

O-035-10

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION UNDER NO 83454  
BY VINISSIMUS SL  
TO REVOKE REGISTRATION NO 2339985  
IN THE NAME OF SOPHIE NEWICK

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IN THE MATTER OF an application  
under No 83454 by Vinissimus SL  
to revoke registration No 2339985  
in the name of Sophie Newick

### **Background**

1. Registration No 2339985 is for the mark VINISSIMO and has a registration date of 12 March 2004. It stands in the name of Sophie Newick and is registered in respect of *Wines* in class 33.

2. On 6 April 2009 an application seeking to revoke the registration was filed by Vinissimus SL (“the applicant”). The application is based on section 46(1)(a) of the Act on the grounds of non-use of the mark and revocation is sought with effect from 13 March 2009.

3. Ms Newick filed a counterstatement along with various documents in support of her defence to the application. I shall return to these in due course.

4. No further evidence was filed by either party and neither requested to be heard. The applicant did, however, file written submissions in lieu of attendance at a hearing.

### **Decision**

5. The application is brought under the provisions of section 46(1)(1) of the Act which reads:

“ 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) .....

(c) ...

(d) .....

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

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

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

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

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

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

(5) Where grounds of 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”.

6. Also of relevance is Section 100 of the Act 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.”

and rule 64 which reads:

“64. (1) Subject to rule 62(2) and as follows, evidence filed in any proceedings under the Act or these Rules may be given-

(a) By witness statement, affidavit, statutory declaration; or

(b) In any other form which would be admissible as evidence in proceedings before the court”

7. The meaning of genuine use was considered by the European Court of Justice (ECJ) in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85.

When answering the question referred to it, the ECJ stated:

“1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is “genuine use” of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

8. It went on to say:

“35....”Genuine use” therefore means actual use of the mark...

36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such 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...

37. It follows that “genuine use” of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector

concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issues, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

9. As the trade mark has a registration date of 12 March 2004 the relevant five year period which I must consider begins on 13 March 2004 and ends of 12 March 2009. Revocation is sought with effect from 13 March 2009.

10. In her counterstatement, Ms Newick states:

“We are involved in the development of the “VINISSIMO” brand with a group of possible partners in Spain.

We have attached:

- 1-Letter of the project coordinator (and the translation): 2 documents
- 2-Label designs: 3 documents
- 3-Marketing campaign pictures: 2 documents

I, Sophie Newick, as the owner of the TM “VINISSIMO”, state that although it hasn’t been in the market for the last few years, claim your benevolence to allow me to retain the trademark as, in my opinion it is still under development.

Hopefully this latest project will over this next year put the trademark into operational use.”

11. Ms Newick has not been professionally represented in these proceedings and it is not entirely clear whether she is claiming the mark has been used at some point during the relevant period or there are proper reasons for its non-use. Whatever the basis for her defence, none of the above material she has filed has been put into evidential form within the meaning of rule 64 of the Trade Mark Rules 2008 and on that basis, I do not consider the information provided in the counterstatement in any way meets the requirements of rule 64 and I decline to take it into account. The application for revocation therefore succeeds.

12. Even if I had taken the material attached to the counterstatement, into account, the application to revoke the registration would still have been successful and I go on to explain why.

13. As indicated above, Ms Newick attaches a number of documents to her counterstatement. These are as follows:

- 1. This is said to be a letter from the project co-ordinator. It is written in the Spanish language and is accompanied by a translation. I have no

details to explain who translated the document or his competency to do so though, from my own knowledge, there appears to be at least one error in it (para 2-“...también hemos contactado con dos productores/embotelladores...”) and it is incomplete (see below). The document is a photocopy and does not bear any address details of the sender or the intended recipient though it is directed to Ms Newick. It is on headed paper which appears to show it to be from BSF, the branding division of a commercial agency (the heading has not been translated). The document may be an email as it appears to have been sent in response to an email from Ms Newick (though that email is not before me) and indicates that BSF “is still interested” in distributing and bottling wine under the mark. It also states that BSF “would be interested in acquiring the brand VINISSIMO providing ofcourse (sic) that we agree on a price”. The letter is dated 9 July 2009 and therefore outside the relevant period.

2. These are said to be label designs. There are three pages each of which appear to me to be a computerised mock-up of a bottle of wine with a label superimposed onto it. Each of the labels bears the mark VINISSIMO in differing fonts. The pages are undated and there is no evidence any actual bottles have ever been produced.
3. These are said to be marketing campaign pictures. There are two photocopied pages each showing three pictures on them. Again the pages are not dated and there is no evidence that any marketing campaign has ever taken place.

14. Where this material is dated, it falls outside the relevant period. None of it appears to relate to the market, instead it seems to be something passed between a marketing agency and Ms Newick and therefore is internal use. Ms Newick talks of “possible partners” and there is no evidence which shows the mark has been used at any time within the UK and no reasons (“proper” or otherwise) are given to explain why the mark has not been put into use since it was registered. Whilst the letter from BSF (which post-dates the relevant period) suggests the company is involved in a project with Ms Newick, no details are given of that project in terms of dates, location, intention etc. I have no evidence by way of e.g. a witness statement from Ms Newick, which gives any explanation of the material she has filed or what it is intended to show and thus, had I taken it into account, I would have been left to speculate on its meaning. In my view she has failed to satisfy the requirement of Section 100 of the Act.

15. The application to revoke the registration succeeds in its entirety and the registration of the trade mark will be revoked with effect from 13 March 2009.

### **Costs**

16. The application for revocation has succeeded and the applicant is entitled to an award of costs in its favour. I take note that the material filed by Ms Newick was brief in the extreme, that the applicant filed no evidence itself and that no hearing took place.

17. In line with the scale of costs set out in Tribunal Practice Notice 6/2008, I award costs on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Preparing written submissions:	£300
Total:	£700

18. I order Sophie Newick to pay Vinissimus SL the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 01 day of February 2010**

**Ann Corbett**

**For The Registrar  
The Comptroller-General**