

O/428/17

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE APPLICATION UNDER NO. 3179013  
BY KETTLE PRODUCE LIMITED  
TO REGISTER THE TRADE MARK:**



**IN CLASSES 29, 30, 31, 32 AND 33**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 600000495  
BY HUNTAPAC PRODUCE LTD**

## BACKGROUND AND PLEADINGS

1. On 8 August 2016, Kettle Produce Limited (“the Applicant”) applied to register the figurative trade mark shown on the front page of this decision, which bears the mark text ‘Roots Collective Est. 1976.’ The application is in respect of the following goods:

<b>Class</b>	<b>Goods</b>
29	Vegetables, cooked.
30	Prepared meals.
31	Vegetables, fresh.
32	Non-alcoholic drinks.
33	Alcoholic beverages , except beer

2. The application was published for opposition purposes in the Trade Marks Journal on 7 October 2016. It is opposed by Huntapac Produce Ltd (“the Opponent”). The Opponent is the proprietor of a UK trade mark registration (No. 2523426) for the figurative trade mark shown below, applied for on 8 August 2009 and registered on 25 December 2009 in respect of “Carrots” under Class 31.



3. Since the Opponent’s registered trade mark has a date of application for registration earlier than that of the Applicant’s trade mark it is an “earlier trade mark” under Section 6(1)(a) of the Trade Marks Act 1994 (“the Act”).
4. The opposition, brought under the fast track opposition procedure, is based on section 5(2)(b) of the Act and is directed against all of the Applicant’s goods. The Opponent claims that the application is for a mark similar to the Opponent’s earlier trade mark and is for goods that are identical with or similar to those specified in the

Opponent's earlier registration. The Opponent has indicated in its notice of fast track opposition (Form TM7F) that it relies on its registration in respect of "Carrots" under Class 31, which in fact represents the whole of its registration.

5. Since the Opponent's earlier trade mark had been registered for more than five years when the Applicant's mark was published for opposition, the earlier mark is subject to the proof of use provisions under section 6A of the Act. (I set out relevant parts of that section later in this decision.) The Opponent has provided a statement detailing whether, during the relevant period,<sup>1</sup> its earlier mark had been put to genuine use in relation to "Carrots". The Opponent states that the mark has been used throughout the UK and, within its notice of fast track opposition, the Opponent provided the proof of use on which the Opponent wishes to rely. I will summarise that evidence in this decision.
6. Although Rules 20(1)-(3) of the Trade Marks Rules - which are the provisions that deal with evidence rounds - do not apply to fast track oppositions, Rule 20(4) does apply. It reads: "*(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit*". This implies that parties in fast track oppositions are required to seek leave from the registrar if they wish to file evidence. The only exception to that general position is that a fast track opponent who is relying on an earlier mark that is subject to proof of use must file evidence of use at the time of filing the opposition. Neither party sought leave to file evidence in these proceedings. This point has some bearing on a point arising from the Applicant's counterstatement and I shall deal with that later in this decision.
7. The Applicant filed a notice of defence and counterstatement in which it denies the grounds of opposition. The counterstatement also contends that the opposition should be rejected on the basis that the Opponent has failed to provide sufficient evidence to demonstrate genuine use of the Opponent's earlier trade mark. The counterstatement includes extensive comments on the Opponent's evidence of use and I shall refer to those points later in this decision.

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<sup>1</sup> The relevant period is the period referred to in section 6A(3)(a)

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if the registry requests it, or if either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary in the present case.
9. Both the Applicant and the Opponent have provided written submissions in lieu of a hearing. I bear these in mind and shall refer to them in this decision where appropriate.
10. The Applicant is represented in these proceedings by CMS Cameron McKenna Nabarro Olswang LLP while Wilson Gunn represents the Opponent. I take this decision based on the papers before me and taking into account relevant jurisprudence.

#### **THE OPPONENT'S EVIDENCE**

11. The Opponent states that the "*Roots brand has been used for the sale of fresh produce and as a branded Roots vegetable crisp line to retailers and wholesalers.*" The Opponent has provided evidence that comprises 13 exhibits which it lists in the following terms:

*"Exhibit 1 – 8: Roots labelled applied & images of Roots crisps.*

*Exhibit 9: Presentation for wholesales*

*Exhibit 10: Press release – Roots vegetable crisps.*

*Exhibit 11: Roots brochure*

*Exhibit 12: Roots Asparagus for Booths Supermarket – invoice*

*Exhibit 13: Roots Crisps – Booker wholesale – invoice."*

12. The Form TM7F asks the Opponent to provide details of sales achieved under the mark in the UK during the relevant period. It stipulates that these figures should, if possible, be provided on an annual basis and, if possible, be split in relation to each of the goods for which use of the mark is claimed; estimates should be provided if

exact figures are not readily available. The Opponent's completed TM7F cross-references to its "Appendix II", where it sets out the following information:

	2015/16	2014/15	2013/14	2012/13
"Roots" Veg Crisps	£131,297.00	£50,430.00	£28,228.00	£18,607.00
"Roots" Fresh Produce	£61,047.00	£44,554.00	£38,560.64	£80,402.17
Total	£192,344.00	£94,984.00	£66,788.64	£98,469.17

13. **Exhibit 1** has the appearance of being a printout of a single slide from a presentation. It is headed "Our 'Roots' Offering" and includes a bullet point proclaiming "Strong branding – a 'family' of products". The word HUNTAPAC appears in the bottom right corner of the exhibit. The exhibit is not dated. It comprises ten images of very similar rectangles, each bearing the word Roots, seemingly in the figurative form of the Opponent's trade mark. The images are very poor in quality, but single words are variously legible (just) - including in one image 'Leeks', in another 'Broccoli' and in another 'Green Cabbage.' A further image is not rectangular in shape and could possibly be an image of a packet. That image is seen to bear the words "Quality, it's in our Roots" – again the latter word in the figurative form of the Opponent's trade mark. Also legible are the words "No Need to Peel."
14. **Exhibit 2** is again not dated. The exhibit also shows nine poor quality images of what may be packaged, labelled vegetables. The labels apparently applied to the packaged vegetables all bear the word "Roots" in the figurative style of the Opponent's mark. Two of the images bear legible words that identify the packages as containing, respectively, 'Iceberg Lettuce' and 'Cauliflower'. The exhibit also shows an image of a tag on a piece of string. On the tag, the following words are legible: "THE ROOTS RANGE" (not in a figurative format), "Fresh quality every day! The best in British produce. Grown, washed, packed and delivered into [...]". The exhibit also includes the name "HUNTAPAC", below which is the slogan "Growing for over 70 years."

15. **Exhibit 3** is again undated. It shows a poor quality image of what may possibly be a packet of crisps. The word “Roots” in the figurative style of the Opponent’s trade mark is half legible on the packet.
16. **Exhibit 4** is again undated. It appears to be an example of a label, but since it is in large part blank, it is clearly not one that shows actual use on a product. That image is seen to bear the words “*Quality, it’s in our Roots*” – the latter word in the figurative form of the Opponent’s trade mark, indeed the word is accompanied by an encircled capital letter R indicating registration. The words quoted overlay what appear to be images of vegetables. Also legible are the words “*Vegetable Selection*” and “*Contains Carrots (UK), Parsnip (UK), Swede (UK), Leek (Spain), Onion (Spain)* *Xxxxxxx Xxxxxx xxxxxxx xxxxxx xxxxx xxx*” and “*Display until*” “*Weight*” and “*Class*” – where the space for those relevant data is blank.
17. **Exhibit 5** is again undated. It shows a poor quality image of what may possibly be a packet of crisps. The word “Roots” in the Opponent’s figurative style is half legible on the packet, along with “Hand Cooked”. The exhibit also shows the text “...ble Crisps” and an image of what looks like it could be a white tub, bearing the word “Roots” in the Opponent’s figurative style.
18. **Exhibit 6** is again undated. It appears to be an image of a package of vegetables, bearing a “Vegetable Selection” label largely as described for Exhibit 4. The label is in large part blank, and it is not possible to say what the package contains, although a leek appears to be visible.
19. **Exhibit 7** is again undated. It shows an image of what may well be the same type of packet of crisps shown in Exhibit 5. The packet appears to be leaning against a rectangular block on which are seen the words “Roots” in the Opponent’s figurative style is half legible on the packet, along with “*Hand Cooked Vegetable Crisps*”.
20. **Exhibit 8** is again undated. It appears to be an image of a package of a round vegetable – probably a swede - bearing a label that includes the Opponent’s trade mark.

21. **Exhibit 9** comprises 11 undated pages.

Page 1 is an image of the Opponent's mark on the previously seen crisp packet. Pages 2 and 3 give an account of the "Huntapac story" over 70 years as "*one of the UK's leading growers of root vegetables supplying wholesale markets and retailers such as Tesco, Waitrose, Sainsbury's and M&S.*" The account appears (as the Opponent initially referred to the exhibit) to be part of a presentation and each slide exhibited includes as part of its footer both the Opponent's figurative mark and the website reference "*rootscrisps.co.uk*".

Page 4 shows the brand images of what the slide describes as "Huntapac's Key Customers" which, in addition to the well-known stores mentioned above, lists Spar, Aldi, Makro, Booker and others.

Page 5 explains that "*in early 2013, the business embarked on an entirely new product, its own brand of Vegetable Crisps ~ Roots Hand Cooked Vegetable Crisps ...*".

Page 6 continues: "*Thinly sliced, the carrot, parsnip and beetroots are cooked in sunflower oil and lightly seasoned with sea salt.*"

Page 7 declares the vegan and gluten free credentials of the vegetable crisps.

Page 8 advertises the wholesale and retail prices of the vegetable crisps, available in a case of 18 x 50 gram bags or a 600 gram container – "*great for garnishing soups and sandwiches or decanted into bowls as appetisers.*" It also highlights a "*minimum 16 weeks life on all products from point of delivery.*"

Page 9 outlines Huntapac's distribution and delivery, mentioning its "*own fleet of 60 articulated delivery vehicles.*" The exhibit includes a poor quality image of an articulated lorry, which seems to bear the Opponent's mark on its side. Page 10 stipulates minimum orders of 84 cases of crisps or 40 x 600g containers of crisps.

Page 11 includes cuttings of "*Roots in the press ...*". The four press extracts appear to be from lep.co.uk, Bite, Lancashire Food and CLH. (These publications are not known to me.) The four articles pictured are too small to read in their substance, but from their headings and incorporated photos it is clear that the press items relate to Roots vegetable crisps. No dates are visible.

22. **Exhibit 10** is said to be a press release and indeed, those words are hand-written on it. The document carries the date of 27 June 2013 and the Huntapac logo and the

words “Quality, it’s in our Roots” – again the word ‘roots’ rendered in the Opponent’s figurative registered form. The exhibit carries the title “*Huntapac bids to crack snacks category with new Roots Vegetable Crisps*”. In its three pages, the document outlines Huntapac’s diversification into vegetable crisps, which it says will be “*available only at branches of leading wholesaler Booker*” and “*... are an extension of the company’s existing Roots range of vegetables and salads.*” The press release states that “*Huntapac is one of the UK’s leading producers of carrots and parsnips, supplying stores and markets across the UK*” “*Huntapac grows and packs directly (from seed to shelf) a range of products from root vegetables, brassicas, salads and organic vegetables.*” The evidence gives no indication of whether or to whom this press release was circulated.

23. **Exhibit 11** is another advertising piece for vegetable crisps under the Opponent’s trade mark. It is undated and the Opponent earlier described the exhibit as a Roots brochure. Its promotional text includes a repetition that Huntapac is one of the UK’s leading producers of carrots and parsnips and that “*Huntapac believed that its lovingly grown root vegetables could be used in other ways ... A vegetable crisp which began its life as a humble Huntapac root vegetable, grown in our own fields, by our own farmers.*”
24. **Exhibit 12** is an invoice under the HUNTAPAC logo to a company called E.H. Booth. It is dated 6 May 2016. Four of the items on the invoice are listed as carrots, fifth item lists “Cauli, Carr&Broc x 8”. If I include the latter mixed item, the invoice in respect of carrots totals £1,062.33. The invoice mentions “Roots” only in a hand written addition of the word alongside the printed itemisation of asparagus. Indeed, the Opponent earlier described this exhibit as “*Roots Asparagus for Booths Supermarket – invoice.*”
25. **Exhibit 13** is an invoice under the logo HUNTAPAC to the wholesale company Booker Ltd. It is dated 13 September 2016. It lists Roots Crisps to the value of £1,108.80.
26. That concludes my summary of the Opponent’s evidence.



## PROOF OF USE

27. The Opponent must show that the earlier mark has been put to genuine use in relation to the registered goods on which it relies during the 5 years up to the date when the Applicant's mark was published for opposition purposes. The relevant period for proving use in this case is therefore 8 October 2011 to 7 October 2016.
28. Section 6A states that the use conditions are met if :
- “ ... (3) (a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.”
29. Section 100 of the Act makes it clear that the burden of proving use of a trade mark falls on the Opponent.
30. I must determine whether the submitted evidence is sufficient to show that the Opponent's earlier trade mark has been put to genuine use during the relevant period in relation to the registered goods on which it relies, namely Carrots in class 31.
31. This determination must be made in light of the numerous principles established in relevant case law. The case law on genuine use of trade marks was summarised by Arnold J in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, who said as follows:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the Court of Justice of the European Union (CJEU) in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* 2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH*

[2009] ECR I-2759 (to which I added references to Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in 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 that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

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

32. In making my determination as to whether the evidence presented shows the necessary genuine use, I also take account of judicial comment as to probative and evidential issues in such cases. In *Awareness Limited v Plymouth City Council*<sup>2</sup>, Mr Daniel Alexander Q.C. 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.”

33. In *Dosenbach-Ochsner*<sup>3</sup>, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person stated that:

“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

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<sup>2</sup> Case BL O/230/13

<sup>3</sup> *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13

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."

#### Parties' submissions

34. Having noted the legal framework around proving genuine use, I take account too of what the parties say on the matter. The Opponent, as part of its written submissions in lieu of an oral hearing, states only the following in support of its evidence of use:

*"The Opponent has indicated clearly on the Form TM7F in a statement of truth that the mark in use is the mark subject of UK Registration No. 2523426 (indicated above). The Opponent has confirmed that use has been made throughout the United Kingdom. To support this the Opponent has provided evidence including, sales figures for 'fresh produce' for the period 2012 - 2016.*

*The Opponent has therefore satisfied the proof of use requirements in respect of the registered trade mark, goods covered 'fresh produce' covers the goods 'carrots', use has been made throughout the UK, and the use has been made within the relevant time period."*

35. For its part, the Applicant, both in its counterstatement and in its written submissions in lieu of an oral hearing, makes numerous points in support of its contention that the Opponent has failed to provide sufficient evidence to demonstrate genuine use of the Opponent's mark in relation to carrots. In its counterstatement, the Applicant says as follows:

*"... Appendix II to the Opposition provides financial figures for "Veg Crisps" and "Fresh Produce" sold under the Opponent's Mark. Sales of crisps cannot be used to demonstrate use of the Opponent's Mark for carrots. Carrots and crisps are completely different types of food items. Indeed, under the Nice*

*Classification they appear under different classes of goods with crisps listed under class 29 and carrots under class 31.*

*9. Further, Appendix II does not provide a breakdown of the sales figures of "Fresh Produce" to indicate whether the fresh produce included carrots and the number of actual units sold. In any case, numbers are so small that any sales of carrots (although this is not admitted) would at best constitute a small element of this. Based on these figures, it is impossible for the Applicant or the Registry to assess the scale of use.*

*10. Exhibits 1-8 filed with the Opposition constitute images of product packaging which use the Opponent's Mark (the "Packaging Exhibits"). Evidence of packaging does not demonstrate that the products have actually been put on the market. It does not demonstrate whether sales of carrots using the Opponent's Mark is sufficiently significant so as to demonstrate proper use of the Opponent's Mark in relation to carrots.*

*11. In any event, Packaging Exhibits 3, 5, and 7 appear to depict images of the Opponent's crisps products which use the Opponent's Mark. This is not sufficient to demonstrate use with regards to carrots which, as mentioned above, is a different type of food item. The remaining Packaging Exhibits appear to depict images of the Opponent's vegetable products which use the Opponent's Mark. The vast majority of these appear to be in relation to vegetables which are not carrots such as cabbages, leeks, broccoli, cauliflower, lettuces and parsnips, and therefore do not demonstrate use in relation to carrots. It must however be noted that the quality of the Packaging Exhibits provided by the Opponent is poor and it is not possible to determine with certainty precisely which vegetable products are being sold under the Opponent's Mark.*

*12. Exhibits 9 and 10 provide evidence in relation to the Opponent's use of the Opponent's Mark in relation to its crisps brand only. In fact, an article on page 11 of Exhibit 9 even refers to the Opponent as a "crisp company". As already mentioned, this does not sufficiently demonstrate use of the Opponent's Mark in relation to carrots. Although page 1 of Exhibit 10 also refers to the Opponent's*

*range of vegetables and salads, this fails to indicate whether any, or what quantity, of those vegetables which use the Opponent's Mark are carrots.*

*13. Furthermore, even if any carrots are sold by the Opponent (of which it is the Opponent's burden to prove), there is no indication from the evidence provided that any carrots sold by the Opponent are sold using the Opponent's Mark. On the contrary, the invoices in Exhibits 12 and 13 demonstrate that carrots are sold either unbranded or under the Opponent's customer's own brand. This is clear as those products on the invoices which are sold under the brand of the Opponent's Mark (asparagus in Exhibit 12 and crisps in Exhibit 13) are labelled as such.*

*14. Exhibit 12 is an invoice addressed to E.H. Booth, a supermarket which trades as Booth's. The Exhibit demonstrates that carrots were sold by the Opponent to E.H. Booth. However, Booth's website advertises carrots for sale under its own name (Booth's Chantenay Carrots) rather than under the Opponent's Mark. A screenshot from the Booth's website taken on 4 April 2017 is appended as an exhibit to this Counterstatement. This further supports the view that the Opponent does not sell carrots to E.H. Booth under the Opponent's Mark, even if it initially sourced carrots from the Opponent.*

*15. In summary, the Opponent has failed to evidence financial turnover, sales invoices, other sales records or advertising relating specifically to the sale of carrots under the Opponent's Mark.*

*16. The evidence has failed to demonstrate that the Opponent has made any sufficient sales of carrots under the Opponent's Mark brand to prove genuine use of the Opponent's Mark. The evidence rather indicates that any potential sales of carrots by the Opponent are not branded with the Opponent's Mark.*

*17. The evidence which forms the basis of the Opposition is therefore irrelevant and the Opposition should be rejected in its entirety.*

36. In its written submissions in lieu of an oral hearing, the Applicant further states as follows:

*“... the Opponent has failed to discharge the burden of proof of genuine use of the mark as registered for the relevant goods.*

*2.3 The evidence provided does not adequately indicate the place, time, extent or nature of use of the Registration in respect of the class 31 goods. In particular, the evidence does not show genuine use of the Registration as it does not relate to the registered goods and much of the evidence is undated, lacking in indications of place and/or lacking information regarding the extent to which it has been made available.”*

37. The Applicant’s submissions cite the relevant legal principles (much as I have set out earlier in this decision) and continue as follows:

*3.3 As explained below, it is clear that the evidence submitted by the Opponent is neither sufficient nor clear enough to prove objectively the "genuine use" of the Registration as a trade mark in the: UK in relation to the goods covered by the Registration relied upon during the Relevant Period.*

*3.4 Following La Mer the evidence supplied by the Opponent is not sufficient to preserve or create a market share for the goods "carrots". The evidence is largely undated and the financial figures provided are unsubstantiated. The evidence provided is minimal for the market that the Opponent appears to operate in namely raw carrots. The root vegetables market in the UK and carrots specifically generates substantial revenue and the Opponent has failed to provide any concrete evidence of sales figures or advertising/marketing expenditure.*

...



#### 4. COMMENTS ON THE OPPONENT'S .PROOF OF USE EVIDENCE

4.1 *The Opponent's Registration is for the mark ROOTS (stylised), registered in respect of the following goods: Class 31: Carrots*

4.2 *None of the evidence supplied by the Opponent gives any indication as to what products are offered. Mere inclusion of the mark on materials in the absence of any information linking the mark to specific products is not sufficient to establish genuine use and should be disregarded.*

4.3 *The Applicant has already provided an assessment of the evidence of use provided by the Opponent in its Counterstatement, at paragraphs 5 - 17. For the avoidance of doubt, we reiterate the following points:*

4.3.1 *Appendix II - claims to show figures for "Veg Crisps" and "Fresh Produce", but no breakdowns have been provided as to what the figures relate to, the geographical location nor what constitutes 'produce'. Further; the inclusion of 'Roots Veg Crisps' is irrelevant, as it does not support use of the Registration in respect of its registered goods, namely "Carrots".*

...

4.3.11 *Exhibit (unknown) (pages 18-19 ) - appears to show a press release, which discusses a range of vegetable crisps. Prima facie, this appears to be an internal document. Whilst it has a date of 27 June 2013, it is impossible to assess where the press release was targeting or if in fact it was ever released. There is no evidence to support that this document was circulated externally to consumers or used in a way to promote goods under the Registration.*

#### Decision as to proof of use

38. I find myself in agreement with the majority of the points made by the Applicant. It should be noted, however, that I expressly take no account of the exhibit (or points arising from it) that is contained within the Applicant's counterstatement since there

was no request by the Applicant to submit evidence in these proceedings.<sup>4</sup> Nonetheless, in my own assessment of the invoice at **Exhibit 12** I consider it self-evident that it in no way shows use of the Opponent's earlier trade mark registration for carrots.

39. Much of the evidence relates to use of the mark in relation to vegetable crisps. Although an ingredient of those crisps appears to be carrots, the goods are clearly quite different. I understand carrots to mean simply those vegetables in a form essentially unchanged from their harvest. By contrast, a carrot transformed into a vegetable crisp will have undergone very considerable processing, including slicing and particularly frying in oil and seasoning. A customer in search or need of carrots would hardly be likely to substitute that item with mixed vegetable crisps. An exhibit therefore has no evidential value in demonstrating genuine use of the mark in relation to carrots insofar as such an exhibit relates only or partly to vegetable crisps.
40. The only evidence of potential relevance is that which relates to "Roots" Fresh Produce. However, even those exhibits that relate in some way to fresh vegetables commonly fail to show any perceivable use of the earlier mark in relation to carrots. In the context of growing root vegetables, including carrots, some exhibits refer primarily or exclusively to Huntapac, rather than to Roots. Most exhibits are made irrelevant by their being undated, and/or by their quality of reproduction being so poor that one cannot make out the detail or even the gist of the presented images and text.

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<sup>4</sup> I note that Tribunal Practice Notice 2 / 2013, which deals with fast track proceedings, states that "*Where either party considers it necessary to file (further) evidence, a request for leave to file such evidence should be submitted as soon as possible and, at the latest, within 14 days of the serving of the Form TM8 (counterstatement). Each such application will be considered on its merits. The Registrar is more likely to accede to such requests where: ... ii) The applicant wishes to file evidence of fact (not comments or arguments) to challenge facts contained in the opponent's evidence of use of it earlier mark(s).*" For the sake of completeness, had the exhibit been accepted into evidence, it would have entailed no evidential benefit for the Applicant, not least because the Applicant's exhibit is undated and the fact that the supermarket in question applied their own name to the carrots is not significant. What is clearly more significant is the absence of relevant branding in the Opponent's Exhibit 12.

41. The Opponent provides little by way of clear information to aid in understanding the context of the filed evidence. As the Applicant submits, “*genuine use requires that use is made as a trade mark, not purely for illustrative purposes or on purely promotional goods. The mere inclusion of the Registration on a document is insufficient for the purposes of proving genuine use, in the absence of any information of the exact nature of the products.*” It may be that some of the exhibits show use of the mark on packaging and even that the packaging contains carrots, but, as the Applicant also submits packaging does not demonstrate that the products have actually been put on the market.
42. Huntapac refers to its being one of the UK’s leading producers of carrots (and other vegetables) and its statement of having a distribution fleet of 60 articulated vehicles supports the impression of its being a sizable and significant organisation. If it is the case that it has used its Roots mark in relation to carrots, it ought therefore to have been straightforward to provide clear and compelling financial and promotional information to that effect. I note the aphorism of Lord Mansfield<sup>5</sup> that 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.*”
43. The Opponent’s evidence under Appendix II gives data relating to “*Roots*” *Fresh Produce* that is both undifferentiated and unsubstantiated. I agree with the Applicant’s comment that it is not possible, based on the figures presented, for the Applicant or the Registry to assess the scale of use in respect of carrots.
44. Overall, I find that the evidence is not sufficient to show genuine use of the Opponent’s earlier trade mark in respect of the registered goods during the relevant period. The Opponent is therefore unable to rely on its earlier mark as a basis for this opposition. In the circumstances, I cannot consider the merits of the Opponent’s claim under section 5(2)(b) of the Act. The opposition fails.

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<sup>5</sup> In *Blatch v. Archer* (1774) 1 Cowp 63 at 65, 98 ER 969 at 970

## Costs

45. Since the opposition has failed, the Applicant is entitled to a contribution toward its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice 2 of 2015.
46. I award the Applicant the sum of £500 (five hundred pounds) as a contribution towards the cost of the proceedings, calculated as follows:

Considering notice of opposition and filing a notice of defence and counterstatement	£200
Filing written submissions	£300
<b>Total</b>	<b>£500</b>

47. I therefore order Huntapac Produce Ltd to pay Kettle Produce Limited the sum of £500 (five hundred pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12<sup>th</sup> day of September 2017**

**Matthew Williams**  
**For the Registrar,**  
**the Comptroller-General**