

O/586/22

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO. 503658

TO REVOKE ON THE GROUNDS OF NON-USE

TRADE MARK REGISTRATION NO. UK00910695963

OF THE TRADE MARK

foodpanda

OWNED BY DELIVERY HERO SE

BACKGROUND AND PLEADINGS

1. The trade mark shown on the cover page of this decision (“the contested mark”) stands registered in the name of Delivery Hero SE (“the proprietor”).¹ The contested mark was initially registered as a European Union Trade Mark (EUTM) with a filing date of 5 March 2012 and a registration date of 3 August 2012. It is registered in respect of the following goods and services:

Class 9: *Downloadable computer software in the form of applications for electronic apparatus and portable telephones (Apps), especially for offers for presenting goods and services in databases and immediate order placement; all the aforementioned goods excluding software related to computer security and to antivirus.*

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast; baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.*

Class 31: *Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.*

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

Class 33: *Alcoholic beverages (except beers).*

¹ The mark was originally registered in the name of Emerging Markets Online Food Delivery Holding S.à.r.l. (EMOFDH) and was assigned to the current proprietor by way of an assignment with an effective date of 9 August 2021.

Class 35: *Advertising; creating, updating and rental of advertising space, planning of presentations and other information offers for advertising purposes, information purposes, sales purposes; marketing for others on digital networks in the form of Web advertising; Arranging of contracts, for others, for the buying and selling of goods and the providing of services in the field of providing food and drink; sales promotion of goods and services for others in the field of providing food and drink; providing information concerning offers for goods and services, in the field of providing food and drink in databases with interactive access and immediate order placement; retail and wholesale services relating to food, drink and agricultural products; restaurant opinion polling; Internet advertising services for restaurants; consumer generated reviews for the purposes of consumer research; order procurement services for restaurants.*

Class 38: *Telecommunications; transmission of information, news, press, last minute offers, in the field of providing food and drink and food delivery services; providing electronic interactive access to databases for immediate order placement; Telecommunications; online transmission of consumer generated reviews for restaurants and take away restaurants.*

Class 39: *Transport; packaging and storage of goods in the field of food and drink.*

Class 42: *Providing platforms for providing goods and services in databases with electronic, interactive access for immediate order placement, in the field of providing food and drink, catering, transport of food and drink.*

Class 43: *Services for providing food and drink; booking services for restaurants; restaurant and take away restaurant services; catering; listing restaurant particulars and menus on the Internet; restaurant directory and search services; gathering, and providing of information, news, press, last minute offers, in the field of providing food and drink and food delivery services.*

2. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade

marks for all right holders with an existing EUTM. As a result of the contested mark being registered as a EUTM at the end of the Implementation Period, it was automatically converted to a comparable UK trade mark. The comparable UK mark is now recorded on the UK trade mark register and has the same legal status as if it had been applied for and registered under UK law, retaining its original filing date.

3. On 23 February 2021, HUNGRYPANDA LTD (“the applicant”) sought revocation of the contested mark on the grounds of non-use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994.

4. Revocation is sought under Section 46(1)(a) in respect of the 5-year period following the date of completion of the registration procedure, namely 4 August 2012 – 3 August 2017 (“the first relevant period”). Revocation is therefore sought from 4 August 2017. Revocation is also sought under Section 46(1)(b) in respect of the time period 18 February 2016 – 17 February 2021 (“the second relevant period”). Revocation is therefore sought from 18 February 2021.

5. The proprietor filed a counterstatement defending its registration for some of the goods and services for which the contested mark is registered, namely those in classes 9, 35, 38, 39, 42 and 43. In its Form TM8, the proprietor states as follows:

“The cancellation request is unfounded. The trade mark ‘foodpanda’ is used extensively within the European Union since years, especially ‘foodpanda’ is offering a marketplace for restaurants and consumers for ordering meals and beverages and its delivery services. ‘foodpanda’ also advertises the goods and services of its business partners and offers to them the communication platform including the telecommunication services between them and consumers/buyers. ‘foodpanda’ also provides information relating to food and drink [...]”

6. Only the proprietor filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. In these proceedings, the applicant is represented by Bird & Bird LLP and the proprietor by ip21 Limited.

7. A hearing took place before me on 22 April 2022. Mr Ian Silcock of Counsel instructed by ip21 Limited appeared on behalf of the proprietor. Mr Allan Poulter appeared on behalf of the applicant. Both filed skeleton arguments in advance of the hearing.

8. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

9. The proprietor filed evidence in the form of witness statement of Andreas Krause dated 28 June 2021. Mr Krause is the General Counsel of Delivery Hero SE who is the proprietor of the contested mark. Certain parts of Mr Krause's evidence will be redacted from the published version of this decision on the grounds they are covered by confidentiality.

10. I do not intend to reproduce or summarise the evidence here, but will refer to it below, where necessary.

DECISION

11. Section 46 of the Act states:

"46. - (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) [...]

(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 existing at an earlier date, that date”.

12. Where the mark is a comparable mark, paragraph 8 of part 1, schedule 2A is relevant. It reads:

“8.— Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before IP completion day—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union”.

13. Section 100 of the Act is also relevant, which reads:

“100. 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.”

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to 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 Bunderversvereinigung 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].”

15. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark*” is not, therefore, genuine use.

16. As the contested mark is a comparable mark deriving from a EUTM and (a) the first relevant period has expired before IP completion day and (b) IP completion day falls within the second relevant period, I must consider the EU as the market in which the proprietor is required to show genuine use up to 31 December 2020: see *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraph 36.

17. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, wherein 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.”

[...]

“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.”

18. In addition, 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.”

19. It is clear from the case law above, that the onus is on the proprietor to show that it has used the contested mark during the relevant periods.

Assignment of the contested mark

20. Delivery Hero SE is the current proprietor of the contested mark. The mark was originally registered in the name of Emerging Markets Online Food Delivery Holding S.à.r.l. (EMOFDH) and was assigned to the current proprietor by way of an assignment with an effective date of 9 August 2021. Consequently, the assignment took place after the present invalidity action was launched and outside the two relevant periods in relation to which the applicant seeks to invalidate the contested mark.

21. The current proprietor and the previous owner of the mark are parent companies. Mr Krause explains that the previous owner of the mark (EMOFDH) owns Foodpanda GmbH who in turn owns the Bulgarian company Delivery Hero Bulgaria EOOD. The evidence provided relates to the use of the contested mark by EMOFDH or authorised companies and it is therefore use by the proprietor or with its consent.

The goods and services which are defended

22. The proprietor has accepted in its defence, that the contested mark has not been used for some of the goods covered by the registration, namely all of the goods in classes 29, 30, 31, 32 and 33. To this extent, the revocation will necessarily be successful.

23. The goods and services in relation to which the proprietor claims to have used the mark are those in classes 9, 35, 38, 39, 42 and 43.

The evidence of use

24. Mr Krause says that the mark 'foodpanda' has been used since at least 2013 in Romania and since 2014 in Bulgaria and that the mark is used in relation to the advertisement, processing and delivery of orders of partner restaurants which are then distributed by delivery drivers to consumers. The services are available via websites and mobile applications.

25. According to Mr Krause the business model works as follows:

“The customer is connected to the restaurant that offers the food for delivery which is selected, ordered and paid for. The restaurants are able to advertise their products/services via the various communications media including product promotion, and the product lists and menus are available. Furthermore, communications are sent out through the platform to confirm the order and to provide an estimated delivery time. On the Apps and websites platforms it is possible to leave a review for the restaurant [or] leave a review or comment on sale process, delivery, taste and overall impression of the restaurant.”

26. Mr Krause also states that, more recently, the use of the mark has been extended to include grocery ordering and delivery services.

27. Revenue is generated by way of fees, because the partners that advertise and offer their goods and services for sale, through the ‘foodpanda’ platforms, pay a fee for accessing the platforms and for the orders received and delivered.

28. Order numbers for meal ordering and delivery services are as follows:²

Bulgaria	
2017	193,964
2018	431,585
2019	1,196,875
2020	2,285,007
Total	4,107,431

Romania	
2017	1,115,056
2018	2,031,374
2019	4,726,796
2020	10,329,377
Total	18,202,603

² ET4

29. At the hearing Mr Poulter criticised this evidence by saying that it is not clear how many deliveries were made. Further, he said that it is not possible to determine whether an order of 100 items amounts to one order or 100 orders. At the hearing Mr Silcock was able to confirm my impression drawn from the tables, namely that one order is one order (and one delivery), regardless of the number of items included in the order.

30. Mr Krause confirms that the turnover figures for the years 2018, 2019 and 2020 are as follows:³

- Bulgaria: the annual revenue generated under the mark 'foodpanda' in Bulgaria increased from EUR [REDACTED] in 2018 to EUR [REDACTED] in 2019, to EUR [REDACTED] in 2020, with a total revenue of EUR [REDACTED] between 2018 and 2020. The annual revenue figures are broken down in the following categories: 'marketplace commission', 'delivery revenues', 'food processing', 'other business lines', 'advertisements', 'card free user', 'merchandising' and 'other' with the 'delivery revenues' being by far the category generating the largest amount of revenue and representing over 75% of the total revenue generated over the three-year period 2018-2020;
- Romania: the annual revenue generated under the mark 'foodpanda' in Romania increased from EUR [REDACTED] in 2018 to EUR [REDACTED] in 2019, to EUR [REDACTED] in 2020, with a total revenue of EUR [REDACTED] between 2018 and 2020. The annual revenue figures are broken down in the following categories: 'food delivery marketplace + own delivery including delivery fees', 'groceries + shops (including delivery fees)' and 'noncommission revenue (NCR)', however, the 'food delivery marketplace + own delivery including delivery fees' represent nearly 95% of the total revenue generated over the three-year period 2018-2020. The 'groceries + shops' category did not produce any revenue in 2018 and 2019 and the revenue generated in 2020 is EUR [REDACTED]. The NCR revenue is EUR [REDACTED] in 2018, EUR [REDACTED] in 2019 and EUR [REDACTED] in 2020.

³ ET15

31. In so far as the turnover figures for Bulgaria are concerned, it is stated as follows:

*In the provided turnover figures, Revenue – Marketplace Commission, Delivery and Food processing relate to restaurants and food delivery
**Revenue – Other business lines are related to the grocery delivery. For clarification: we do not retail any goods, just provide the service listing and delivery on behalf of retailers, like Kaufland. Meaning, here Foodpanda acts as an Agent, not Principal

32. At the hearing, Mr Poulter stated that the above statement, in particular the phrase “*we do not retail any goods*”, is evidence that the proprietor is not involved in the business of retailing goods, the inference being that the contested mark could not have been used for the registered retail and wholesale services relating to food, drink and agricultural products.

33. Mr Silcock made two points. The first is that the phrase “*we do not retail any goods*” has to be read in context, and here it means that the user(s) of the mark ‘foodpanda’ acts as an agent, not as a principal. According to Mr Silcock, the phrase effectively says that the user(s) of the mark ‘foodpanda’ provides what is in effect a retail service through their online app, but they do not manufacture or sell the goods. In any event, Mr Silcock pointed out that the phrase “*we do not retail any goods*” is part of a comment which relates only to the category ‘other business lines’ (which generated revenue only in 2020 amounting to EUR [REDACTED]) and does not apply to the other streams of revenue. In relation to the category ‘food processing’, Mr Silcock submitted that it ought to be read in context as being more likely to be a reference to the processing of food orders, rather than to ‘food processing’ intended as the action of performing a series of mechanical or chemical operations on food in order to change or preserve it.

34. Mr Poulton criticised the proprietor’s evidence by reference to a document exhibited at ET2 which consists of an extract from Wikipedia. Whilst Mr Poulton said that little weight should be attached to the extract, because Wikipedia is an online encyclopaedia that anyone can amend, at the same time, he relied on the information contained within the same extract to discredit the proprietor’s evidence. In this connection, Mr Poulton said that the extract from Wikipedia talks about the fact that ‘foodpanda’ was launched in Singapore and then later in Malaysia, Indonesia and Thailand demonstrating that the proprietor was interested only in Asia and the Balkan countries. According to Mr Poulton, although the proprietor relies on use in Romania

and Bulgaria, there is no suggestion that this was a real attempt to enter the EU market and create a market share within that market. I do not think there is anything in this point. Whether or not use in Bulgaria and Romania is sufficient to establish genuine use within the EU must be assessed taking into account all of the relevant factors, including the nature of the goods or services concerned, the characteristics of the market and the scale and frequency of use of the mark. The fact that the proprietor's focus might be the Asian market does not mean that the proprietor had no intention to enter the EU market or that it did not genuinely use the contested mark in Bulgaria and Romania.

35. In this case, the turnover achieved by the opponent amounts to approximately EUR [REDACTED] and the number of orders processed is approximately 22 million in the three-year period 2018-2020. Obviously, this is not the value of the orders taken through the proprietor's online platforms but, as the turnover figures show, it reflects (a) the commission fees charged by the proprietor to its partners for promoting their businesses and taking their orders through the 'foodpanda' website and app and (b) the delivery fees charged by the proprietor to its partners for delivering the orders to the end-consumers. This is significant even taking into account the characteristics of the goods and services concerned and is further corroborated by a statistic published by www.statista.com which identifies 'foodpanda' as the second most used delivery app in Bucharest during the Covid-19 pandemic in Romania in 2020.⁴ There is also an article from 23 August 2018 which says that "*Delivery Hero's foodpanda platform is the biggest online food order platform in Romania, where it lists the offer of over 500 restaurants in 10 cities*",

36. In addition, the evidence of use is supported by copies of invoices issued to businesses with addresses in Romania and Bulgaria dated between 2018 and 2020.⁵ Although the proprietor did not provide a translated version of these invoices, some of them contain the wording "*commission conform contract*" which can be easily understood as "*commission conform to contract*"; this tallies with the evidence that the proprietor's revenue is generated from, inter alia, commission fees paid by its restaurant partners.

⁴ ET5

⁵ ET13-14

37. In terms of how the mark has been used, throughout the evidence, the proprietor has shown use of the sign 'foodpanda' either alone (as it is registered) or with a figurative element representing a panda as shown below:



There are also pictures of 'foodpanda' riders from Bulgaria and Romania.⁶ Although Mr Poulton criticised this evidence for being undated, it is corroborated by other material including (a) pages from the proprietor's Bulgarian and Romanian websites⁷ www.foodpanda.bg and www.foodpanda.ro (which are dated as early as July 2018) (b) pages from the proprietor's Facebook and Instagram accounts⁸ (which are dated between 2016 and 2021) and (c) evidence of media coverage from Bulgaria and Romania dated between 2018 and 2020.⁹ All of this evidence paints the picture of a mark consistently used over time in two EU countries since at least 2016.

38. Another criticism of the evidence made by Mr Poulton, is that from the end of December 2020 until 18 February 2021, the only use that is relevant to protect the registration is use in the UK, and there has not been any use in the UK at any time since the date of the registration. Further, there is no suggestion that the UK is an important market for the opponent, either historically or for the future.

39. I do not think there is anything in Mr Poulton's criticisms. Whilst there is a very short period of time of less than 3 months whereby use in the EU would not be relevant, use in the EU is nonetheless relevant up to within two months preceding the end of the second five-year period. The fact that the opponent has not used the mark in the UK and has no plans to expand its business in the UK is not fatal. This is because the law does not require the comparable mark, which is subject to revocation, to survive proof of use in the UK separately, especially when the EU is the relevant territory (and so use in the EU counts towards genuine use) for most of the relevant periods.

⁶ ET11

⁷ ET3

⁸ ET7

⁹ ET2

Conclusion on genuine use

40. Taking all of the above into account, I consider that the evidence is sufficient to demonstrate that the proprietor has put the contested mark to genuine use in the EU during the most recent relevant period, namely 18 February 2016 – 17 February 2021. This is enough to save the mark even if there was not sufficient use during the earliest relevant period, i.e. 4 August 2012 – 3 August 2017, since, in such case, the position would be restored by virtue Section 46(3).

41. The final point of dispute relates to the terms in which, on the basis of the evidence filed, the goods and services of the proprietor may fairly be described, and to whether they extend to the defended goods and services covered by the contested registration.

42. 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."

43. In similar vein, Mr Geoffrey Hobbs Q.C. as the Appointed Person in *Euro Gida*¹⁰ 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."

44. The proprietor has defended the contested mark for the registered goods and services in classes 9, 35, 38, 39, 42 and 43. Further, during the hearing Mr Silcock confirmed that the proprietor was no longer seeking to defend the registration in

¹⁰ *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

respect of *retail and wholesale services relating to agricultural products* (in class 35). Hence the defended specification is now as follows:

Class 9: *Downloadable computer software in the form of applications for electronic apparatus and portable telephones (Apps), especially for offers for presenting goods and services in databases and immediate order placement; all the aforementioned goods excluding software related to computer security and to antivirus.*

Class 35: *Advertising; creating, updating and rental of advertising space, planning of presentations and other information offers for advertising purposes, information purposes, sales purposes; marketing for others on digital networks in the form of Web advertising; Arranging of contracts, for others, for the buying and selling of goods and the providing of services in the field of providing food and drink; sales promotion of goods and services for others in the field of providing food and drink; providing information concerning offers for goods and services, in the field of providing food and drink in databases with interactive access and immediate order placement; retail and wholesale services relating to food, drink; restaurant opinion polling; Internet advertising services for restaurants; consumer generated reviews for the purposes of consumer research; order procurement services for restaurants.*

Class 38: *Telecommunications; transmission of information, news, press, last minute offers, in the field of providing food and drink and food delivery services; providing electronic interactive access to databases for immediate order placement; Telecommunications; online transmission of consumer generated reviews for restaurants and take away restaurants.*

Class 39: *Transport; packaging and storage of goods in the field of food and drink.*

Class 42: *Providing platforms for providing goods and services in databases with electronic, interactive access for immediate order placement, in the field of providing food and drink, catering, transport of food and drink.*

Class 43: *Services for providing food and drink; booking services for restaurants; restaurant and take away restaurant services; catering; listing restaurant particulars and menus on the Internet; restaurant directory and search services; gathering, and providing of information, news, press, last minute offers, in the field of providing food and drink and food delivery services.*

45. The evidence shows that the mark ‘foodpanda’ is used in relation to an online food and grocery delivery platform.¹¹ The services are provided in the EU through the ‘foodpanda’ Bulgarian and Romanian websites and through an online app. The extract from Wikipedia says that the ‘foodpanda’ business operates in the following manner:

“Foodpanda processes and sends orders directly to partner restaurants, then delivers the meals by delivery riders to the customers. The service is available via its websites and mobile applications. It connects customers with restaurants that offer food delivery in their area and lets them choose, order and pay online/offline. Customers order food by entering their postcodes on the site and browsing for food from a list of restaurants. They can create meals by browsing restaurant menus and selecting items they want to order before entering an address and proceeding to the checkout. Foodpanda sends out an SMS to confirm orders and their estimated delivery time. Foodpanda also has a review section on restaurant pages, where customers can comment on sales process, delivery, taste, and overall impression of restaurants”.

46. Mr Silcock stated that there are essentially two categories of users, namely retail customers (which I understand to mean end-users) and partners. The latter are said to be the restaurants and other product suppliers who use the proprietor’s app and website to promote their goods and services to the end-consumers. In addition to that, Mr Silcock says, there are several other services that come through in the evidence, including (a) the fact that restaurant partners use the proprietor’s app and website to advertise their own services, (b) the fact that end-customers are able to leave reviews on the app and (c) the fact that the proprietor supplies delivery services.

¹¹ Witness statement paragraph 3 and ET2

47. As regards the claim that the contested mark has been used in relation to retail services, Mr Silcock referred me to an article of 26 May 2020, which talks about the launch of 800 products by a Bulgarian drugstore company through a partnership with 'foodpanda'. The article states:

“DM Bulgaria has launched a partnership with foodpanda which will make it easier for the clients of the drugstore company in 16 cities to receive about 800 products from the range the chain ordered online. Deliveries will be made within an hour after the order. Customers need to register on the website or mobile application of foodpanda, enter their address and the system will automatically find the nearest branch of DM. Clicking on the “Stores” section loads the range and shopping can begin. [...] at the moment the delivery is free, and the minimum value of the order is BGN 20”.

48. Another article from 18 April 2020 states:

“The food delivery company Foodpanda is already supplying products from the Fantastico retail chain, it is clear from the chain’s website. [...] The platform, which we know mainly for the delivery of food from restaurants, is already divided and has a category and “shops”. It includes not only grocery and household goods, but also small appliances, cosmetics, flowers, baby food, pet food and accessories, gift shops, drugstores and more”.

49. It is clear, in my view, that the proprietor provides an online marketplace for buyers and sellers of goods and services and a delivery service, not a retail service.

50. The proprietor’s business partners - namely restaurants and shops - use the proprietor’s online platforms to advertise, offer and sell their goods and services. They are the proprietor’s customers, because they pay the proprietor a commission/fee for marketing and selling their goods and services, for processing their orders and for picking up and delivering the goods to the end-consumers. The proprietor is essentially an intermediary which operates an online marketplace and a delivery service.

51. Insofar as the proprietor advertises and promotes its partners/customer-sellers' goods and services through its website and app under the sign 'foodpanda', it acts as an operator of an online marketplace and an advertiser. It also provides a delivery service.

52. Although the proprietor provides a service consisting of enabling its partners/customer-sellers to display on its website and app, in the course of their commercial activities, their offers for sale, the proprietor does not itself use the sign 'foodpanda' to identify the origin of the goods and services offered for sale through its online platforms. It is not apparent that the mark 'foodpanda' has been used by the proprietor, in such a way, that it has resulted in the end-consumer perceiving it as an indication of the trade origin of the goods (e.g. restaurant meals and/or retailed goods) and services (e.g. restaurant and retail services).

53. I will now turn to apply these findings to the various category of use claimed.

The class 9 specification

54. Mr Poulton contended that although the proprietor might operate an online app, use of the contested mark in relation to the app is ancillary to the services for which the proprietor claims that the contested mark has been used. According to Mr Poulton, the use shown is not sufficient to demonstrate that the proprietor has attempted to create a market across the EU for apps.

55. The proprietor's bespoke online app plays an integral and important part in the delivery of the proprietor's services which consist of providing (a) an online marketplace for sellers and buyers of goods and services and (b) a delivery service.

56. Although there is no evidence as to whether end-consumers were charged for downloading the app, that is not fatal, because the contested mark is used by the proprietor in relation to the app as a badge of origin to indicate to consumers that the app comes from the same source as the marketplace and the delivery services. Even if the end-consumer did not pay directly for the app, by downloading and using the app, they also became users and consumers of the app itself. It matters not that end-

consumers were not charged directly by the proprietor for using its app, because part of the cost they paid when they made their orders was eventually allocated to the proprietor through the fees paid by the proprietor's partners.

57. Finally, although there is no indication of how many consumers did in fact download the app, the evidence from www.statista.com demonstrates that 'foodpanda' was the most used food delivery apps in Bucharest (Romania) in March and April 2020 (which is within the second relevant period) and there is evidence which suggests that the app was up and running since 2017¹², as well as social media posts from 2019, which show the app on mobile phones.

58. Although this is in my view use in relation to an app, the specification is too broad because the word '*especially*' is not understood as a restriction to the specific goods listed thereafter. Although the term '*especially*' points out that the goods that follow are important, it does not restrict the list in any way. Consequently, the specification *downloadable computer software in the form of applications for electronic apparatus and portable telephones (Apps), especially for offers for presenting goods and services in databases and immediate order placement; all the aforementioned goods excluding software related to computer security and to antivirus* covers any kind of downloadable computer software in the form of applications for electronic apparatus and portable telephones (Apps), with downloadable computer software for offers for presenting goods and services in databases and immediate order placement being only an example.

59. My conclusion is therefore that there has been use of the contested mark in relation to a mobile application for food delivery and ordering.

60. As regards the claim that 'foodpanda' has also expanded its delivery and ordering services to include retailer partners offering a variety of goods, I note an article from the Bulgarian press dated 18 April 2020 which states that at that date 'foodpanda' already supplied products from supermarkets and pet stores and that the coverage of this new service was in almost all of Sofia. The article further states that the service

¹² ET5

covered not only grocery and household goods, but also small appliances, cosmetics, flowers, baby food, pet food and accessories, gift shop, drugstore and more, that there were 150 active stores in Bulgaria and that the goal was to reach 500 stores by 2020.

61. Going back to the turnover figures, they show that in 2020 the revenue generated by this service was EUR █████ in Romania (as shown under the heading “grocery + shops including delivery fees”) and EUR █████ in Bulgaria (as shown under the heading “revenue-other business lines” which is said to relate to the service of listing and delivering on behalf of retailers). Although the total revenue generated by the provision of these services is not very high, being EUR █████, it is in my view sufficient to be viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question taking into account the nature of the goods and services concerned and the geographical scope of the use made. Finally, although there is no specific evidence of how many orders were taken through the app - as opposed to the website – there is no indication that the services were not available through the app, so I am satisfied that they were.

62. Taking all of the above into account, I am satisfied that the use shown also covers a mobile app for delivery and ordering of retailed goods.

63. In consideration of all the above, a fair specification for the class 9 specification is:

Downloadable computer software in the form of applications for electronic apparatus and portable telephones (Apps) for offers for presenting goods and services of restaurants, take away restaurants and retailers in databases and immediate order placement; all the aforementioned goods excluding software related to computer security and to antivirus.

The class 35 specification

64. As it will be recalled, I have accepted that the proprietor’s use of the mark in relation to its marketplace services is use in relation to advertising services. Further, the turnover figures for Bulgaria include revenue generated by advertising (which amounts

to EUR [REDACTED] between 2018 and 2020). The term *advertising* is very broad and would include services such as cinema advertising, newspaper advertising, television advertising, etc in relation to which no use has been shown.

65. Taking into account the use made, I find that *advertising, namely, promoting and marketing the goods and services of restaurants, take away restaurants and retailers via electronic media* represents an appropriate subcategory of goods. Likewise, the term *marketing for others on digital networks in the form of Web advertising* should be restricted by adding the limitation *by means of listing the offers of restaurants, take away restaurants and retailers*.

66. As regard *creating, updating and rental of advertising space, planning of presentations and other information offers for advertising purposes, information purposes, sales purposes*, the evidence indicates that a proportion of the proprietor's revenue is generated by "marketplace commission". Mr Silcock did not really explain what the difference is between rental of advertising spaces and commission-based model in marketplace e-commerce. In my view, the rental of advertising spaces means that the seller pays to gain access to an advertising space, whether it sells its goods and services or not. Conversely, in a commission-based model - which seems the one adopted by the proprietor - the seller pays a commission based on the value of the sales it gets. On this basis, I find that no use has been shown for *creating, updating and rental of advertising space, planning of presentations and other information offers for advertising purposes, information purposes, sales purposes* and this term will be removed from the specification.

67. The next terms are *Arranging of contracts, for others, for the buying and selling of goods and the providing of services in the field of providing food and drink; sales promotion of goods and services for others in the field of providing food and drink; providing information concerning offers for goods and services, in the field of providing food and drink in databases with interactive access and immediate order placement*. I am content that the use shown is sufficient to retain all of these terms.

68. This leaves *retail and wholesale services relating to food, drink; restaurant opinion polling; consumer generated reviews for the purposes of consumer research; order procurement services for restaurants.*

69. There is no evidence of use in relation to *restaurant opinion polling and order procurement services for restaurants.* As regards *consumer generated reviews for the purposes of consumer research* whilst there are some references in the evidence to end-consumers being able to leave reviews, it is not clear how many reviews were left and how these reviews are utilised by the proprietor or by its restaurant partners.

70. Finally, as regard *retail and wholesale services relating to food, drink,* Mr Poulton referred me to an article from 18 January 2021 which states: *“foodpanda enter retail, a market of over 20 billion euros. The delivery platform opens its own stores under the pandamart brand. The company learned about retail from its partners with whom it already collaborates from deliveries and now enters this market with its own format”.*

71. Whilst I have found that the proprietor provides a delivery and ordering services in collaboration with third party retailers, that is not the same as providing retail services – see paragraph 52 above - and the reference to the proprietor entering the retail market in 2021 under a different brand confirms that there has been no use of the mark ‘foodpanda’ for retail services during the relevant periods.

72. For all of the above these reasons, the following terms will be removed from the specification in class 35:

creating, updating and rental of advertising space, planning of presentations and other information offers for advertising purposes, information purposes, sales purposes; retail and wholesale services relating to food, drink; restaurant opinion polling; consumer generated reviews for the purposes of consumer research; order procurement services for restaurants.

The class 38 specification

73. As Mr Poulton correctly pointed out at the hearing that class 38 includes mainly services that allow one party to communicate with another, as well as services for the

broadcasting and transmission of data, like radio and television broadcasting, video on demand transmission and telephone and voicemail services.

74. Although in my view the use shown justifies the proprietor retaining protection for *transmission of information, news, press, last minute offers, in the field of providing food and drink and food delivery services* the term *providing electronic interactive access to databases for immediate order placement*, should be restricted to *in the field of providing food and drink, retailed goods and delivery of food and drink and retailed goods*. Further, I am not convinced that there is any justification for the proprietor retaining protection for *Telecommunications* (repeated twice) and *online transmission of consumer generated reviews for restaurants and take away restaurants*. There is no evidence of use in relation to telecommunication services and no specific information about the provision of the reviews. Hence, the following terms will be removed from the specification in class 38:

Telecommunications; online transmission of consumer generated reviews for restaurants and take away restaurants.

The class 39 specification

75. It is clear from the evidence that the proprietor generates most of its revenue from its food delivery services. There is no evidence that in addition to delivering the orders, the proprietor also offers *packaging and storage of goods in the field of food and drink*. This term will be removed from the specification.

76. The other registered term *transport* is too broad to be retained, because, as Mr Poulton said, it would cover anything from the rental of vehicles for transportation, the transportation of people by air, by ship, by land, etc.

77. In my view *transport of goods in the field of foods and drink* and *transport of retailed goods* would constitute a fair specification in class 39.

The class 42 specification

78. The use shown is in my view sufficient to retain the class 42 specification as it is registered, namely *Providing platforms for providing goods and services in databases with electronic, interactive access for immediate order placement, in the field of providing food and drink, catering, transport of food and drink.*

The class 43 specification

79. The proprietor does not of itself provide any food and drink, any restaurant services or restaurant booking service. As I have explained, what the proprietor does is operate a marketplace which consumers can use to order goods from restaurants and retailers.

80. On that basis, I find that no use has been shown for *Services for providing food and drink; restaurant and take away restaurant services; catering; booking services for restaurants.* These terms will, therefore, be removed from the specification.

81. However, I find that the use shown is sufficient to retain protection for the following services:

listing restaurant particulars and menus on the Internet; restaurant directory and search services; gathering, and providing of information, news, press, last minute offers, in the field of providing food and drink and food delivery services.

OUTCOME

82. The contested mark will be revoked with effect from the earliest date requested under Section 46(1)(b), namely 4 August 2017, in relation to the following goods and services:

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices;*

honey, treacle; yeast; baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 31: *Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals; malt.*

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

Class 33: *Alcoholic beverages (except beers).*

Class 35: *creating, updating and rental of advertising space, planning of presentations and other information offers for advertising purposes, information purposes, sales purposes; retail and wholesale services relating to food, drink and agricultural products; restaurant opinion polling; consumer generated reviews for the purposes of consumer research; order procurement services for restaurants.*

Class 38: *Telecommunications; Telecommunications; online transmission of consumer generated reviews for restaurants and take away restaurants.*

Class 39: *packaging and storage of goods in the field of food and drink.*

Class 43: *Services for providing food and drink; booking services for restaurants; restaurant and take away restaurant services; catering.*

83. The surviving specification (taking into account the restricted specifications I have decided for the goods and services in classes 9, 35, 38 and 39) is as follows:

Class 9: *Downloadable computer software in the form of applications for electronic apparatus and portable telephones (Apps) for offers for presenting goods and services of restaurants, take away restaurants and retailers in databases and immediate order placement; all the aforementioned goods excluding software related to computer security and to antivirus.*

Class 35: *advertising, namely, promoting and marketing the goods and services of restaurants, take away restaurants and retailers via electronic media; marketing for others on digital networks in the form of Web advertising by means of listing the offers of restaurants, take away restaurants and retailers; Arranging of contracts, for others, for the buying and selling of goods and the providing of services in the field of providing food and drink; sales promotion of goods and services for others in the field of providing food and drink; providing information concerning offers for goods and services, in the field of providing food and drink in databases with interactive access and immediate order placement; Internet advertising services for restaurants.*

Class 38: *transmission of information, news, press, last minute offers, in the field of providing food and drink and food delivery services; providing electronic interactive access to databases for immediate order placement in the field of providing food and drink, retailed goods and delivery of food and drink and retailed goods.*

Class 39: *transport of goods in the field of foods and drink; transport of goods of retailers.*

Class 42: *Providing platforms for providing goods and services in databases with electronic, interactive access for immediate order placement, in the field of providing food and drink, catering, transport of food and drink.*

Class 43: *listing restaurant particulars and menus on the Internet; restaurant directory and search services; gathering, and providing of information, news, press, last minute offers, in the field of providing food and drink and food delivery services.*

CONCLUSIONS

84. The application for revocation on the grounds of non-use partially succeeds for the goods and services listed at paragraph 82.

85. The surviving specification for which the mark will remain registered is that listed at paragraph 83.

86. Both parties have succeeded to some extent and have failed to some extent. In the circumstances, I make no order as to costs.

Dated this 8th day of July 2022

**Teresa Perks
For the Registrar**