DEC FEB MAR
15
2010 2012 2013
56 captures
21 Dec 2008 - 19 Aug 2013
About this capture



Make it perfect



[Pizza with family](#), [pizza with friends](#), or [pizza just for you](#)... Perfect Pizza makes any occasion perfect. Perfect Pizza is a pizza takeaway and delivery company that sells fantastic [hot pizzas](#), [tasty sides](#), [superb desserts](#) and [refreshing drinks](#).

Order your Perfect Pizza online or by phone for fast delivery.

Perfect Pizza always has great money saving [deals and discounts](#). These include buy one get one free pizza deals, any pizza any size deals and Monday-Tuesday pizza deals.

Order your delivery or takeaway online from Perfect Pizza and we'll give you the best possible deal automatically. That's our Perfect Price Promise.

Looking for your local pizza store? The Perfect Pizza [store locator](#) makes it easy.

Get rewarded with free pizza, for the pizza you buy, with our rewards scheme - it's called 'Perfect Pizza Points'. [Sign up for Perfect Pizza Points](#) and you will get 1 Perfect Pizza Point with every pizza order. Collect 6 Perfect Pizza Points and you can claim a free pizza.

Classic Perfect Pizza toppings include pepperoni, cheese, tomato, chilli, beef, pork, chicken, veg, tuna, sweetcorn, onions, olives, pineapple and garlic. Perfect Pizza sides include garlic bread, onion rings, chicken wings, potato wedges and delicious dips. Perfect Pizza sells delicious desserts including Ben & Jerry's ice cream, cheesecake and chocolate fudge cake. Perfect Pizza can quench your thirst with Coca Cola, Sprite, Dr Pepper and Fanta.

[Get in touch with Perfect Pizza](#) using our contact form and we will answer your questions.

Read the [Perfect Pizza privacy policy](#).

Interested in buying and running a Perfect Pizza franchise? Visit the [Perfect Pizza franchise sales and information website](#).



[If you love pizza \(and who doesn't\) register now and every time you order you'll earn points that will reward you with, well what else. FREE pizza](#)

## Delivery

[Collection](#)

Step 1

### Order now

To start, enter your postcode or [sign in](#)





22. Mr Hussain also provides evidence about a visit he made to the Fordhouses store on 24 August 2018. This is after the relevant dates. Mr Hussain appears to have included this because he spoke to the store manager about how long the new mark had been used, as opposed to the contested mark. Mr Hussain relates that the store manager told him that the new logo had been used for the last 6/7 years. This is pure hearsay evidence. Mr Hussain has not filed a witness statement from the (unnamed) store manager, although he could have done so. This particular part of Mr Hussain's evidence carries no weight.

23. Mr Wasu's second witness statement, dated 4 December 2019, replies to Mr Hussain's evidence. He states that the Fordhouses store has a prominent roadside position in a row of shops and that the signage depicting the contested mark is regularly seen by the passing public; before entering the store, customers have a clear view of the signage. He refutes Mr Hussain's contention that the signs have simply been left there after the logo changed and refutes the contention that the use is token. Mr Wasu states:

“...although franchisees were encouraged to make use of the new THE PERFECT PIZZA COMPANY figurative mark it was recognised that the figurative mark of UK2182923 had a reputation and that there was goodwill associated with the mark and that making and permitting continued use of the mark of UK2182923 was beneficial to the business. Accordingly, the mark continued to be used prominently at a number of locations and was still in use at a number of locations subsequent to 6 July 2012. Use has reduced over time but the reduction was gradual and there was still significant use across a number of locations at least as recently as 2015...”.

24. Mr Wasu refers again to the Fordhouses store but also makes reference to a Stevenage store. He states that the contested mark was used prominently on the front of the Stevenage store until at least late in 2015. He attaches (Exhibit JWA1) images obtained from Google with image capture dates of June 2012 and October 2015. The images are of poor quality and it is impossible to see what signage appears apart from one photograph from October 2015:



25. Mr Wasu also exhibits a screenshot print, like the prints in Mr Hussain's evidence, with a copyright date of 2012, showing the new trade mark:



26. Mr Wasu refers to the confusion at the beginning of Mr Hussain's statement about the latter's franchisee status. He points out that Mr Hussain's evidence shows that he was receiving franchisee correspondence in 2012. Mr Wasu states that any use of the contested mark by franchisees was with the consent of The Perfect Pizza Company Ltd, but that use after termination of a franchise would not have been with consent.

27. Mr Hussain also filed a witness statement on 11 February 2019 which appeared to respond to Mr Wasu's evidence-in-reply, although this occurred after the parties had been notified by the registry that the evidence rounds had concluded. The Registry wrote to the parties, on 15 February 2019, stating that the extra material would not be considered, save for that part of it which consisted of submissions. Mr Hussain did not respond to that letter but, two days before the hearing, he filed another witness statement. There was some confusion on Mr Hussain's part about

the right of reply; his latest witness statement was in reply to the Stevenage evidence in Mr Wasu's reply evidence. However, as I explained the Stevenage evidence was filed to respond to Mr Hussain's criticism in his evidence about there only being evidence from one store (Fordhouses). The latest witness statement was from the manager of the Stevenage store (Mr Ullah) and would have meant that Mr Wasu should have the right of reply to it, turning the evidence rounds into a potential tennis match. Mr Hussain could have requested to file such evidence once he had seen Mr Wasu's evidence in reply. Instead, it appeared two days before the hearing, some three months later. I refused to admit the evidence.

## **Decision**

28. Section 46 of the Act states:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

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

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



the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

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

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

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

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from——

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

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

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

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung 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].”

30. The onus is on Mr Wasu to show use because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

31. Mr Wasu, in his second witness statement, says:

“It would be perfectly possible for me to own a single take-away restaurant which used the mark as depicted in United Kingdom trade mark registration number 2182923 only on the outside thereof and for that registration still to be valid.”

32. This statement over-simplifies the law. In *La Mer*, there was use of the mark by a single client in relation to imported goods, which was deemed to be sufficient to demonstrate that such use was genuine because it was found that the import operation had a genuine commercial justification for the proprietor. In contrast, *Reber* concerned a single chocolate shop in Germany. Commercial use was proven, but it was not found to be genuine. The point in both these cases is that the evidence, as a whole, must present a picture of real commercial exploitation of the mark, which includes whether the use is warranted in the economic sector concerned to maintain or create a share in the market. In *SdS InvestCorp AG v Memory Opticians Ltd* (BL O/528/15), Professor Ruth Annand, sitting as the Appointed Person, observed that “it is clear from the CJEU case law including *Reber* that the relevant question for the tribunal to address is whether the proven use was commercially warranted in the marketplace taking account of all the relevant facts and circumstances of the case, which are interdependent.” I am required to look at the evidence as a whole and not necessarily to conclude that the presence on one (or two) shop front(s) of the contested mark automatically equals genuine use.

33. The present case is concerned with takeaways/pizza takeaways. Mr Wasu is best placed to show evidence that, in the relevant periods, he, or his predecessors-in-title, were engaged in maintaining or creating a share in that market. However, the evidence which he has provided is thin. There is a huge market in the UK for such goods and services. Mr Wasu’s evidence-in-chief concerns only the Fordhouses shop. He states that the mark was in use by other franchised shops, but does not back this up. Mr Wasu’s evidence-in-reply purports to show the contested mark on a Stevenage shop, but in only one of the photographs is it possible to take an educated guess that the contested mark appears alongside the words “Perfect Pizza” on the shop signage. In fact, that is a guess based upon what the



Fordhouses shop looked like. It is not solid evidence. The evidence provided by a proprietor must, given the burden, be taken as being the best evidence that the proprietor can show. In *Plymouth Life Centre*, O/236/13 Mr Daniel Alexander QC, sitting as the Appointed Person, observed that:

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

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

34. There is no evidence of the contested mark having been promoted, for example in menus, flyers or posters. With regards to internet use, Mr Hussain has filed evidence from the Wayback Machine (Exhibit ZH11, paragraph 21 of this decision) which contradicts or at least raises a question about Exhibits JW6 and JW7 (at paragraph 12 of this decision). In particular, how it is that the new trade mark is shown on the website on 15 February 2012, 29 June 2012 and 10 July 2012, according to Mr Hussain’s evidence, but Mr Wasu’s evidence shows the contested trade mark on the website on 10 July 2012, the same date as the third example shown by Mr Hussain which shows the new trade mark. This point has gone unanswered by Mr Wasu, casting doubt upon the probity of the internet prints.

35. It is curious that on the one hand Mr Wasu states that the new logo was developed in 2011 and that he/his company consented to use of the old mark by franchisees, but that Mr Hussain states that Mr Wasu sent instructions to franchisees early in 2012 to change the main outside signage boards to reflect the new trade mark. This appears to be corroborated by the reference on a menu to a change of logo:



36. Although the menu is undated, it helps to form a picture that the public was being educated early in 2012 that the logo had been changed. It is more than likely that this occurred in 2012 because the new trade mark was filed in December 2011; Mr Hussain received an email on 8 February 2012 (showing the new trade mark), the content of which was about the new trade mark; and, in particular, the menu carries a promotional offer which expired on 2 April 2012. The website screenshots showing the new trade mark all have a copyright date of 2012.

37. The photographs of the Fordhouses store, exhibited by Mr Wasu, show the inside of the store, with the customer counter showing the new trade mark. The first photograph is dated in April 2015. Mr Wasu confirms that the inside of the store was updated after the franchise agreement was terminated in 2014. The valuation report (Exhibit JW1) shows a counter with the contested trade mark. Mr Wasu states that the restaurant had an annual turnover of £200,000 in 2015, 2016 and 2017. However, he does not mention any turnover prior to that date. By 2015, 2016 and 2017, the internal signage showed the new trade mark. This is the high point of Mr Wasu's evidence, that the Fordhouses store appeared to have a counter (and external signage) showing the contested mark in 2014. It appears that the shop operated in 2014, prior to the termination of the franchise, because Exhibit JW2 is a copy of an invoice sent to the store by the then proprietor of the trade mark. The new trade mark appears on the invoice.

38. Mr Wasu does not provide any turnover details or examples of promotional material from the Fordhouses shop. The contract of employment for the new store manager in 2014 (Exhibit JW3) has the new trade mark on the cover page. Given the menu dating of 2012, referred to earlier, I conclude that there is no promotional literature from the Fordhouse store showing the contested mark because, at least by 2014, it was the new mark that was in use on all promotional literature.

39. I also conclude that, early in 2012, it was the new mark which was adopted and which was promoted to the public. The livery, logos and colours changed in 2012. That the contested mark still appeared on the outside of the Fordhouses store up until 2017, and on the outside of the Stevenage store in 2015, appears to be an oversight, or a lack of action in changing the external signage on the part of the franchisees of those stores. The insides of those stores bore the new branding and colours. The remaining signage showing the contested mark does not appear to me to be sham or token use for the purpose of preserving the registration; I think it results from an oversight/lack of action by individual franchisees.

40. Does the fact that the signage is there, nevertheless, constitute trade mark use according to the essential function of trade marks which is to enable consumers to distinguish the goods and services of one undertaking from another? Mr Wasu's position is that the external signage plays a key role in attracting customers. However, taking into account all the relevant facts and circumstances, I do not agree with that view. Certainly, after February 2012, the attention of consumers was being directed to the new mark. Mr Wasu (or predecessors-in-title) did nothing to draw attention to the contested mark other than to say that it had changed to the new mark. This does not indicate a business endeavouring to create or maintain a market share in relation to the contested mark. This very low-key use, coupled with the very geographically limited use shown in the evidence, is insufficient to constitute real commercial exploitation of the contested mark in the UK market for these particular goods and services. I, therefore, find that Mr Wasu has not shown that the contested mark was put to genuine use in the UK after February 2012.

41. This leaves a question as to the position between 1 August 2011 and February 2012. As said earlier, the burden is on Mr Wasu to produce satisfactory, solid

evidence. There is no satisfactory evidence of use of the contested mark during this period.

### **Outcome**

42. The application for revocation succeeds in full. Under section 46(6)(b) of the Act, the registration is revoked from 1 August 2016.

### **Costs**

43. Mr Hussain is the successful party and is entitled to a contribution to his costs, on the scale published in Tribunal Practice Notice 2/2016. As is standard practice, the Tribunal sent Mr Hussain a blank costs proforma to fill in and return to the Tribunal if he wished to receive a contribution towards his costs, if successful. The costs proforma was sent to Mr Hussain on 12 December 2018, under cover of a letter of the same date concerning the end of the evidence rounds and the next steps in the proceedings. Mr Hussain was given until 27 December 2018 to return the costs proforma, but did not do so. The letter stated that if the form was not completed and returned to the Tribunal, no costs, other than official fees, would be awarded. In the circumstances, I make no award for costs save the reimbursement of the official fee for filing the application for revocation, £200.

44. I order Jatinder Singh Wasu to pay to Zamir Hussain the sum of **£200**. 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 13 May 2019**

**Judi Pike**

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