

**BL O-544-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**APPLICATION NO. 502840**

**TO REVOKE ON THE GROUNDS OF NON-USE**

**TRADE MARK REGISTRATION**

**NO. 3043633**

**OF THE MARK:**

**RECIPES**

**OWNED BY**

**MADES COSMETICS B.V.**

## **Background**

1. These proceedings concern the trade mark **RECIPES** which was filed on 21 February 2014 and entered in the register on 30 May 2014. The trade mark is registered in class 3 in the name of Mades Cosmetics B.V. (“the proprietor”) in respect of the following goods:

Soaps; perfumery; bath products ; body care products; cosmetics, hair care.

2. On 4 October 2019, The Procter & Gamble Company (“the applicant”) applied for the revocation in full of the above trade mark, relying upon section 46(1)(b) of the Trade Marks Act 1994 (“the Act”). Under this section, “the relevant period” is 2 October 2014 to 1 October 2019, with revocation sought from 2 October 2019.

3. The proprietor filed a counterstatement in which it indicates it is defending the application in respect of all the goods for which its trade mark is registered.

4. In these proceedings the applicant is represented by D Young & Co LLP; the proprietor represents itself. Although only the proprietor filed evidence, the applicant filed written submissions during the evidence rounds. While neither party asked to be heard, both filed written submissions in lieu of attendance.

## **Issue arising prior to the preparation of the substantive decision**

5. In its submission filed in lieu of a hearing, the applicant stated:

“13. In the revocation of Guccio Gucci SPA's UK Registration No. 1082541 (O-441-13), the Hearing Officer opens the decision with the following statement:

“In *La Mer Technology v. Laboratoire Groemar*, the Court of Appeal emphasised the importance of dotting the i's and crossing the t's in the evidence of use in proceedings where a mark is challenged on the grounds of non-use. This case emphasises the importance not just of doing that but also of doing so in the first round of evidence and not

relying on the possibility of being able to bolster inadequate evidence of use at a later stage of the proceedings.”

14. The remedied invoices should be disregarded in their entirety as they constitute new evidence, the submission of which has not been deemed permissible by the Court.

15. In addition to the remedied invoices, the Registered Proprietor has submitted two entirely new pieces of evidence. Neither of the new pages have been properly formatted or labelled as separate Exhibits, the Registered Proprietor merely states that these have been “added to these final submissions in exhibit JD8”.

18. The principle set out above regarding “the importance of dotting the l’s and crossing the t’s... in the first round of evidence and not relying on the possibility of being able to bolster inadequate evidence of use at a later stage of the proceedings” should apply here and consequently the new evidence should clearly be struck out on procedural grounds.”

6. In an official letter to the parties dated 1 July 2020, the tribunal stated:

“Before the case is passed to a Hearing Officer for substantive determination, the tribunal notes that the proprietor’s “Final submissions” contains submissions and documentation which ought to have been filed in the form of a witness statement accompanied by exhibits.

In an official letter to the parties dated 23 April 2020, the tribunal stated:

“...The applicant has filed submissions in support of their application received on 22 April 2020. You should have received a copy of these submissions. As they have not filed any evidence of fact, the evidence rounds are now concluded.” (my emphasis)

Given the nature of the applicant's submissions filed on 22 April 2020, the above approach was, on this occasion, inappropriate. Rather, what the tribunal ought to have done was to give the proprietor an opportunity to indicate if it wished to file evidence of fact in reply to the applicant's written submissions and, if it did, to allow it a period for such evidence to be filed.

Rule 74 of the Trade Marks Rules 2008 reads:

“74.—(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made

(a) after giving the parties such notice; and

(b) subject to such conditions, as the registrar may direct.”

As on this occasion the tribunal's approach was inappropriate, it is my preliminary view that matters should be corrected by invoking the provisions of rule 74.

For the avoidance of doubt, this is not an opportunity for the proprietor to file submissions and evidence beyond that which was contained in its “Final submissions.” It is simply an opportunity for the proprietor to do now what it ought to have been given an opportunity to do during the evidence rounds. As a consequence, the proprietor is allowed 28 days from the date of this letter, that is on or before 29 July 2020, to resubmit such submissions and documentation as it considers appropriate in proper evidential format and to copy same to the applicant. As indicated above, any evidence filed must be no different to that already contained in the proprietor's “Final submissions”. If the proprietor elects to adopt this approach and as its unredacted documentation has already been copied to the applicant, it should be aware that

in the absence of any justifiable request for such information to be declared confidential and withheld from the public at large, some or all of its contents may be relied upon by the Hearing Officer in the substantive decision.

If the proprietor elects to resubmit its submissions/documentation in proper evidential format, the applicant will be allowed a period of 28 days from its receipt of same in which to request a hearing to challenge the preliminary view mentioned above. If it elects not to challenge the preliminary view, the same period is allowed for it to either request a substantive hearing or to amend its written submissions filed in lieu.

If the proprietor chooses not to provide its submissions/documentation in proper evidential format, the case will proceed to substantive determination on the basis of the papers currently on file.”

7. In an official letter sent to the proprietor of 21 July 2020, the Tribunal stated:

“Your email of 16 July 2020 and the submissions and documents attached thereto refer.

Although your covering email refers to “our statement with exhibits in a proper evidential format”, the tribunal does not appear to have received a witness statement to which the documents provided have been exhibited. The tribunal does, however, note that no request has been made for the documents provided to be withheld from the public at large.

You are now allowed a final period of 14 days from the date of this letter, that is on or before 4 August 2020, to resubmit such submissions/documentation as you see fit in the form of a witness statement accompanied by exhibits and to copy same to the applicant.

If you elect to resubmit such submissions/documentation in the format indicated, the applicant will be allowed a period of 28 days from its receipt of same in which to request a hearing to challenge the preliminary view mentioned in the

official letter of 1 July. If it elects not to challenge the preliminary view, the same period is allowed for it to either request a substantive hearing or to amend its written submissions filed in lieu.

If you choose not to provide submissions/documentation in the format indicated, the case will proceed to substantive determination on the basis of the papers currently on file.”

8. On 31 July 2020, the proprietor re-filed the documents in the correct evidential format and, on 19 August 2020, the applicant requested an interlocutory hearing to challenge the preliminary view expressed in the official letter of 1 July 2020. That hearing took place before the Hearing Officer, Ms Venables, on 9 September 2020. In her letter of 24 September 2020, Ms Venables stated:

“I note the section of the Trade Marks Manual referred to by Ms Kirkland, however, I bear in mind that the Trade Marks Manual is guidance only and allows for the normal run of proceedings.

In this case the Registrar chose to invoke rule 74 of the Trade Marks Rules 2008 to rectify an irregularity in procedure; the irregularity being that the proprietor should have been given the opportunity to file evidence in reply to the cancellation applicant’s written submissions during the evidence rounds. Rule 38(8) of the Trade Marks Rules 2008 deals with revocation proceedings on the ground of non-use and gives discretion to the Registry to allow evidence into proceedings at any time. Rule 38(8) states:

“(8) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

There is no rule that a party cannot file evidence in reply to written submissions; whether there is a right of reply will depend upon the content of the written submissions. Where the written submissions filed by a cancellation applicant directly challenge the evidence in chief filed by the proprietor of the contested mark, that may give rise to a right of reply to enable the proprietor to address

those challenges. That is the case here and that is why the Registry invoked the provisions of rule 74 and in so doing gave the proprietor the opportunity to file evidence in reply.

I also bear in mind the comments of Mr Justice Henry Carr in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), where he stated, at paragraph 41:

“There was very significant prejudice to TTL if the evidence was excluded, in that it stood to lose a valuable registered trade mark. This, in my judgment, outweighs any prejudice to Titanic Huddersfield if the evidence was admitted.”

That is the case here. Whilst there is some prejudice to the cancellation applicant, it is outweighed by the prejudice to the proprietor in that it could stand to lose its registered trade mark if the evidence is excluded from the proceedings.

### Conclusion

The preliminary view set out in the Registry’s letter of 1 July 2020 is maintained. The cancellation applicant has 14 days from the date of this letter, i.e. on or before 8 October 2020, to file amended written submissions in lieu of a hearing. The case will then be passed to a Hearing Officer for a substantive decision.”

9. The applicant elected not to appeal that decision and, on 7 October 2020, it filed amended written submissions.

### **The proprietor’s evidence**

10. This consists of two witness statements, dated 30 November 2019 and 30 July 2020 from the proprietor’s Managing Director, Joel Desensy, a position he has held since 1992. He states:

“Mades Cosmetics is a leading company active within the cosmetics industry. It develops and manufactures high-quality bath-, body-, hair- and skin care products which are marketed under a broad range of product lines and which are distributed on a global scale. Mades Cosmetics is selling its products to major retailers in department stores, higher end hypermarkets, drugstores and beauty product retailers in more than 50 countries.”

11. Mr Desensy further states that the trade mark under attack:

“...is used by Mades Cosmetics as the name of one of its basic product lines... Under the RECIPES product line, Mades Cosmetics is offering a variety of cosmetic products ranging from body lotion to body wash, body scrub, body milk, hand cream, shampoo and conditioner, all of which bearing the name 'RECIPES'. The RECIPES product line was first included in the basic collection of Mades Cosmetics in 2014 and has remained part of its basic collection up to this day...”

12. Exhibits JD2 to JD7 consist of copies of the proprietor’s product catalogues from 2014 to 2019 which, Mr Desensy states are:

“disseminated by Mades Cosmetics...to its (potential) distribution partners for promotional purposes.”

The cover page of the 2014 product catalogue looks like this:





13. As one can see, the proprietor's name appears at the top right of the page as does the word "RECIPES" (preceded by the word "mades" and a stylised letter "R"). Mr Desensy's image can be found on page 3 of the exhibit in which he is identified as "Managing Director." On page 4 of the exhibit, under the heading "MADES COSMETIC BRANDS", there appears the word "RECIPES". Page 6 of the exhibit looks like this:



**RECIPES FRUITY FESTIVAL** with a cocktail of fruit extracts known to create a refreshed skin

art.number	description	contents	colour	fragrance	extract	outer	inner
2703801	violet PET bottle body wash	400 ml	white	fruity festival	cocktail of fruits	24	6
2703802	orange PET bottle body lotion	350 ml	white	fruity festival	cocktail of fruits	24	6
2703803	solid violet tube body sugar scrub	250 g	white	fruity festival	cocktail of fruits	24	6
2703804	solid orange tube body butter	200 ml	white	fruity festival	cocktail of fruits	24	6
2703805	solid violet tube volumising shampoo	200 ml	clear	fruity festival	cocktail of fruits	24	6
2703806	solid orange tube volumising conditioner	200 ml	white	fruity festival	cocktail of fruits	24	6



**RECIPES SPICY SENSATION** with pink pepper extract known to create a re-energised skin

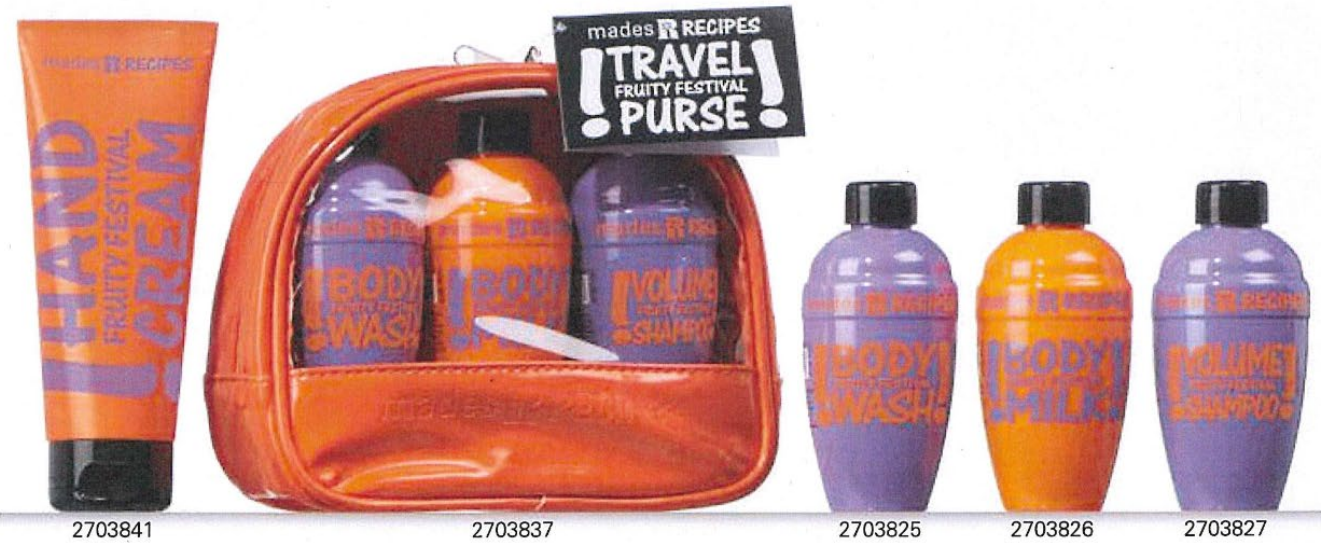
art.number	description	contents	colour	fragrance	extract	outer	inner
2703807	yellow PET bottle body wash	400 ml	white	spicy sensation	pink pepper	24	6
2703808	pink PET bottle body lotion	350 ml	white	spicy sensation	pink pepper	24	6
2703809	solid yellow tube body sugar scrub	250 g	white	spicy sensation	pink pepper	24	6
2703810	solid pink tube body butter	200 ml	white	spicy sensation	pink pepper	24	6
2703811	solid yellow tube volumising shampoo	200 ml	clear	spicy sensation	pink pepper	24	6
2703812	solid pink tube volumising conditioner	200 ml	white	spicy sensation	pink pepper	24	6

14. Exhibit JD3, which consists of a copy of the 2015 product catalogue, is much the same. On page 4 of the exhibit there appears a reference to “mades RECIPES”. Page 9 of the exhibit looks like this:



**MADES RECIPES FRUITY FESTIVAL** with a cocktail of fruit extracts known to create a refreshed skin

art.number	description	contents	colour	fragrance	extract	outer	inner
2703801	violet PET bottle body wash	400 ml	white	fruity festival	cocktail of fruits	24	6
2703802	orange PET bottle body lotion	350 ml	white	fruity festival	cocktail of fruits	24	6
2703803	solid violet tube body sugar scrub	250 g	white	fruity festival	cocktail of fruits	24	6
2703804	solid orange tube body butter	200 ml	white	fruity festival	cocktail of fruits	24	6
2703805	solid violet tube volumising shampoo	200 ml	clear	fruity festival	cocktail of fruits	24	6
2703806	solid orange tube volumising conditioner	200 ml	white	fruity festival	cocktail of fruits	24	6



**MADES RECIPES FRUITY FESTIVAL** travel kit – mini bottles – hand cream

art.number	description	contents	colour	fragrance	extract	outer	inner
2703825	violet PET mini bottle body wash	100 ml	white	fruity festival	cocktail of fruits	24	6
2703826	orange PET mini bottle body milk	100 ml	white	fruity festival	cocktail of fruits	24	6
2703827	violet PET mini bottle volumising shampoo	100 ml	clear	fruity festival	cocktail of fruits	24	6
2703837	travel purse orange with 3 mini bottles • body wash • body milk • shampoo	3x 100 ml	white-clear	fruity festival	cocktail of fruits	24	6
2703841	solid orange tube hand cream	100 ml	white	fruity festival	cocktail of fruits	24	6

15. Exhibits JD4 to JD7 are similar to the previous product catalogues. Mr Desensy states:

“Within the period between 2 October 2014 and 1 October 2019... a range of the products of the RECIPES product line were purchased from Mades Cosmetics by two retail chains located in the UK...”

16. Exhibits JD8 to JD14A (now replaced by exhibits JD20 to JD27) consist of a range of invoices issued by the proprietor. The proprietor’s name and address appears on all the invoices. The first invoice, exhibit JD20, is dated 3 September 2014 (with a “due date” of 2 November 2014) and is addressed to Superdrug Stores plc (“Superdrug”) at an address in Croydon and a delivery address in Pontefrac, West Yorkshire. In its written submissions filed in lieu of a hearing, the proprietor states:

“Superdrug Stores plc (trading as Superdrug) is a very well-known health and beauty retailer in the United Kingdom with more than 700 stores and is the second largest drugstore next to Boots UK.”

The invoice consists of eight entries entitled either “MADES RECIPES” or “mades RECIPES”. The goods listed are as follows: body butter, body lotion and body sugar scrub. The total quantity of goods supplied amounts to 37,602 with the value of the invoice, expressed in “Total GBP”, amounting to £45,122.40

17. The remaining invoices, which are dated 14 June 2017 (exhibits JD21-JD-24), 30 August 2017 (exhibits JD25 and JD26) and 11 September 2019 (exhibit JD27) are addressed to TJX Europe Buying Limited (“TJX”) at an address in Watford. The delivery address of the invoices at exhibits JD21-JD26 is shown as: “Fashion Wheels B.V., Vossebeemd 111G, 5705 CL Helmond” and of invoice JD27 as: “MODEXPRESS, Vuurijzer 23, 5723 SV DEURNE.” Despite the delivery addresses being outside of the UK, in its written submissions filed in lieu of a hearing, the proprietor states:

“TJX Europe is a leading off-price retailer worldwide, including the UK. The invoices are directed to the company located in Watford, Hertfordshire for re-selling the Mades Recipes products in the UK.”

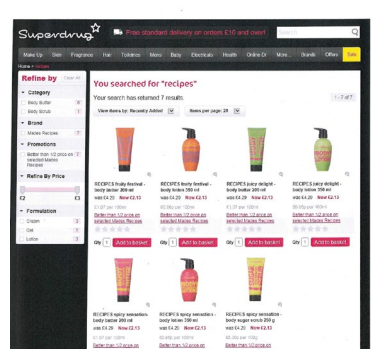
Once again the proprietor’s name and address appears on all the invoices. All of the invoices contain references to “mades RECIPES” or “MADES RECIPES”. The goods identified are: body wash, body lotion, body sugar scrub, body butter, body milk and shampoo. The total quantity of goods supplied/values of the invoices, expressed in “Total EUR”, is as follows: 600/€1449, 600/€1449, 120/€289.80, 120/€289.80, 1704/€3742.20, 432/€990 and 582/€1164. That amounts to a total quantity/value of 4158/€9373.80.

18. Mr Desensy states that exhibit JD15 contains a picture “of various products of the RECIPES product line on the shelves of a retail store located in the UK”. He further states:

“The picture in this exhibit...shows the moment on which it was taken (i.e. 9-10-2014).”

The exhibit consists of two photographs (which appear to be identical) showing a number of the proprietor’s goods bearing the word “RECIPES” (preceded by the word “mades” and a stylised letter “R”) on a retail shelf. The items are priced in “£”. On the second page there appears a computer generated insert in Dutch which includes a reference to “Gewijzigd donderdag 9 October 2014, 12:07:46” and to “Locatie....superdrug.”

19. The first page of exhibit JD16 looks like this:



20. The exhibit consists of two screen prints. The second screen print is identical to the first, save that it also includes a computer generated insert in Dutch which includes a reference to “Gewijzigd vrijdag 23 Januari 2015,12:02:45”. Mr Desensy states this exhibit contains a screen print:

“...of the online web shop of retail chain Superdrug Stores offering a range of products of the RECIPES product line to the public in the UK. The second screen-print in this exhibit JD16 shows the moment on which the screen-print was taken (i.e. 23-01-2015). The web shop displays the products of the RECIPES product line which were purchased by Superdrug Store from Mades Cosmetics on 02-11-2014...”

21. Mr Desensy states that exhibit JD17 contains:

“...a screen print showing a review of a product of the RECIPES product line....The review was placed on June 7<sup>th</sup> 2016 by a customer which purchased fore-mentioned product in one of the Superdrug stores located in the UK...”

22. The page provided is in relation to “mades RECIPES – Sugar Scrub (ALL Scents)”, is dated “Jun/07/2016” and contains the following “\$\$\$\$ price range”. No indication is provided of the website on which the review appeared. The reviewer states:

“I purchased two of these from my local Superdrug store (where I think they’re sold exclusively) for £4.99 each, thinking they might be comparable to the Tree Hut sugar scrub (which are difficult to find in the UK) or The Body Shop version. Sadly they really weren’t...”

23. Mr Desensy states that exhibit JD18:

“contains two screen-prints of the website of Mades Cosmetics in 2016 which were recently retrieved from the website web.archive.org, I added the screen-prints so as to demonstrate that Mades Cosmetics was offering the products of

its RECIPES product line at a global level, including at national (UK) level, on Its own English website within the Relevant Period.”

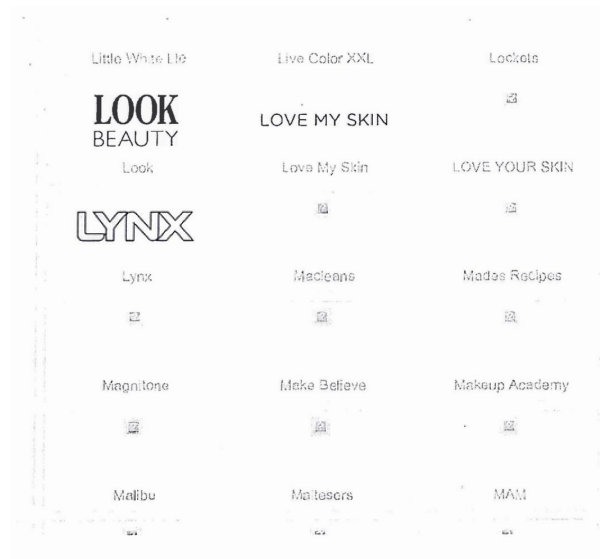
24. Mr Desensy states that exhibit JD19:

“contains two screen-prints of the website of Mades Cosmetics in 2019. The first image displays how the website looked like In August 2019, the second shows the website in its most recent form. I added the screen-prints in order to emphasize that, since its introduction in 2014, the RECIPES product line forms part of the basic collection of Mades Cosmetics and as such is of significant value to the company.”

25. Mr Desensy states that exhibit JD28:

“...contains a screen-print dated 22 October 2014 of the website of Superdrug taken from the Wayback Machine showing the registered trademark placed on the page of the Superdrug website amidst the other brands sold by Superdrug. This evidence displays that the Recipes products were available via Superdrug in October 2014. This finding is supported by the fact payment was made end October and as a result must have been in stock for sales purposes.”

26. A portion of the page referred to looks like this:



27. Mr Desensy states that exhibit JD29:

“contains a printout bank transfer Rabobank/confirmation of payment dates 14<sup>th</sup> of October 2014. Although the invoice to Superdrug Stores was dated 3rd September 2014 (due payment: 2<sup>nd</sup> November 2014), the payment was made on 15 October 2014, thus falling within the relevant period of 2nd October 2014 - 1 October 2019. The transfer of the amount of GBP 45.122,40 can be retrieved from the bank account of Mades Cosmetics with a confirmation of the payment date.”

The page provided appears to show a payment made by Superdrug to the proprietor on 14 October 2014 in the amount of “GBP 44.205.83.” No explanation is provided as to why the amount paid to the proprietor differs from that of the invoice at exhibit JD20 i.e. “£45.122.40.”

28. That concludes my summary of all the evidence filed in these proceedings to the extent I consider it necessary.

### **Legislation and leading case-law relating to revocation**

29. The pertinent legislation is contained in section 46 of the Act, the relevant parts of which read:

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

(a)...

(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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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.”



30. Section 100 is also relevant; it reads:

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

31. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

## DECISION

32. I begin by reminding myself of the relevant period in play in these proceedings i.e. 2 October 2014 to 1 October 2019. 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.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

33. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes

be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

34. As the proprietor’s Managing Director since 1992, Mr Desensy is well placed to give evidence on its behalf. He states that the “RECIPES” product line was first included in the proprietor’s basic collection in 2014. He provides a range of product catalogues from 2014 to 2019 in support. Although Mr Desensy states that the product catalogues are “disseminated by Mades Cosmetics...to its (potential) distribution partners for promotional purposes”, as the applicant points out, there is no evidence to demonstrate that these catalogues were distributed in the United Kingdom.

35. Although the word “RECIPES” appears in all of these catalogues, in the catalogues and in use on the goods and in invoices it is often accompanied by the word “mades” or “MADES” or the word “mades” and a stylised device of a letter “R”. However, for the reasons explained by the Court of Justice of the European Union (“CJEU”) in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, that sort of use does not count against the proprietor.

36. The proprietor has filed eight invoices in support of its claim to genuine use. The invoice addressed to Superdrug (exhibit JD20) is dated 3 September 2014 (which is prior to the relevant date) and has a “due date” of 2 November 2014 (which is within the relevant period). In its submissions, the proprietor provides details of Superdrug (paragraph 16 above). Although it has filed no evidence in support of those details, as the applicant does not appear to take issue with them, I shall proceed on the basis they are not disputed.

37. As I mentioned earlier, the invoice consists of eight entries entitled either “MADES RECIPES” or “mades RECIPES”, the goods listed are: body butter, body lotion and body sugar scrub. A total quantity of 37,602 items were supplied with the value of the invoice, expressed in “Total GBP”, amounting to £45,122.40. In its submissions, the applicant argues that this invoice cannot be taken into account as it dates from before the relevant period. While it is true that the invoice dates from before the relevant period began, I must consider the relevant timeline i.e.:

- Exhibit JD15 consists of a photograph which Mr Desensy states was taken on 9 October 2014 and which he describes as showing “various products of the RECIPES product line on the shelves of a retail store located in the UK”;
- Exhibit JD29 indicates that an invoice in the amount of GBP £44,205.83 was paid by Superdrug on 14 October 2014;
- Exhibit JD28 consists of an extract obtained from the waybackmachine Internet archive which shows that the words “Mades Recipes” appeared on the a-z brands section of the Superdrug website on 22 October 2014.
- Exhibit JD16 contains images of the proprietor’s products (priced in £) which Mr Desensy states appeared on the Superdrug website in January 2015;
- Exhibit JDF17 is a review one of the proprietor’s products posted on 7 June 2016.

38. In its written submissions filed on 22 April 2020, the applicant stated:

“14. Exhibit JD15 purports to show photographs of the Proprietor’s products on sale in a UK store; however, the Applicant notes that the pictures are not clearly dated. The screenshot on the second page of the Exhibit, which appears to show the picture data, is not provided in English so it is not clear when the photograph was taken. Additionally, the screenshot showing the picture data, appears to have been superimposed onto the Exhibit. As the date the original photograph was taken is not clearly demonstrated, the evidence is deemed insufficient to prove genuine use during the relevant time period.”

39. In its written submissions filed in lieu, the proprietor stated:

“Applicant suggests that the photographs are manipulated. Although the picture of the display might not be very clear, one can clearly perceive the pricing in pound sterling and the range of the products as branded under the registered trade mark Recipes.”

40. In its written submissions filed on 22 April 2020, the applicant stated:

“15. Exhibit JD16 contains a webpage printout from the Superdrug website. As with the previous Exhibit, a screenshot of the picture data appears to have been added to the photograph. Again the picture data has not been translated, but it appears to indicate that the picture was created on 23 January 2015. However, at the top of the imposed window screenshot, the picture name is provided as “23012014”, suggesting the screenshot was taken on 23 January 2014, so it is not clear that this is relevant use either. Due to the inconsistencies in the only photographic data provided, the Applicant does not consider this to constitute proof of genuine use within the relevant time frame.”

41. In its written submissions filed in lieu, the proprietor stated:

“The picture of the Superdrug website was created on 23 January 2015 as can clearly be seen in the creation date of the file (see exhibit JD16: “Gemaakt” in the “pop-up” frame as shown on the screen shot. Due to a typo indeed the file

name was named “23012014”, but the file name is not relevant, the creation date of the screen print is. Moreover, since the very first order and delivery of the Recipes products at Superdrug Stores dates from September 2014 it is impossible that the screenshot was taken in January 2014...”

42. If one reviews what Mr Desensy refers to as the pop-up frame in exhibits JD15 and JD16, one can identify dates of “9 oktober 2014” and “23 januari 2015.” However, these entries are against the word “Gewijzigd” (for which no translation has been provided) and not “Gemaakt” as Mr Desensy suggests in relation to exhibit JD16. Against the word “Gemaakt” which Mr Desensy states means “creation”, in both exhibits there appears “maandag 9 april 2018, 22:28.07” (which is, of course, within the relevant period).

43. In its written submissions filed on 7 October 2020, the applicant stated:

“23. For example, the Registered Proprietor included a retail photograph to substantiate proof of use. In their final submissions the Registered Proprietor admits the quality of the photograph “might not be very clear” and “due to a typo” was incorrectly named with a date which suggests the photograph is outside the relevant time frame. Taking into consideration the relevant facts and circumstances, the nature of the goods, the characteristics of the market concerned, the Applicant asserts that the evidence available is unsubstantial and contains various errors and irregularities which is inconsistent with the level of use/available evidence expected for the market.”

44. Despite the inconsistencies mentioned in paragraph 42 above, in its submissions filed on 7 October 2020, the applicant focuses on the quantum of use rather than challenging Mr Desensy’s statements regarding “...the moment on which [the photograph] was taken” (exhibit JD15) and “the moment on which the screen-print was taken” (exhibit JD16). As a consequence, I intend to proceed on the basis that the photograph/screen-print in exhibits JD15 and JD16 were taken on 9 October 2014 and 23 January 2015 as Mr Desensy states they were.



45. Insofar as exhibit JD17 is concerned, the applicant is correct that the name of the website (which includes a reference to \$) is not identified. However, the review refers to “Superdrug store” and “£4.99”. As those posting such reviews (especially negative reviews) are, in my experience, far more likely to do so in fairly close proximity to the date of the purchase of the item concerned, it is, in my view, far more likely than not that the review refers to an item bought in a Superdrug store in the UK in fairly close proximity to the review date of June 2016.

46. As to the invoices issued to TJX, in his submissions Mr Desensy states:

“TJX Europe is a leading off-price retailer worldwide, including the UK. The invoices are directed to the company located in Watford, Hertfordshire for re-selling the Mades Recipes products in the UK.”

47. Once again Mr Desensy provides no evidence in support of the above. While all of the invoices are addressed to TJX at an address in Watford, the delivery addresses are to undertakings based outside of the UK. However, as far as I can tell, in its amended submissions the applicant has taken no issue with Mr Desensy’s statement in paragraph 46. As a consequence, I shall proceed on the basis indicated that, as Mr Desensy states, the proprietor’s goods sold to TJX were sold in the UK.

48. With the exception of the final invoice dated 11 September 2019 (to which I will return shortly) all the invoices are either of the same date (i.e. 14 June 2017) or in fairly close proximity to that date (i.e. 30 August 2017). However, all of the invoices contain references to “mades RECIPES” or “MADES RECIPES” and the goods identified are: body wash, body lotion, body sugar scrub, body butter, body milk and shampoo. Insofar as the invoice of 11 September 2019 is concerned, the applicant argues that this should be excluded from the reckoning because it warned the proprietor of its intention to commence revocation proceedings on 22 August 2019. As it is clear from the invoices dated in June and August 2017 that the proprietor had an existing business relationship with TJX long before the applicant warned the proprietor, I see no reason to conclude this invoice represents anything other than the continuance of an existing trade as opposed to an attempt by the proprietor to thwart the request for revocation.

49. The total quantity of goods supplied/values in the invoices, expressed in “Total EUR”, amounts to a total quantity/monetary value of 4158/€9373.80. The fact that the invoices are in Euros rather than £ sterling is a matter for the proprietor and TJX and does not mean that the goods concerned were not made available in the UK (as the proprietor states they were).

50. Although I have not included them all in this decision, in reaching a conclusion, I have kept all the applicant’s written submissions (dated 22 April, 18 June and 7 October 2020) firmly in mind. Having stepped back and taken a view of the evidence as a whole, the evidence relating to the Superdrug invoice indicates that having raised an invoice on 3 September 2014, the order was delivered to Superdrug on 5 September 2014 and, although the amount is different, a payment was received by the proprietor from Superdrug on 14 October 2014 (i.e. during the relevant period). The proprietor’s goods bearing the trade mark appeared on the shelves of Superdrug as early as 9 October 2014 (exhibit JD15). The proprietor’s trade mark also appeared on Superdrug’s website as early as 22 October 2014 (exhibit JD 28) and certainly no later than 23 January 2015 (exhibit JD16). I also think it is far more likely than not that the proprietor’s goods bearing the trade mark remained on the shelves of Superdrug until at least June 2016 when the negative review was posted. As a consequence, the proprietor is, in my view, entitled to rely upon the sale to Superdrug Stores in relation to: body butter, body lotion and body sugar scrub.

51. As for the sales to TJX, these are all within the relevant period and amount to a little under €10k. The goods identified are: body wash, body lotion, body sugar scrub, body butter, body milk and shampoo. Although the sales are small, there is nothing to suggest they represent anything other than efforts by the proprietor to create or maintain a market in the UK for the goods mentioned.

### **Conclusion on genuine use**

52. Having reminded myself of the comments in *Reber*, on the basis of the totality of the evidence provided, I am satisfied that within the relevant period the proprietor has made genuine use of its RECIPES trade mark in relation to:

Body butter, body lotion, body sugar scrub, body wash, body milk and shampoo.

### **What constitutes a fair specification?**

53. Having reached that conclusion, I must now go on and determine what constitutes a fair specification. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

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

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

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

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

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

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

55. The proprietor's trade mark stands registered for:

Soaps; perfumery; bath products ; body care products; cosmetics, hair care.

56. I have found that the proprietor has used its trade mark in relation to:

Body butter, body lotion, body sugar scrub, body wash, body milk and shampoo.

57. Given the nature, intended purpose and method of use of the goods upon which I have found the proprietor has used its trade mark, I am satisfied that it is entitled to retain the following goods in its specification: "Soaps", "bath products", "body care products" and "hair care".

58. Collinsdictionary.com defines “perfume” and “cosmetics” as:

“Perfume is a pleasant-smelling liquid that you can put on your skin to make yourself smell nice”;

And:

“beauty preparations; make-up.”

59. Those are definitions with which I am satisfied the average consumer of such goods will be very familiar. Bearing in mind, once again, the nature, intended purpose and method of use of the goods upon which the proprietor has used its RECIPES trade mark i.e. to beautify oneself and to create a pleasant aroma, when considered from the perspective of the average consumer, I am further satisfied that the proprietor is also entitled to retain “perfumery” and “cosmetics”. In summary, the proprietor’s specification is to remain as registered.

### **Overall conclusion**

**60. The application has failed and, subject to any successful appeal, the registration will remain registered.**

### **Costs**

61. As the proprietor has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. In an official letter to the proprietor dated 23 April 2020, the tribunal stated:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party...”

...You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.”

62. The costs pro-forma requires those completing it to indicate the amount of time they have spent during the proceedings by reference to various categories of work, for example, “Notice of defence”, “Considering forms filed by the other party”, “Preparing evidence/written submissions/considering and commenting on the other sides’ evidence/written submissions”. In its completed costs pro-forma, the proprietor indicates that it spent 27 hours “preparing witness statements and evidence” and 10 hours “considering applicant’s submissions and preparing written submissions in reply.”

63. As an unrepresented party, I have no doubt that it would have taken the proprietor some time to familiarise itself with the legal basis of the revocation and the type of evidence necessary to defend against such an application. It is also likely to have taken some time for it to obtain and collate the evidence filed in support of its registration. In making an award, I shall also keep in mind that the evidence-in-reply filed in the proper evidential format on 31 July 2020 was largely the same as it had filed earlier in the proceedings as part of its submissions in lieu of a hearing.

64. Adopting a “rough and ready” approach to the matter, I award the proprietor costs in the amount of **£513** calculated on the following basis: **£380** i.e. 20 hours @£19 for: considering the application, preparing a Notice of Defence and preparing evidence and **£133** i.e. 7 hours @£19 for: considering the applicant’s written submissions and filing submission in lieu of a hearing.

65. I order The Procter & Gamble Company to pay to Mades Cosmetics B.V. the sum of **£513**. This sum is to be paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 3rd November 2020**

**C J BOWEN**

**For the Registrar,**

**The Comptroller-General**