

O/0347/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 504780 BY CELESTE KRENZ
TO REVOKE FOR NON-USE**

TRADE MARK REGISTRATION No. 3057461



**REGISTERED IN THE NAME OF URBAN JUICE LTD
IN RESPECT OF SERVICES IN CLASS 43**

BACKGROUND, PLEADINGS AND EVIDENCE

1. Urban Juice Ltd (“**the Proprietor**”) is the owner of trade mark No. 3057461, as shown on the cover of this decision, registered since 5 September 2014 only for services in Class 43, namely: *Restaurants (self-service-)*.
2. On 12 April 2022, Celeste Krenz (“**the Applicant**”), through her legal representatives - Bromhead Johnson LLP – filed a Form TM26(N), seeking to revoke the trade mark registration on the grounds of non-use, relying on section 46(1)(a) and section 46(1)(b) of the Trade Marks Act 1994 (“**the Act**”).
3. The Applicant seeks revocation under **section 46(1)(a)** alleging that, without proper reason, the mark had not been put to genuine use in the UK within five years of the completion of the registration procedure, i.e. between 6 September 2014 – 5 September 2019 (which in this decision I describe as “**Period One**”). The Applicant claims that the mark should therefore be revoked as from 6 September 2019.
4. Additionally, the Applicant claims under **section 46(1)(b)** that there was no genuine use of the mark within two subsequent specified five-year periods, namely: between 20 December 2014 – 19 December 2019 (“**Period Two**”); nor between 12 April 2017 – 11 April 2022 (“**Period Three**”). The Applicant therefore claims that under this ground, the mark should be revoked as from 20 December 2019 or from 12 April 2022.
5. The Proprietor filed a Form TM8(N) notice of defence against the application for revocation, including a declaration of truth and dated 15 December 2022.
6. Point 7 of that form asks the proprietor to “Please specify the goods and/or services of the registration for which you are submitting this notice of defence.” The Proprietor ticked the box indicating “All goods and services.” It then used the space beneath to state that “From 2014, Urban Juice has produced and sold directly to customers, such as Delfont Mackintosh Theatres, freshly pressed juices and on request baked sweet items.” It then listed the names of four juices, and listed five other items, including “Brownies” and “Yogurt”.
7. Point 8 of the Form TM8(N) provides space for a counterstatement, with the following guidance:

“If a defence is based on “proper reasons for non-use” then this should be clearly set out in the counterstatement. The counterstatement should state the reason(s) why the proprietor opposes the application for revocation for non-use. The counterstatement should say which goods/services you have used the mark for.”

8. Point 9 of the form asks “Are you filing evidence with this form in support of your defence?” The Proprietor ticked the box to indicate “Yes” and then listed its six exhibits in evidence. The Proprietor used the space under Point 8 to set out a witness statement from Nicholas Mackintosh which refers to those exhibits. It subsequently re-filed the same statement as a separate document, signed by Mr Mackintosh under a declaration of truth and dated 15 December 2022.
9. Given the brief nature of the present short decision and since the Proprietor filed its evidence as part of or simultaneously with its Form TM8(N) and counterstatement, it is convenient to outline here the evidence filed. The witness statement includes the following points:
 - i. Mr Mackintosh states that he is the director and owner of the Proprietor and that his company has been using the contested trade mark since 2014, trading initially online and then through Mackintosh's Catering Management Ltd.
 - ii. He states that “since 2014 Urban Juice has produced and sold directly to customers such as Delfont Mackintosh Theatres freshly pressed juices and, on request, small sweet organic products such as listed in **Exhibit 5**.”
 - iii. “Although initially trading under its own name, Urban Juice, the company has been trading under the name Mackintosh Catering Management Limited, which has sold nuts to all Delfont Mackintosh theatres for about 15 years. Please see **Exhibit 6** for examples of invoices.”
 - iv. “From March 2020 until March 2022 Urban Juice’s operations were suspended since its major customer, Delfont Mackintosh Theatres, had closed its theatres to the public. Now that the Pandemic is over, Urban Juice will be opening its own outlets, so that its products will be available to customers on the High Street. See **Exhibit 4**.”

v. “The concept for the shop can be seen in **Exhibit 3.**”

10. I’ll return to say a little more about the exhibits and evidence later in this short decision.
11. On 17 February 2023 the registry wrote to the Proprietor acknowledging receipt of its (amended) Form TM8(N) and counterstatement filed on 16 December 2022. The registry’s letter then explained as follows:

“The cancellation applicant has challenged TM registration 3057461 for non-use.

The mark is registered only in respect of services in Class 43: Restaurants (self-service-).

The filed TM8(N) (despite revisions) claims no use for those services, and instead refers to goods that are organic juices and products.

The TM8(N)N therefore makes no denial of the Applicant’s claim that the trade mark has not been used in the relevant periods for the registered services

It is therefore the registrar’s preliminary view that the revocation application must succeed for lack of defence and the trade mark registration (which is for Class 43 services) be revoked from the end of the 5-year period of non-use, namely 20 December 2019.

If you wish to challenge this view you have until Wednesday 1 March 2023 to request a Case Management Conference (CMC). If no request is made by this date, the provisional date will be vacated, and the preliminary view deemed confirmed and the registration 3057461 will be revoked.”

12. The Proprietor did not request a CMC nor otherwise respond to the registry’s letter. This short decision therefore records the confirmation of the revocation of the Proprietor’s contested trade mark registration.

DECISION

Applicable legislation

13. The relevant parts of section 46 of the Act provide as follows:

“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;

.....

- (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 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.

.....

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

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

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

14. Section 100 of the Act is also relevant and 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.”

Case law principles

15. In *Walton International Ltd & Anor v Verweij Fashion BV*,¹ Arnold J. (as he then was) considered the case law relating to genuine use and concluded 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;
 - (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;
 - (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;
 - (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: Internal use by the proprietor does not suffice. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter;
 - (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;
 - (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

1 [2018] EWHC 1608 (Ch) at paragraph 15 of the judgment.

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;

(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;

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

16. In *Armin Häupl v Lidl*², the Court of Justice of the European Union held that:

“54. [...] only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as “proper reasons for non-use” of that mark. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable. It is the task of the national court or tribunal, before which the dispute in the main proceedings is brought and which alone is in a position to establish the relevant facts, to apply that assessment in the context of the present action.”

17. For completeness I note that the exhibits referenced in the evidence do not assist the Proprietor in establishing proof of use of the mark for its registered services. Exhibit 1 is simply an image of the mark; Exhibit 2 is simply an undated image of a bottle of carrot juice whose label bears the mark. Mr Mackintosh also filed a document showing that the juices that are named at Point 7 of the Form TM8(N) (such as “apple of my eye”

2 *Armin Häupl v Lidl Stiftung & Co. KG*, Case C-246/05

22. The evidence also shows a menu, where part of the mark is visible and where a few drinks and snacks are listed. This is not dated, does not appear to relate to the relevant periods and does not establish genuine use of the mark for its registered services.
23. It is clear from the account that I set out above in the background, pleadings and evidence section of this decision and from my summary of the exhibits, that the mark has not been used in relation to its registered services. There is some evidence relating to use in respect of a small number of goods (juices), but not only is the evidence of sales of bottles of juice lacking, but in any event those goods are not the registered services.
24. The Proprietor has not explicitly claimed that there are proper reasons for non-use during any the relevant periods, but I note that the evidence does refer to the two-year disruption caused by the pandemic March 2020 - March 2022, and refers to plans for a high street outlet. This does not assist the Proprietor. The disruption caused by the closure of its one named customer (the theatre group) relates to sale of its goods. It does not relate to the provision of the registered services. The impact of the COVID pandemic of course has no bearing on Period One or Period Two, which fully predate it. While I do not in this decision make a finding as to whether the impact of the pandemic may furnish proper reasons for non-use outside the control of a proprietor, there is anyway no evidence (or even claim) of use of the trade mark for its registered services even after the expiry of Period Three. The Proprietor can therefore derive no benefit from the provision in section 46(3) of the Act. The sketch, the undated menu and the vaguely asserted future plans cannot overcome the claims of non-use.
25. **OUTCOME:** In line with the indication of the registry's letter, trade mark No. 3057461 is revoked. Since it has never been used at all for its registered services it is revoked as from the end of Period One – **from 6 September 2019.**

COSTS

26. The Applicant is entitled to a contribution towards its costs reflecting the stage to which the proceedings progressed and the successful revocation of the Proprietor's trade mark. In line with the scale published in the annex to Tribunal Practice Notice (2/2016), I award the following costs:

Preparing a statement and considering the Proprietor's response	£200
Official fee for filing the TM26(N)	£200
TOTAL	£400

27. I order Urban Juice Ltd to pay Celeste Krenz the sum of £400 (four hundred pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 6th day of April 2023

Matthew Williams

For the Registrar