O-591-18

TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED APPLICATIONS
Nos. 501337, 501338 & 501339
BY JACK RUSSELL MALLETIER SAS

FOR REVOCATION OF TRADE MARK
Nos. 3074644, 2319138 & 3076162

STANDING IN THE NAME OF
UNION JACK MARKETING LIMITED

BACKGROUND

1) The following trade marks are registered in the name of Union Jack Marketing Limited (hereinafter UJM).

Mark	Number	Date registered	Class	Specification
JACK RUSSELL	3074644	03.03.06	9	Sunglasses; audio bearing media; video bearing media but not including any such goods in the form of or relating to animals.
			18	Articles made of leather or imitation leather; rucksacks; backpacks; bags; cases; wallets; purses; key holders; key fobs; luggage; umbrellas and parasols.
			25	Articles of clothing; footwear; headgear.
JACK RUSSELL	2319138	18.03.05	14	Shaving items and cufflinks of precious metals or coated therewith, all included in Class 14.
			18	Bags, holdalls, briefcases and wallets, all of leather or imitation leather.
			25	Articles of clothing including footwear and headgear.
JACK RUSSELL	3076162	07.07.06	35	The bringing together, for the benefit of others, of a variety of, sunglasses, audio and/or video bearing media, rucksacks, backpacks, bags, holdalls, briefcases, wallets, cases, purses, key holders, key fobs, luggage, umbrellas, parasols, badges, articles of clothing,

				footwear, headgear enabling customers to conveniently view and purchase those goods from a retail outlet, by mail order or, via the internet.

2) By three applications all dated 16 September 2016 Jack Russell Malletier SAS (hereinafter JRM) applied for the revocation of all three registrations shown above under the provisions of Section 46(1)(a) claiming there has been no use of the trade marks on the goods and services for which they are registered in the five year periods 03.03.06 – 03.03.11 (re 3074644); 18.03.05 – 18.03.10 (re 2319138) and 07.07.06 – 07.07.11 (re 3076162) with revocations dates of 04.03.11, 19.03.10 and 08.07.11 respectively. JRM also seeks revocation of all three marks under 46(1)(b) claiming there has been no use in respect of the three trade marks on the goods and services for which they are registered in the five year period 16 September 2011 – 15 September 2016. Revocation is sought from 16 September 2016. Notice of the intention to file a revocation action was provided on 12 July 2016 and so use after this date cannot be taken into account. The revocation actions under both Section 46(1) (a) & (b) relate to all goods in classes 9 & 18, and footwear & headgear only in class 25 (3074644); all goods in classes 14 & 18, and footwear & headgear only in class 25 (2319138) and all services in class 35 (3076162). On 9 January 2017 the revocation applications were consolidated.

3) On 4 December 2016, UJM filed its counterstatements. It contends that its marks 3074644 & 2319138 have been used during the specified periods in respect of Bags; cases; in class 18 and Belts; boxers; jumpers; scarves in class 25. It contends that its mark 3076162 has been used during the specified periods in respect of Retail and wholesale services in respect of bags; cases; articles of clothing, footwear and headgear in class 35.

4) Only UJM filed evidence. Neither side wished to be heard.

UJM'S EVIDENCE

5) UJM filed a witness statement, dated 7 February 2017, by Adrian Michael Potts a Director of UJM. He states that the registrations were originally in the name of Mr Robert

Charles Russell t/a Jack Russell. Mr Russell initially licensed Suttle Textiles Ltd to use the three marks and in 2007/2008 the registrations were transferred to Jack Russell Clothing Limited (JRCL), a company which was dissolved in July 2013. This company had stores in the UK and Spain which closed progressively in the period December 2011- March 2013. JRCL also had a website which sold its products from 2007 until March 2013. Mr Potts was a director of Suttle Textiles Ltd and JRCL. From the Registry records it is clear that the three marks were assigned to UJM on 1 September 2014.

6) Mr Potts states that he has had problems finding evidence relating to use, prior to the dissolution of JRCL but has managed to find various instances of use. He provides the following exhibits:

- AMP1: Photographs of the various stores which show use of the marks in suit over the shops, but are undated.

- AMP2: A copy of a sales report for the period 1 October 2011-29 December 2011 which shows sales of men's, ladies' and girls' wear for the stores in Cirencester, Morpeth and Oakham. This report shows sales of the following items: Scarves, T-shirts, sweatshirts, rugby shirts, polo shirts, joggers, jumpers, tunics, gloves, blouses, hats, tank tops, loungers, socks, mittens, berets.

- AMP3 & 4: The first is a copy of a sales report for the Oakham store for the period 1 September 2011 to 31 December 2011. From exhibit 3, Mr Potts has extracted sales relating to the period 17 September 2011 – 31 December 2011. These show sales of items in classes other than 18 & 25 such as razor and brush stands, razor stands and shaving brushes all in class 21; cologne, skin food, shaving cream, shaving soap in Class 3 and footballs in class 28. It also shows sales of, inter alia, scarves, belts, boxers, aprons, gloves, hats, ties, socks, jackets, jumpers, cardigans, trousers, T-shirts, mittens, loungers, berets, blouses, joggers, sweatshirts, tunics, raincoats, coats and shoes in class 25 and writing cases and messenger bags in class 18. However, Mr Potts points out that only certain items, to wit, boxers (23 pairs), T shirts (44), shirts (13) and jumpers (27) in class 25 and writing cases (3) and messenger bags (1) in class 18, bore the mark consisting of or including "JACK RUSSELL". These products are identified by the terms "JACKS" and had upon them

the name JACK RUSSELL sometimes accompanied with a Union Jack and/or image of a terrier.

- AMP5: Photographs of items which are said to show the mark in suit with a Union Jack and/or terrier logo. These include handkerchiefs, a jumper, two belts (one leather the other canvas) and a scarf. However, the only item where the mark can be clearly seen is a handkerchief, which is in class 24.

- AMP6: Photographs of kitbags, messenger bag and a writing case which are claimed to have the mark in suit and the logo off a terrier and/or a Union Jack. Of the five pictures only on three can the mark JACK RUSSELL be made out, all three have a terrier device above the name towards the top of the bag, and a Union Jack near the base of the bag.

- AMP7: Mr Potts states that since March 2016 his company has been exporting goods to China such as items in classes 10, 21 and 24 as well as Bracelets in class 14, Handbags, cross body bag, backpacks and wallets in class 18, handkerchiefs in class 24, and items such as trousers, ties, socks shirts, jackets, waistcoats, raincoats, jumpers, T-shirts, jeans, sweatshirts and shoes under the mark JACK RUSSELL EMPORIUM and device. The exhibit is a spreadsheet which corroborates the claims in so far as it shows the items named on a list of goods and details of the sale. These are dated 4 March 2016 – 18 January 2017.

- AMP8 / 9: An illustration of the mark referred to in exhibit 7 above. The products are sold in China via a website JD.com which is said to be a Chinese electronic commerce company. The website includes a link to Mr Potts' company at the web address "jremp.jd.hk". All sales through this website have to go through a Chinese intermediary and so when an order is received, the item is shipped to this intermediary called Paul's Boutique, and raises an invoice to the same company which pays for the item and arranges onward shipping to the ultimate client in China. Whilst other brands are offered for sale, it does show use of the Jack Russell brand on casual shirts.

7) That concludes my review of the evidence. I now turn to the decision.

DECISION

8) The revocation action is based upon Section 46(1)(a) & (b) of the Trade Marks Act 1994, the relevant parts of which read as follows:

> "Section 46(1) of the Act states that:
>
> > "The registration of a trade mark may be revoked on any of the following grounds-
> >
> > (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
> > (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
> > (c).....
> > (d).....
> >
> > (2) For the purpose of subsection (1) use of a trade mark includes use in a form 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 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 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."

9) Section 100 is also relevant, which 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."

10) The revocation actions were filed on 16 September 2016 with revocation sought under Section 46(1)(a) & (b) as follows:

Mark	Section	Period	Revocation date
3074644	46(1)(a)	4 March 2006 – 3 March 2011	4 March 2011
2319138	46(1)(a)	19 March 2005 – 18 March 2010	19 March 2010
3076162	46(1)(a)	8 July 2006 – 7 July 2011	8 July 2011
3074644	46(1)(b)	16 September 2011 – 15 September 2016	16 September 2016
2319138	46(1)(b)	16 September 2011 – 15 September 2016	16 September 2016
3076162	46(1)(b)	16 September 2011 – 15 September 2016	16 September 2016

11) In determining whether UJM has used its trade marks I take into account the case of *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited,* [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

> "217. *The law with respect to genuine use* . 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 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).
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> 218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word "genuine",

other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in Ansul at [35], there is a similar difference in language in what is now recital (9) of the Directive.

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]."

12) I also take into account the case of *Naazneen Investments Ltd v OHIM*, Case T-250/13, in which the General Court upheld a decision by the OHIM (now the EUIPO) Board of Appeal that the sale of EUR 800 worth of non-alcoholic beverages under a mark over a 5 year period, which had been accepted was not purely to maintain the trade mark registration, was insufficient, in the economic sector concerned, for the purposes of

maintaining or creating market share for the goods covered by that Community trade mark. The use was therefore not genuine use. The relevant part of the judgment of the General Court is as follows:

> "46. In the fifth place, the applicant argues that, in accordance with the case-law cited in paragraph 25 above, use of a trade mark is to be regarded as token if its sole purpose is to preserve the rights conferred by the registration of the mark. It claims that the Board of Appeal contradicted itself by stating, on the one hand, in paragraph 31 of the contested decision, that the total amount of transactions over the relevant period seemed to be token, and by stating, on the other hand, in paragraph 42 of the contested decision, that it did not doubt the intention of the proprietor of the mark at issue to make real use of that mark in relation to the goods in question.
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> 47. In this connection, suffice it to point out that the applicant's argument is based on an incorrect reading of the contested decision. The Board of Appeal used the term 'token' to describe the total amount of transactions, approximately EUR 800, and not to categorise the use of the mark at issue.
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> 48. In the sixth place, the applicant claims that the Board of Appeal, by relying solely on the insufficient use made of the mark at issue, did not comply with the case-law according to which there is no quantitative threshold, determined a priori and in the abstract, that must be chosen in order to determine whether use is genuine. The Board of Appeal also failed to comply with the case-law according to which even minimal use may be sufficient in order to be deemed genuine.
>
> 49. According to the case-law, the turnover achieved and the volume of sales of the goods under the mark at issue cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market. As a result, use of the mark at issue need not always be quantitatively significant in order to be deemed genuine (see, to that effect, judgments in *VITAFRUIT*, cited in paragraph 25 above, EU:T:2004:225, paragraph 42, and *HIPOVITON*, cited in paragraph 27 above, EU:T:2004:223, paragraph 36). Even minimal use can therefore be sufficient in order to be deemed genuine, provided that it is warranted, in the

economic sector concerned, to maintain or create market shares for the goods or services protected by the mark. Consequently, it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine. A de minimis rule, which would not allow OHIM or, on appeal, the General Court, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order of 27 January 2004 in *La Mer Technology*, C-259/02, ECR, EU:C:2004:50, paragraphs 25 and 27, and judgment of 11 May 2006 in *Sunrider* v *OHIM*, C-416/04 P, ECR, EU:C:2006:310, paragraph 72).

50. In the present case, contrary to what the applicant claims, the Board of Appeal did not determine a minimum threshold 'a priori and in the abstract' so as to determine whether the use was genuine. In accordance with the case-law, it examined the volume of sales of the goods in question in relation to other factors, namely the economic sector concerned and the nature of the goods in question.

51. The Board of Appeal accordingly took the view that the market for the goods in question was of a significant size (paragraph 28 of the contested decision). It found also that the goods in question, namely non-alcoholic beverages, were for everyday use, were sold at a very reasonable price and that they were not expensive, luxury goods sold in limited numbers on a narrow market (paragraph 29 of the contested decision). Furthermore, it took the view that the total amount of transactions over the relevant period, an amount of EUR 800, seemed to be so token as to suggest, in the absence of supporting documents or convincing explanations to demonstrate otherwise, that use of the mark at issue could not be regarded as sufficient, in the economic sector concerned, for the purposes of maintaining or creating market shares for the goods covered by that mark (paragraph 31 of the contested decision).

52. It is therefore apparent, contrary to what the applicant claims, that it was in accordance with the case-law cited in paragraph 49 above that the Board of Appeal took the view that, in the present case, minimal use was not sufficient to be deemed genuine."

13) I also look to *Awareness Limited v Plymouth City Council,* Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

and further at paragraph 28:

"28. ..... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted."

14) I also note that in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric*

Industrial Co. v. Comptroller- General of Patents [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

15) The three marks under consideration are all identical and are for the word only mark "JACK RUSSELL". Some of the evidence shows this mark being used with a terrier device and/or a device of the Union Jack. I must consider whether the use of the mark with these devices is able to be regarded as use of the registered marks. If I consider that the devices do not have a distinctive character then the distinctive character of the mark would be the word only element and, as such, UJM could rely upon the use filed to maintain its registrations. In *Nirvana Trade Mark,* BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. …. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period…

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

16) The same point was raised in *Remus Trade Mark* – BL O/061/08 (Appointed Person) & *OAO Alfa-Bank v Alpha Bank A.E.* - 2011 EWHC 2021 (Ch) and *Orient Express Trade Mark* - BL O/299/08 (Appointed Person). Although these cases were decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, they remain sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered.

17) In *Colloseum Holdings AG v Levi Strauss & Co.,* which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

18) To my mind, the device element of a terrier simply emphasises the registered mark as the device when used next the name "JACK RUSSELL" will be seen as simply a device of a Jack Russell terrier a well-known breed in the UK. I find use of the registered mark with the device of a Jack Russell terrier to be use of the mark as registered. Similarly, the use of a device of a Union Jack flag, merely emphasises the Britishness of the product, and will not detract from the mark JACK RUSSELL being perceived as the indication of origin of the goods and/or services. I must also consider the use of the mark JACK RUSSELL EMPORIUM which began in March 2016. The word EMPORIUM is a standard dictionary word which usually refers to a retail store selling a wide range of goods, such as a department store. Use of this mark would not detract from the message that the source of origin of the goods was JACK RUSSELL. It is synonymous with using Jack Russell shop.

19) When one looks at the evidence filed by UJM, individually it is relatively easy to decry its evidential value. However, when one takes into account the entirety of the evidence, Mr Potts provides a clear narrative of a business with shops in numerous towns and cities in the UK selling a range of clothing and bags. Although undated, the photographs at exhibit

AMP1 corroborate the claim to have had a number of UK stores, and Mr Potts has provided closing dates for the same. Equally although only for a limited period the sales reports at AMP2 showing sales in three of the stores during the period 1 October 2011-29 December 2011 and the more detailed report regarding Oakham at exhibits 3 & 4 (for the period 16 September 2011- 31 December 2011) clearly detail sales of items of clothing, albeit limited, during the relevant period for the purposes of section 46(1)(b). The sales figures are somewhat slight as they are for less than three months with only 23 pairs of boxers, 44 T-shirts, 13 shirts, 27 jumpers, 3 writing cases and 1 messenger bag being confirmed as sold under the registered mark with additional device elements as mentioned earlier. I note that the evidence of UJM has not been formally challenged by JRM.

20) In deciding what weight to give to the evidence filed I take into account the comments of Mr Arnold Q.C (as he was) when acting as the Appointed Person in *Extreme* BL/161/07 where he commented on the issue of unchallenged evidence and cross examination:

> *"Unchallenged evidence*
>
> 33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:
>
> > In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.
> >
> > This rules [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficult in submitting that the evidence should be rejected.
> >
> > However the rule is not an inflexible one…
>
> .
>
> 34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal*

Commissioner of Taxation (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [205] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] *BusLR* 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically)."

21) Whilst the evidence provided by UJM is not without flaws, and is not as comprehensive as one might wish, it nevertheless stands up to scrutiny when taken in the round. It is clear that the business operated a number of shops in the UK trading under the name JACK RUSSELL which were selling items of clothing and bags with labels, showing the registered mark (with and without additional devices) attached to them. The use corroborated is small but there can be no question that it was genuine use and reflected only a very limited period of time. I have no hesitation in stating that UJM has shown genuine use of its registered marks during the period 16 September 2011 – 15 September 2016 on the goods shown at paragraph 19 above, and also on retail services for the same.

22) I must now consider the what would be regarded as a fair specification based upon the use shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

23) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)*,* Mr Justice Carr summed up the law relating to partial revocation as follows.

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Pl*c [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

24) Taking all of the above into account, I believe that in relation to the class 18 goods it is reasonable to limit the specification to "bags and cases" as this is what has been shown and these descriptions are also recognisable sub-sets within the class, a fact emphasised by the fact that these were identified by the proprietor when applying for the registration. In respect of the class 25 specification there has been no use on footwear or headgear that has been corroborated. However, the list of clothing items is such that they do not fall into recognisable subsets and so I propose to simply limit the registration to "clothing". As such the class 35 retail specification will be restricted to "The bringing together for the benefit of others, a variety of bags, cases and articles of clothing enabling customers to conveniently view and purchase those goods from a retail outlet, by mail order or, via the internet."

CONCLUSION

25) In its counterstatement UJM accepted that it had not used its mark at all on a wide range of goods and services. It only sought to defend certain parts of its specifications. I have found that UJM has used its marks upon the following goods and services.

Mark number	Goods and services
3074644	Class 18: Bags & cases. Class 25: Articles of clothing;
2319138	Class 18: Bags & cases Class 25: Articles of clothing;
3076162	Class 35: The bringing together, for the benefit of others, of a variety of, bags, cases and articles of clothing enabling customers to conveniently view and purchase those goods from a retail outlet, by mail order or, via the internet.

26) The registrations should be amended to reflect the above. The revocations will take effect from the date of registration of each mark i.e 3074644: 4 March 2011; 2319138: 19 March 2010 & 3076162: 8 July 2011.

COSTS

27) As the registered proprietor has, mostly, successfully defended the goods and services which it identified in its counterstatement it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence	£600
Attendance at a hearing	£1000
TOTAL	£1900

28) I order Jack Russell Malletier SAS to pay Union Jack Marketing Limited the sum of £1,900. This sum 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 24th day of September 2018

George W Salthouse
For the Registrar,
the Comptroller-General