

O/0167/23

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3594539
BY A. G. PARFETT & SONS LIMITED**

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 425613
BY SUNTREE LIMITED**

AND

**IN THE MATTER OF UK REGISTRATION NO. 912554242
IN THE NAME OF SUNTREE LIMITED**

AND

**AN APPLICATION FOR THE REVOCATION THEREOF
UNDER NO 504055
BY A. G. PARFETT & SONS LIMITED**

BACKGROUND AND PLEADINGS

1. A. G. Parfett & Sons Limited (“Parfett”) applied to register **ZENERGY** as a trade mark in the United Kingdom on 12 February 2021. The application was accepted and published on 16 April 2021 in respect of the following goods:

Class 32

Energy drinks.

2. On 16 July 2021, the application was opposed by Suntree Limited (“Suntree”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Suntree is relying upon UK Trade Mark (“UKTM”) No. 912554242, **ZENERJII**. The filing date for this mark is 31 January 2014 and it was registered on 23 June 2014. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EU Trade Mark (“EUTM”) or EU designation of an International Registration. As a result of Suntree’s EUTM No. 12554242 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK Trade Mark Register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date. Suntree is relying on the following goods and services:

Class 29

Milk and milk products; yoghurt-based drinks; milk or yoghurt-based drinks flavoured with herbs or including herbal additives.

Class 32

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; non-alcoholic drinks; fruit drinks and fruit juices; vegetable-based non-alcoholic beverages; drinks flavoured with herbs and herbal preparations; syrups and other preparations for making non-alcoholic beverages.

Class 43

Services for providing food and drink; snack bar services; bar and bistro services; juice bar services.

3. Suntree claims that the marks are visually very closely similar and aurally and conceptually identical and that Parfett's *Energy drinks* are identical to *Other non-alcoholic beverages; non-alcoholic drinks; vegetable based non-alcoholic beverages; drinks flavoured with herbs and herbal preparations* and similar to the remaining goods and services on which it relies. As a result, it claims that there is a likelihood of confusion on the part of the public, including the likelihood of association between the marks.

4. On 9 August 2021, Parfett applied to have the earlier mark revoked under section 46(1)(a) of the Act on the grounds that the mark had not been put to genuine use by the registered owner or with their consent in relation to the goods or services listed below within the period of five years following the date of the completion of the registration process, and that there were no proper reasons for non-use:

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 oil and fats; yoghurt, fruit flavoured yoghurt and yoghurt-based drinks; milk or yoghurt-based drinks flavoured with herbs or including herbal additives.

Class 32

Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; non-alcoholic drinks; fruit drinks and fruit juices; vegetable-based non-alcoholic beverages; drinks flavoured with herbs and herbal preparations; syrups and other preparations for making non-alcoholic beverages.

Class 43

Services for providing food and drink; temporary accommodation; snack bar services; bar and bistro services.

5. Parfett claims that the earlier mark has only been used for *Juice bar services* and seeks an effective revocation date of 24 June 2019.

6. On 20 September 2021, Parfett filed a defence and counterstatement denying the claims made by Suntree in its opposition and putting it to proof of use of the earlier mark.

7. Suntree contests the application for revocation and claims that it has made genuine use of the mark for all the goods and services for which it is registered.

8. In these proceedings, Parfett is represented by Harrison IP Limited and Suntree by Sandersons. Neither side requested a hearing, so this decision has been taken after a careful consideration of the papers.

Evidence and Submissions

9. Suntree's evidence in chief comes from Cathal Power, Managing Director of Suntree Limited. His evidence is dated 9 February 2022 and goes to the use made of the ZENERJII mark. He also filed a second witness statement dated 12 July 2022 responding to points raised in Parfett's evidence and submissions.

10. Parfett's evidence comes from Mark Smith, a solicitor working for Harrison IP Limited. His evidence is dated 14 April 2022 and is a vehicle for exhibiting the results of an internet search.

11. Both parties filed written submissions. Suntree's submissions are dated 7 February 2022 and 12 July 2022; Parfett's are dated 14 April 2022 and 22 September 2022.

Procedural Issue

12. On reviewing the file prior to drafting a decision, I noticed that there was an issue that needed to be resolved in connection with Parfett's pleadings in its application for revocation of Suntree's mark.

13. As I have stated in paragraph 5 above, Parfett had originally claimed that Suntree's mark had not been used for any of the goods or services in the specification, except for *Juice bar services*. On 14 April 2022, during the evidence round, Parfett stated in its written submissions that it wished to amend the pleadings to seek revocation of the mark in its entirety.

14. In its written submissions in reply, dated 12 July 2022, Suntree objected to Parfett's request, submitting that it was an abuse of proceedings and that Parfett should have particularised its case at the outset.

15. Unfortunately, there had been no response to the request by the time the case came for a decision. The Registry therefore wrote to the parties on 15 November 2022, quoting section 4.1 of the Tribunal Manual on Amendment of Pleadings which says that:

“Whilst each request to amend will be considered on its merits, the Tribunal will aim to give favourable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties more quickly and at less cost. Whether to allow the amendment is a matter of discretion. In making its decision the Tribunal will consider, in particular, any inconvenience or prejudice suffered by the other side, and whether the party seeking amendment could reasonably have been expected to have fully particularised their case at an earlier stage. In other words, a party seeking amendment will have to dispel any suspicion of abuse of process.”

16. The Registry's view was that, although Parfett could have claimed at the outset that Suntree had not used its mark for *Juice bar services*, as Suntree had provided evidence to support a claim of genuine use of these services in the context of the opposition, and that the evidence appeared to address the relevant period for the revocation, the amendment to the pleadings should be permitted. The parties were given a period of 14 days to request a case management conference in the event that they wished to dispute this view. No request was received.

The Revocation

17. I shall address the revocation first, as the outcome of that action will determine the goods and services for which Suntree must show use in the opposition proceedings. If the revocation succeeds in its entirety, the opposition will fall away.

18. Section 46 of the Act is as follows:

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

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

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

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

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

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

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

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

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

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

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

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

19. As the earlier mark is a comparable mark, paragraph 8 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

“(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.”

20. Section 100 of the Act 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.”

21. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):¹

“114. *The law with respect to genuine use.* 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 *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 Bundersvereinigung 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 Marken 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 *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].

¹ 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 Trade Marks 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, although the UK has left the EU.

(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].

22. The relevant period is 24 June 2014 to 23 June 2019, with revocation sought from 24 June 2019. As this period expired before IP completion day, the relevant territory in which use must be shown is the European Union (which at the time included the UK).

23. Mr Power states that Suntree operates a chain of franchised outlets selling food and drink under the **ZENERJII** mark, which the outlets are licensed to use as part of the franchise agreement. It opened the first one in Dublin in 2001 and entered the UK market in 2012. Outlets are for the most part located in major retail centres, such as Westfield Stratford City, although Mr Power provides evidence that a ZENERJII juice bar opened within the Holland & Barrett store in Chester in 2015. An example of the

Romford kiosk is shown below. Although the image is somewhat blurred, the mark can be clearly identified in use with a device:²



24. UK turnover figures are shown below:³

2014:	£1,386,000
2015:	£1,473,000
2016:	£ 948,000
2017:	£ 872,000
2018:	£ 675,000
2019:	£ 687,000
2020:	£ 342,000

25. During the relevant period, the registered proprietor of the EUTM was a Cypriot company, Chilapa Limited (“Chilapa”), who assigned the EUTM to Suntree on 22 September 2020.⁴ Parfett submits that there is no evidence that the use of the EUTM, such as it was, was by or with the consent of the then registered proprietor, as required by section 46(1)(a).

² Exhibit CP-05, page 6.

³ First witness statement of Cathal Power, paragraph 9.

⁴ Exhibit CP-16.

26. In *Makro Zelfbedieningsgroothandel CV & Ors v Diesel SpA*, Case C-324/08, the Court of Justice of the European Union (“CJEU”) held that:

“... Article 7(1) of Directive 89/104 must be interpreted as meaning that the consent of the proprietor of a trade mark to the marketing of goods bearing that mark carried out directly in the EEA by a third party who has no economic link to that proprietor may be implied, in so far as such consent is to be inferred from facts and circumstances prior to, simultaneous with or subsequent to the placing of the goods on the market in that area which, in the view of the national court, unequivocally demonstrate that the proprietor has renounced his exclusive rights.”⁵

27. Mr Power states that he was authorised to act for Chilapa through a power of attorney dated 29 May 2012 that was approved by Chilapa’s Board of Directors. The power of attorney authorised him to do the following:⁶

- a) To open, manage and close Bank Accounts with any Bank in any part of the world in the name of Company and to withdraw all or any of the money standing to the said accounts and to draw, sign, endorse and negotiate any cheques, promissory notes, bills of exchange, negotiable instruments and generally any document or order connected with or in relation to such accounts and banking business and to receive money owing by the Bank to the Company and to withdraw and deal with any of the Company’s property or securities.
- b) To give indemnities, to transact, manage, administer and do all and every business matter and things requisite and necessary, or in any matter connected with, or having reference to the business and affairs of the company, including establishment of one or more representative and/or correspondent offices in any part of the world, and for such purposes to conduct all correspondence appertaining to such business and affairs;
- c) To enter into, make, sign and effect all such contracts, agreements, letters, undertakings, receipts, payments, assignments, transfers, conveyances, mortgages, assurances, instruments and things as may in the opinion of the Attorney be necessary or convenient for carrying on the business of the company and in relation to the Company’s bank accounts.
- d) To negotiate and agree on the terms and conditions of any joint ventures agreement to be entered into with any company or person in any part of the world and to do all acts and things necessary to set up and operate in any part of the world such joint venture as per the terms and conditions to be so agreed.
- e) To take all necessary steps and sign all necessary documents for the establishment and registration in any part of the world of any branches or subsidiary companies or partnerships or other bodies and the participation in other branches, companies or partnerships or bodies.
- f) To sign on behalf of the company all such applications, contracts, retainers, forms and documents whatsoever, as may be deemed by him necessary or desirable.

⁵ Paragraph 35.

⁶ Exhibit CP-22.

The power of attorney was issued for the period of one year.

28. Mr Power says that he then instructed Sandersons to prepare and submit the application for the EUTM on 31 January 2014 in the following email:

“I want to register a new name zenerjii. I have checked the website and there is only one name that is very similar zenerji. That is a registered word under class 35 business services. It would appear that as a food company we should not affect them. Or could they object anyway?

If you think the chances of getting registered are reasonable I would like to register the word under the same 3 classes as zalsa but under the Chilapa company.”⁷

29. Mr Power states that prior to the assignment of the EUTM to Suntree, the mark was used by Suntree and its licensees by consent of Chilapa.⁸ The EUTM application is listed as one of the relevant brands to be applied to the services supplied by the franchisee in a franchise agreement between Suntree and the franchisees of an outlet in Dublin, dated 1 January 2018.⁹

Brand: CTM Application No 012554242 – Zenerjii – Classes 29, 32, 43
CTM Application No 014420749 – Beleaf- Classes 24, 32, 43.

30. Clause 6.1 of the agreement states that:

“You are granted a non-exclusive right to use the Brand subject to the provisions of this Agreement. We retain all rights in the Brand and all goodwill generated therefrom.”¹⁰

⁷ Exhibit CP-15.

⁸ Second witness statement, paragraph 4.

⁹ Exhibit CP-18, page 50.

¹⁰ Page 18.

31. The agreement is unsigned. Parfett submits that this document does not demonstrate that any agreement was concluded, merely that, at most, a draft agreement was drawn up. Furthermore, Mr Power does not provide any evidence to explain the relationship between Suntree and Chilapa, or how Suntree had any rights at that time in the EUTM. Parfett also states that, at this time, Suntree was a dormant company.

32. Suntree had been incorporated on 11 April 2012, and Mr Power's appointment as a director was terminated on 12 September 2012. He was later reappointed on 17 August 2018. On 19 September 2018, Suntree filed accounts for a dormant company and seems to have been dormant until at least 31 December 2020.¹¹ Parfett adduced an extract from gov.uk which explains that "*Your company or association may be 'dormant' if it's not doing business ('trading') and doesn't have any other income, for example investments.*"¹² Suntree submits that this is irrelevant and does not cast doubt upon the UK turnover figures given in paragraph 9 of Mr Power's first witness statement, which it says were attributable to licensees as well as Suntree.

33. It is my understanding that a franchisor would normally receive some form of payment from a franchisee. Sections 9.1-9.6 of the franchise agreement deal with fees. This states that on the signing of the agreement an initial fee is due, and that thereafter

"You must pay us [Suntree] without set off, credit or deduction of any nature, a Management Service Fee equal to the percentage of the Gross Revenue set out in Schedule 2. The Management Service Fee will be paid on or before Tuesday in each week."¹³

34. Section 11.1 of the same agreement states that Suntree will establish a marketing fund to promote the outlets and the mark, and that franchisees should pay a Marketing Contribution alongside the Management Service Fee.¹⁴

¹¹ Exhibit MS3.

¹² Exhibit MS4.

¹³ Exhibit CP-18, page 24.

¹⁴ Exhibit CP-18, paragraph 27.

35. What emerges from the evidence is that in 2012-13 Mr Power was authorised to undertake what appears to be a wide range of activities for Chilapa, but that it is unclear whether the power of attorney was renewed after its expiry in 2013. It was after this that he made enquiries with legal representatives about filing “zenerjii” as an EUTM in the name of Chilapa. He says that Suntree operated franchised outlets using the EUTM, with the first one in the UK opening in 2012 in Westfield Stratford City.

36. This use was, according to Mr Power, with the consent of Chilapa, but there is no corroborating documentary evidence. In particular, the relationship between Suntree and Chilapa is unclear. Between 2018 and 2020, Suntree was dormant, although it is not easy to see how this status would have been consistent with running a franchise operation where franchisees are required to pay fees for the use of the brand. Furthermore, a drafted franchise agreement states that Suntree retains all rights in the brand. It does not refer to the then proprietor of the EUTM, Chilapa.

37. In *CLUB SAIL Trade Mark*, [2010] RPC 32, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“38. ... it is not obligatory to regard the written evidence of any particular witness as sufficient, in the absence of cross-examination, to establish the fact or matter (s)he was seeking to establish. That is brought out by the following observations of Mann J in *Matsushita Electric Industrial Co. v Comptroller-General of Patents* [2008] EWHC 2071, [2008] RPC 35 (Pat).

‘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 or 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.’

39. ... when assessing the evidence in the witness statements it is appropriate to do so from the perspective identified by Lord Bingham of Cornhill in *Fairchild v Glenhaven Funeral Services Ltd* [2002] UKHL 22; [2003] 1 AC 32 (HL) at para.[13]:

‘... And I think it is salutary to bear in mind Lord Mansfield’s aphorism in *Blatch v Archer* (1774) 1 Cowp 63 at 65, 98 ER 969 at 970 quoted with approval by the Supreme Court of Canada in *Snell v Farrell*:

‘It is certainly a maxim that all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted.’

...

41. ... the veracity of the evidence in the witness statements could not be taken to have been challenged on the basis of any contention which the witness had not had a fair opportunity to consider and address as best (s)he could: *Pan World Brands Ltd v Tripp Ltd (EXTREME Trade Mark)* [2008] RPC 2 at paras.[33] to [37] (Appointed Person, Mr Richard Arnold QC).”

38. I accept that corroborating documentary evidence is not necessarily required. The difficulty that faces me is that there are gaps in Mr Power’s narrative account. Parfett had challenged Suntree’s evidence in chief purporting to show use of the mark in its written submissions of 14 April 2022. Suntree’s evidence in reply filled in some more of the picture, but there are still gaps, notably concerning the relationship between

Suntree and Chilapa. In *PLYMOUTH LIFE CENTRE*, BL O/236/13, Mr Daniel Alexander QC, sitting 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.”

39. In my view, it should have been reasonably straightforward for Suntree to have provided evidence of any authority given by Chilapa for use of the EUTM, or at the very least to have given more specific information within Mr Power’s second witness statement, given that it knew the criticisms Parfett had made of the earlier evidence. For example, nowhere does Mr Power say whether the power of attorney was renewed. In my view, Suntree has not proved that any use that has been made of the mark has been with the consent of the then proprietor.

40. The application to revoke UKTM No. 912554242 is successful. Given this outcome, the opposition falls away.

Outcome

41. UKTM No. 912554242 is fully revoked with effect from 24 June 2019.

42. Application no. 3594539 will proceed to registration.

Costs

43. Parfett has been successful in these proceedings and is entitled to a contribution towards its costs in line with the scale set out in TPN 2/2016. The award is calculated as follows:

Preparing a statement and considering the other side's statement (x2): £400

Preparing evidence and

considering and commenting on the other side's evidence: £1000

Preparation of submissions in lieu of a hearing: £350

Official fees: £200

TOTAL: £1950

44. I therefore order Suntree Limited to pay A. G. Parfett & Sons Limited the sum of £1950, which should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 16th day of February 2023

Clare Boucher

For the Registrar,

Comptroller-General