

**BL O-662-18**

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 2203866  
IN THE NAME OF BIG BEAR CONFECTIONERY LIMITED  
FOR THE FOLLOWING TRADE MARK IN CLASS 30:

**JUST**

AND AN APPLICATION TO REVOKE ON GROUNDS OF  
NON-USE (NO 501342) BY  
KINNERTON (CONFECTIONERY) COMPANY LIMITED

## BACKGROUND AND PLEADINGS

1. Registration 2203866 is for the mark JUST and stands in the name of Big Bear Confectionery Limited (the proprietor). It has a filing date of 23 July 1999, was published on 10 January 2001 and was entered in the UK register on 27 April 2001. The goods for which the mark is registered are as follows:

### **Class 30**

Confectionery, chocolate; products made from or consisting primarily of chocolate.

2. On 19 September 2016, Kinnerton (Confectionery) Company Limited (the applicant) filed an application seeking to cancel the registration in its entirety on the basis of non-use. It does so under the provisions of section 46(1)(a) of the Trade Marks Act 1994 (“the Act”) in respect of the five year period following the date of the completion of the registration procedure, namely 28 April 2001 to 27 April 2006. It seeks revocation of the trade mark registration effective from 28 April 2006.

3. The proprietor filed a counterstatement in which it rejected the claim that the mark had not been used. It stated:

*“3...it should be noted that the registration of a trade mark shall not be revoked in accordance with Section 46 (1) (a) of the Act if use is commenced or resumed after the expiry of the five year period and before the application for revocation is made (that is, prior to September 2016) as set out in Section 36 (3) of the Act.*

*4. Big Bear denies the grounds alleged in the cancellation action and submits that the mark has been continuously used, by itself or its predecessors in title, since at least as early as 1925.”*

4. Both sides filed evidence and skeleton arguments. The proprietor filed submissions. A hearing took place before me, by video conference, at which the applicant was represented by Mr Jonathan Moss of Counsel, instructed by Wildbore & Gibbons LLP.

The proprietor was represented by Mrs Charlotte Blythe of Counsel, instructed by Eversheds Sutherland (International) LLP.

### **The proprietor's request to file additional evidence**

5. On 8 May 2018 the proprietor submitted a witness statement by its commercial director, Matthew Baker. At the hearing, Mrs Blythe, for the opponent, sought admission of the additional statement. She provided the most recent guidance concerning the relevant factors which can be found in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors.*<sup>1</sup> She submitted that the additional evidence was material to the proprietor's case, was filed in response to a point made in the applicant's skeleton argument and concluded that not admitting it would result in 'significant prejudice' to the proprietor whereas admitting it would not cause prejudice to the applicant.

6. Mr Moss strongly objected to the admission of the additional evidence, primarily on the basis that the applicant would be subject to significant prejudice as it would be unable to investigate the statement made by the proprietor.

7. In reaching a finding I rely on the guidance provided in the *Titanic* case. These factors can also be found in the Manual of Trade Marks Practice in section 4.8.5, which reads:

"A party may ask to file additional evidence. The Tribunal will consider the reasons for the request, the nature of the evidence and the views of the other party. In considering a request to file additional evidence, the Tribunal will primarily consider the following:

- The materiality of the evidence in question to the issues that the Registrar has to determine;

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<sup>1</sup> [2016] EWHC 3103

- The justice and fairness of subjecting the opposite party to the burden of the evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;
- Whether the admission of the further evidence would prejudice the opposite party in ways that cannot be compensated for in costs (e.g. excessive delays); and
- The fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence.”

8. The request was made by the opponent in response to the applicant’s skeleton argument which raised questions regarding the appearance of particular marks on the proprietor’s website. It is material to the matter to be decided and any prejudice to the applicant can be addressed by providing an opportunity for the applicant to respond by filing its own evidence. In my view allowing the evidence and providing the applicant with the opportunity to scrutinise it and file its own evidence in response allows me to consider all relevant material in reaching a decision and removes any prejudice to the applicant. I allowed the additional evidence to be admitted.

9. Following the hearing, I wrote to the applicant allowing a period for it to file a response to the proprietor’s additional witness statement. The applicant subsequently filed an additional witness statement by Christopher Andrew Baume and two exhibits.

## **THE EVIDENCE**

### **Proprietor’s evidence of use**

10. The proprietor’s evidence is provided in a witness statement by Matthew Baker, the proprietor’s Commercial Director. His witness statement is dated 6 July 2017. He begins by providing details of the proprietor’s predecessors, the salient points from which are as follows:<sup>2</sup>

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<sup>2</sup> See exhibit MB1.

- The original Fox's Confectionery was established in 1880 by Walter Richard Fox in a Victorian warehouse in Leicester.
- In 1969, Fox's Confectionery was acquired by Mackintosh (the year before it became Rowntree Mackintosh) and moved to new premises in Braunstone, Leicester where the brands are still manufactured to this day.
- In 1988, Rowntree Mackintosh was acquired by Nestlé.
- In 2001, Nestlé sold Fox's Confectionery to Northern Foods (along with some other brands).
- In 2003, Big Bear Group Limited acquired the company from Northern Foods Group Limited ("Northern Foods").
- In 2010, Glisten Confectionery was acquired by Raisio plc ("Raisio").
- In 2011, Rasio acquired Big Bear, which it combined with Glisten Confectionery to become Big Bear Confectionery Limited.

11. With regard to the JUST trade mark, Mr Baker submits that the first JUST branded product, JUST chocolate-covered brazil nuts, was launched by George Payne & Co. (which later became a part of the Big Bear Group Limited) in 1925 and that since that date, other JUST branded products have been introduced. He further submits that the proprietor and its predecessors in title have sold confectionery food products under the JUST trade mark throughout the UK. He provides an example of the JUST brand as it currently appears on the proprietor's website:<sup>3</sup>



<sup>3</sup> See exhibit MB4.

12. Mr Baker submits that there has been a large number of JUST products and provides the following table listing the products and their launch dates:<sup>4</sup>

<b>Product</b>	<b>Year of first use</b>
<b>JUST brazils</b>	1925
<b>JUST mints</b>	1977
<b>JUST almonds</b>	At least as early as 1999
<b>JUST hazelnuts</b>	At least as early as 1999
<b>JUST strawberries</b>	2006
<b>JUST gingers</b>	2006
<b>JUST caramels</b>	2006
<b>JUST dates</b>	2011
<b>JUST fudge</b>	2011
<b>JUST fruits</b>	2014

13. Mr Baker states that the proprietor’s JUST chocolate-covered brazil nuts are the number one selling chocolate-covered brazil nuts in the UK. They are sold online and instore at numerous outlets including food retailers, supermarkets, convenience stores and fuel stations. He provides the following turnover figures for the brazil nut product:

<b>Year</b>	<b>Sales in the UK (£million) (excluding VAT)</b>
2016	£1.5
2015	£1.8
2014	£2.3
2013	£1.5
2012	£2.0
2011	£2.1
2010	£2.8

14. A representative sample of invoices is provided<sup>5</sup> which Mr Baker submits show sales of the proprietor’s JUST products. The invoices support the sales figures given

<sup>4</sup> Emphasis added by the proprietor.

<sup>5</sup> See exhibit MB8.

in Mr Baker’s statement with regard to the proprietor’s JUST BRAZILS products and I do not intend to itemise them. I present, in the table below, the details of JUST goods other than the proprietor’s brazil nut product:

Date:	Customer:	Goods:	Net value:
5.12.16	Poundworld Retail	JUST FRUITS 480 cases	£3398.40
8.12.15	Poundland Ltd	JUST FRUITS 2078 cases	£13465.44
8.06.11	J Sainsbury Plc	JUST FUDGE 360 cases	£4309.20
08.06.11	W M Morrisons Supermarket Plc	JUST FUDGE 240 cases	£4036.80
18.05.11	W M Morrisons Supermarket Plc	JUST FUDGE 120 cases	£2018.40
09.02.11	Co-operative Group Ltd	JUST FUDGE 40 cases	£488.00
09.02.11	Co-operative Group Ltd	JUST FUDGE 220 cases	£2213.20
8.06.11	W M Morrisons Supermarket Plc	JUST FUDGE 240 cases	£4036.80
15.06.11	W M Morrisons Supermarket Plc	JUST FUDGE 120 cases	£2018.40
20.06.11	J Sainsbury Plc	JUST FUDGE 240 cases	£715.20

15. He further submits that the family of JUST brands confectionery products have, for more than 10 years, been sold under packaging which incorporates, *“the distinctive cursive stylised JUST (‘the JUST logo’) ...”*



16. Mr Baker submits that since 2003 (approximately) the proprietor’s JUST chocolate-covered brazil nuts have been sold ‘under and by reference to’ the following:



17. He describes the JUST trade mark as appearing in a large font, in white, in a distinctive cursive script which is accompanied by the ® symbol. I note that the symbol cannot be seen in this particular example.

18. I note that pages archived from Waybackmachine dated June and December 2004 and April 2005 show a list of the proprietor's brands under the heading: 'Fox's Confectionery :: Clearly Better Sweets'. The pages are taken from [www.foxs.co.uk](http://www.foxs.co.uk) and show the following mark:<sup>6</sup>



19. With regard to advertising expenditure Mr Baker submits that the proprietor spent approximately £200,000 per year from 2010 to 2016 for the proprietor's JUST chocolate-covered brazil nut product. The expenditure relates to, inter alia, attendance at trade fairs, brochures, window advertisements, consumer competitions and giveaways, promotions and off-shelf displays.

20. Examples are provided,<sup>7</sup> the majority relating to a number of competitions run in December 2009 to win boxes of JUST BRAZILS. The boxes shown in the accompanying photographs feature the mark in the following form:

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<sup>6</sup> See exhibit MB7.

<sup>7</sup> See exhibit MB6.





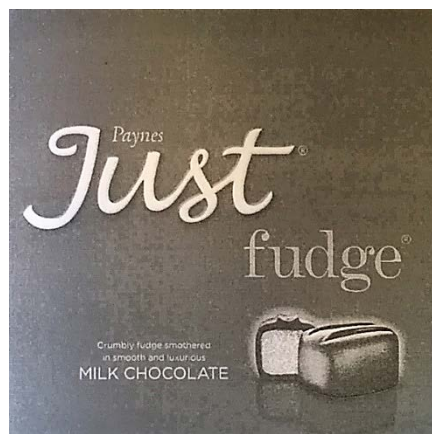
21. The competitions appeared in, inter alia, NOW magazine online, Real People magazine and the Star newspaper.

22. In his witness statement Mr Baker submits that the brazil nut products have been advertised on its websites, www.foxs.co.uk from approximately 2004 to 2010 and on its www.bigbearuk.com website from approximately 2011.

23. Mr Baker submits that the JUST chocolate covered fudge product was sold from 2011 to 2012 under the following 'logo':



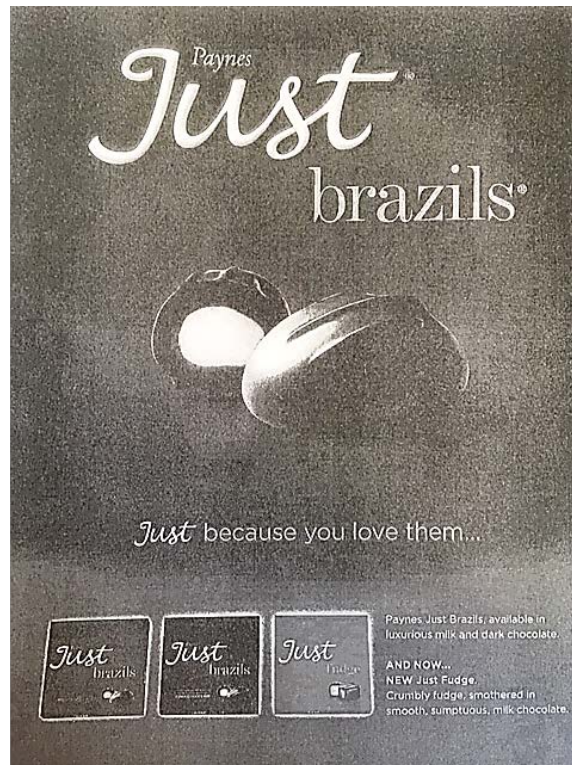
24. The following example of the packaging for the proprietor's chocolate covered fudge product is provided, though the example is undated:<sup>8</sup>



<sup>8</sup> See exhibit MB5.

25. Examples of packaging for the proprietor's Just Strawberries and Just Ginger are provided and are undated.<sup>9</sup> Packaging for the proprietor's Just Mints product is shown in the same exhibit and is dated 1979, before the relevant date.

26. A further undated advert includes packaging for Just brazils dark and milk chocolate and Just fudge:<sup>10</sup>



27. Mr Baker submits that there has been substantial press coverage of the proprietor's JUST products throughout the relevant period up to the filing of this cancellation, including JUST chocolate-covered brazil nuts. The examples provided are dated between 7 September 2003 and 6 June 2015.<sup>11</sup> The articles are taken from a range of publications including The Grocer, newspapers such as The Guardian, The Express, the Mail on Sunday and regional papers such as The Leicester Mercury and the Yorkshire Post. There are also examples from Hedgeweek and The London Stock Exchange News. The majority of the articles concern changes of ownership and investments and include lists of the proprietor's brands. With the exception of one article, the 'Just' product mentioned, in each case, is Just Brazils.

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<sup>9</sup> As above.

<sup>10</sup> As above.

<sup>11</sup> See exhibit MB9.

28. The exception is an article from London Stock Exchange Aggregated Regulatory News Service, dated 18 January 2010 and titled, 'Big Bear Limited Intention to Float'. Under 'highlights' the article describes the proprietor's business as follows:

*"In 2003, [the proprietor] acquired Fox's Confectionery from Northern Foods Plc, including Fox's Glacier (mints and fruits), XXX (extra strong mints), Poppets (bite sized chocolates) and the Just brand (most famous for Just Brazils)."*

**Applicant's evidence**

29. The applicant's evidence is provided in a witness statement by Christopher Andrew Baume, dated 6 September 2017. Mr Baume is employed by the applicant's representative. The first paragraph of his statement reads:

*1...I have read the Witness Statement of Matthew Baker dated 6 July 2017 and was surprised to see the reference to and the illustration of a JUST logo in paragraph 12 of Mr. Baker's statement, said to appear on the website www.bigbearuk.com as I had not seen this previously when the revocation action was filed on 4 October 2016.*

30. He provides two exhibits, the first of which is an extract from the proprietor's website from 10 June 2016, using Waybackmachine.<sup>12</sup> The page is titled, 'About Big Bear Confectionery' and shows the following:



<sup>12</sup> See exhibit CAB1.

31. The second exhibit provided by Mr Baume is an extract from the proprietor's website from 14 October 2016, using Waybackmachine.<sup>13</sup> The page has the Big Bear mark at the top of the page:



32. The following is shown under the heading, 'Our Family of Brands' and is reproduced as filed:



33. Mr Baume concludes:

*"3...This shows that at some point after 10 June 2016, the website illustration had been changed and that, under the heading "Our Family of Brands" the illustration of the JUST BRAZILS product logo had been replaced by what was now merely the stylised word JUST on its own within a simple brown rectangle, as shown in Mr. Baker's Witness Statement."*

### **Proprietor's evidence admitted at the hearing**

34. Mr Baker's second statement is given in response to the applicant's comments regarding the presence of the following 'JUST logo' on the proprietor's website:

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<sup>13</sup> See exhibit CAB2.



35. He provides a copy of an email between the proprietor's marketing manager and a project manager at the company that manages the proprietor's website (Cite).

*"The only thing that Cite can demonstrate for certain is that the 'JUST' logo (as appears now) was uploaded into the website CMS 'Media' folder on 20 October 2015, and that it was subsequently implemented so as to appear on the 'About us' page. We cannot though conclusively demonstrate on what date said implementation took place. However, based on Cite's working practices, it is not unreasonable to assume that the implementation of the logo took place on the same date as the logo was uploaded - 20 October 2015."*

#### **Applicant's evidence filed after the hearing**

36. Mr Baume's second statement provides pages taken from waybackmachine. The first is dated 19 November 2015 which Mr Baume describes as, *"the earliest available capture after the date of 20 October 2015 mentioned in Matthew Baker's second witness statement."* He submits that on that date, "the following illustrations and references of the relevant product appear on the Home, About Us and Brands sections of the website [www.bigbearuk.com](http://www.bigbearuk.com)."<sup>14</sup> Mr Baume also provides prints dated, 20 November 2015, 28 January 2016, 15 March 2016, 26 May 2016 and 10 June 2016<sup>15</sup> which show the same images, as reproduced below:



<sup>14</sup> See exhibit CAB3.

<sup>15</sup> See exhibit CAB4.

OUR FAMILY OF BRANDS



37. Mr Baume concludes:

*“5. From the searches described above, which were easy for me to conduct, I conclude that the ‘Just’ logo described by Matthew Baker never appeared on the registered proprietor’s website www.bigbearuk.com until some point after 10 June 2016.”*

**DECISION**

38. 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) ...

(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.”

39. Section 100 of the Act makes clear that the onus is on the proprietor to show use. It 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.”

40. The relevant periods in this case are firstly, the period specified by s.46(1)(a), which is 28 April 2001 to 27 April 2006 and secondly, the period after the expiry of that five-year period until three months before the application for revocation, namely, 28 April 2006 to 19 June 2016. There is no dispute between the parties that these are the relevant dates for which the proprietor must show genuine use of its JUST trade mark.

41. In *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:

“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 Bunderversammlung 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].”

42. In *Awareness Limited v Plymouth City Council*,<sup>16</sup> 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.

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<sup>16</sup> BL O/236/13.

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.”

43. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*,<sup>17</sup>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

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<sup>17</sup> Case BL 0/404/13.

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."

44. Counsel for the applicant submitted that little of the proprietor's evidence is relevant, drawing my attention to the fact that parts of it post-date the cancellation application. He submitted that where evidence cannot be dated clearly from the documents or the witness statements provided, it cannot be assumed to be within the relevant period.

45. Counsel for the proprietor accepted that parts of the evidence are undated but submitted that in its totality the evidence is sufficient to show genuine use of the proprietor's JUST mark in a form differing in elements which do not alter the distinctive character of the mark as registered.

46. The burden of proof falls on the proprietor. Therefore, the question is whether what the proprietor says and exhibits is sufficient to show that the contested mark was put to genuine use in the relevant period. This is the matter to which I now turn.

47. There is next to no evidence of use of the registered mark by itself. The closest the proprietor's evidence comes to this is the use of the word 'JUST' in a stylised form on its website, a matter which is challenged by the applicant in respect of the date at which it first appeared on that website. Nothing turns on this point. The vast majority of use shown in the proprietor's evidence relates to the sale of its Just Brazils products.

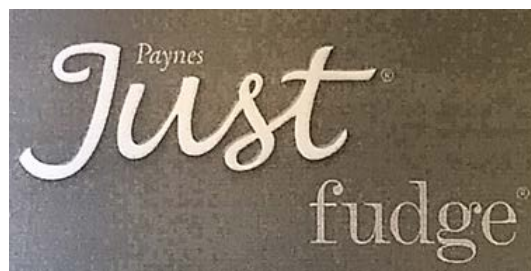
Turnover figures are in excess of £1.5 million for the years 2010-2016 and this is supported by sample invoices provided in evidence which show the goods sold described as JUST BRAZILS. The proprietor claims to have sold the goods under the following sign since 'approximately 2003':



48. The evidence supports use of the sign since, at least, 2009, when images of the product appeared on the competition pages of several newspapers and magazines.

49. In addition, the press articles provided by the proprietor refer to JUST BRAZILS as being one of its brands.

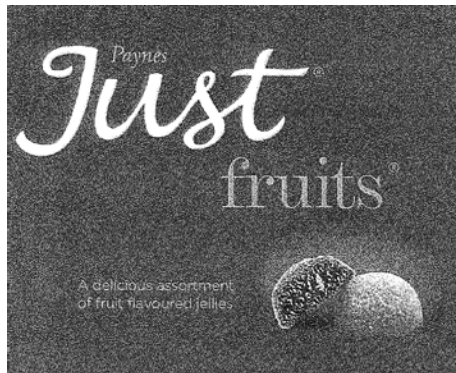
50. With regard to other confectionery goods sold by the proprietor, Mr Baker states that the Just Fudge product was sold between 2011 and 2012 under the following 'logo':



51. Invoices dated between 9 February 2011 and 20 June 2011 show sales of JUST FUDGE to Sainsbury's, Morrisons and Co-operative supermarkets which amount to approximately £19,500.

52. Mr Baker states that the proprietor's JUST FRUITS product was first sold in 2014. One invoice is provided within the relevant periods, dated 8 December 2014, which shows sales of JUST FRUITS to Poundland Ltd. The sale is for 2078 cases amounting

to £13,465.44. An example of packaging for the JUST FRUITS product is provided in evidence, though it is not dated.



53. It has the same style as the previous two examples and cannot date before 2014, when the product was first launched, though I note that this example may date from later than the relevant period.

#### The presentation of JUST within the mark

54. The presentation itself is a cursive version of the word 'JUST' in white on a darker background which, in my view, is within the parameters of fair and notional use of the registered mark.<sup>18</sup> If, however, I am found to be wrong in this, the law in relation to use of a mark in a differing form was considered in *Nirvana Trade Mark*, in which 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

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<sup>18</sup> See *Sadas v OHIM*, T-346/04 and *Peak & Cloppenburg v OHIM*, T-346/04 concerning marks presented in cursive form.

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."

55. The distinctive character of the registered mark rests in the word JUST. The presentation of the word JUST shown in evidence, in a white, cursive font, will still be seen by the average consumer as simply the word JUST with no material added or subtracted which alters its concept or pronunciation. The fact that the average consumer would notice the change of font does not automatically lead to a finding that the distinctive character of the registered mark has been altered. In both presentations the distinctive character resets in the word JUST. I find the use of the word JUST in cursive script to be an acceptable variant which does not alter the distinctive character of the mark as registered.

Does the use of JUST as part of a composite mark count?

56. The relevant law on this point is found in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark. The Court of Justice of the European Union 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). (emphases added)

57. The parties disagree about whether the use of JUST by the proprietor indicates the trade origin of the goods when it is used as part of the composite mark. Both rely on *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd, Specsavers Optical Superstores Ltd v Asda Stores Ltd*,<sup>19</sup> in which the CJEU stated:

“22. For a trade mark to possess distinctive character for the purposes of Regulation No 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking,

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<sup>19</sup> C-252/12.



and thus to distinguish that product from those of other undertakings (see, to that effect, Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-5141, paragraph 32; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-311/11 P *Smart Technologies v OHIM* [2012] ECR I-0000, paragraph 23).

23. That distinctive character of a registered trade mark may be the result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking (see, by analogy, Case C-353/03 *Nestlé* [2005] ECR I-6135, paragraph 30).”

58. The applicant submits that JUST is highly descriptive in the manner it has been used and is not capable of indicating origin. JUST has always been used in combination with another word. It gives the examples of Just Brazils, Just Fudge and Just Fruits. It distinguishes this case from *Specsavers* where both marks were capable of having independent distinctive character and submits that ‘just’ cannot have independent character because it is a descriptive word which qualifies the second word.

59. The applicant further submits that the part of the proprietor’s mark which guarantees origin is the word ‘Paynes’ which, ‘appears on nearly every product sold’. Consequently, its second reason that there has been no genuine use of the ‘Just’ mark is that it is always used with the word Paynes. Paynes is of much greater distinctive character and significantly alters the distinctive character of the mark as registered.

60. The proprietor submits that in product names such as JUST BRAZILS, JUST FUDGE and JUST FRUITS, ‘JUST’ is clearly the distinctive and dominant component, coming before descriptive elements. It further submits that the cursive logo JUST emphasises the word and is presented across the centre of its marks and is the largest element. ‘Paynes’ and ‘Brazils’ are presented in a smaller font, in a colour more akin to the background, “such that from a distance, those words do not stand out”. It

concludes that its JUST mark has served and does serve to identify the goods of the proprietor and submits that the average consumer would see it as such, therefore satisfying the test laid down in *Specsavers*.

61. In respect of the PAYNES element in particular, the proprietor submits:

*“33...that word is a reference to the original manufacturer of the chocolate-covered brazil nuts... It is featured within the Logo in a different size, colour and typeface to the word ‘JUST’ and as a result is clearly separate therefrom. It is submitted, therefore, that this word would not be perceived as part of the same trade mark as the word ‘JUST’, but would be perceived as a company name or creator name...”*

62. The applicant’s first point concerns the descriptive nature of the proprietor’s mark. The prima facie distinctiveness of the proprietor’s JUST mark is not a ground before me in this case. JUST is a registered trade mark and I must afford it at least a minimum degree of distinctive character.<sup>20</sup> I will return below to the independent distinctive character of the proprietor’s mark demonstrated by its evidence of use.

63. The applicant’s second point is that the words ‘JUST’ and the descriptor, such as ‘Brazils’ are positioned beneath the word PAYNES and have the appearance of a subsidiary brand, PAYNES being the primary branding.

64. In *Castellblanch SA v OHIM*,<sup>21</sup> the GC said:

*“33. In the contested decision the Board of Appeal found that there is no precept in the Community trade mark system that obliges the opponent to prove the use of his earlier mark on its own, independently of any other mark. According to the Board of Appeal, the case could arise where two or more trade marks are used jointly and autonomously, with or without the name of the manufacturer’s company, as is the case particularly in the context of the automobile and wine industries.*

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<sup>20</sup> Formula One Licensing BV v OHIM, Case C-196/11P.

<sup>21</sup> Case T-29/04 [2005] ECR II-5309.

34. That approach must be followed. The situation is not that the intervener's mark is used under a form different to the one under which it was registered, but that several signs are used simultaneously without altering the distinctive character of the registered sign. As OHIM rightly pointed out, in the context of the labelling of wine products joint affixing of separate marks or indications on the same product, in particular the name of the winery and the name of the product, is a common commercial practice."

65. I find that where there is use of JUST with BRAZILS, FUDGE or FRUIT, with the word PAYNES above it, or before it, it falls into the *Castellblanch* category of use. It is therefore within the parameters of section 6(A)(4)(a) of the Act ("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").

66. Where the use of JUST is alongside the words describing the nature of the product, such as, JUST BRAZILS or JUST FUDGE, with no emphasis given to either element, the two words, in each case, are read together and neither operates as an independent element within that mark, nor would either word be perceived as indicative of the origin of the product at issue, in its own right.

67. However, there is considerable use shown by the proprietor of the word 'Just' presented in a white cursive font, larger than the remaining words and in sharp contrast to the much darker background. The words PAYNES and BRAZILS (or FUDGE) are considerably darker in presentation, more akin to the background and are much smaller within the composite mark as a whole. The word 'Just' has been picked out and given special prominence within the mark and something has been done to consciously diminish the other elements. As a consequence, the word 'Just' will still be read with the word BRAZILS, or other descriptor, in the same way as described above, but it also operates, simultaneously, as an independent trade mark, playing an independent role in the mark as a whole. It is therefore capable of being perceived as indicative of the origin of the product at issue and constitutes genuine use.

The goods for which genuine use of the mark has been shown

68. The proprietor's specification currently stands as follows:

Confectionery, chocolate; products made from or consisting primarily of chocolate.

69. The way in which this specification is presented means that at present the proprietor's JUST mark stands registered for confectionery at large, chocolate at large and the specific goods named after those two terms.

70. In its skeleton argument the applicant submitted:

*"Finally, even if the IPO is satisfied that there has been some use, it is certainly not use which is broad enough to justify 'confectionery' and should be limited to chocolate confectionery or another sub-category..."*

71. The proprietor submits that its use amounts to real commercial exploitation aimed at creating a market share in confectionery and chocolate products in a way which is intended to designate origin.

72. The correct approach can be found in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,<sup>22</sup> in which Mr Geoffrey Hobbs Q.C. sitting 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."

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<sup>22</sup> BL O/345/10.

73. And in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,<sup>23</sup> 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 Plc* [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,

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<sup>23</sup> [2016] EWHC 3103 (Ch).

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.”

74. The proprietor has shown extensive use of its mark in respect of chocolate-covered brazil nuts. I am also satisfied that there has been use of the contested mark in respect of chocolate-covered fudge. The proprietor has provided invoices showing sales of those goods within the relevant periods and has also provided an example, in Mr Baker’s witness statement, of the mark under which those goods were sold. This has not been challenged.

74. With regard to the proprietor’s jelly fruit product, there is evidence that a sale of JUST FRUITS was made within the relevant period but there is no evidence which shows under which version of the proprietor’s mark the sale was made. A single page shows an example of packaging for the JUST FRUITS product but it is undated and contains no other information. It is simply the cover of a box on a plain white page. I cannot be sure that this particular packaging was put on the market. Without anything else to support the exhibit such as, inter alia, a statement as to the mark under which the goods were sold, I cannot infer that the sale was made under the composite mark which includes JUST presented in a cursive font. Consequently, I do not find that there has been genuine use of the contested mark for the proprietor’s jelly fruit product.

75. Use of the remaining JUST products referred to by Mr Baker in his statement are not supported by the evidence. No invoices are provided to show sales of those goods and there are no examples of advertising. The few examples of packaging that are included are undated and are subject to the same reasoning I have provided in the paragraph above concerning the JUST FRUITS packaging.

76. I find that use of the proprietor’s JUST mark has been made, within the relevant period, for its chocolate-covered brazil nuts and chocolate-covered fudge and conclude

that chocolate confectionery is a fair reflection of the use shown in evidence. Furthermore, it is the way in which the average consumer would fairly describe the goods.<sup>24</sup>

77. The proprietor's specification also includes, 'products made from or consisting primarily of chocolate'. I cannot be sure from the evidence provided the extent to which chocolate is used as a percentage of the total product in each case. These are certainly goods which include chocolate, being a confectionery item such as a nut or fudge which is then covered in chocolate, but I do not find that such goods, for which genuine use has been shown, could be fairly described as 'made from or consisting primarily of chocolate'.

## **Conclusion**

78. Under section 46(1)(a) the proprietor's trade mark registration for JUST in class 30 is to be partially revoked from 28 April 2006 and will remain registered for:

### **Class 30**

Chocolate confectionery.

## **COSTS**

79. Big Bear Confectionery Limited has been successful for the most part and is entitled to a contribution towards its costs on the basis of the published scale (Tribunal Practice Notice 2/2016):

Statement of case and considering the counterstatement	£300
Considering the applicant's evidence and filing evidence	£500
Attending the hearing	£500
<b>Total</b>	<b>£1300</b>

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<sup>24</sup> See *Roger Maier and Another v ASOS* [2015] EWCA Civ 220.

80. I order Kinnerton (Confectionery) Company Limited to pay Big Bear Confectionery Limited the sum of £1300 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

**Dated this 18<sup>th</sup> day of October 2018**

A handwritten signature in black ink, appearing to read 'ASL', followed by a long horizontal flourish.

**Al Skilton**

**For the Registrar,**

**The Comptroller-General**