

O/439/20

TRADE MARKS ACT 1994

**IN THE MATTER OF UK REGISTRATION NO. 2333814
IN THE NAME OF DEWAN FAZLUL HOQUE CHOWDHURY
IN RESPECT OF THE FOLLOWING TRADE MARK:**



IN CLASSES 3, 5 & 44

AND

**AN APPLICATION FOR REVOCATION THEREOF
UNDER NO 502729
BY
DNANUDGE LIMITED**

BACKGROUND AND PLEADINGS

1. Trade mark No. 2333814 shown on the cover page of this decision stands registered in the name of Dewan Fazlul Hoque Chowdhury (“the registered proprietor”). It was applied for on 3 June 2003 and completed its registration procedure on 21 November 2003. The relevant goods and services for which it is registered are as follows:

Class 3

Cosmetic preparations.

Class 5

Pharmaceutical preparations.

Class 44

Medical services; veterinary services; consultation services relating to hygiene and beauty care for human beings and animals.

2. On 23 July 2019, DnaNudge Limited (“the applicant”) filed an application to have this trade mark revoked under the provisions of sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). The applicant claims that the trade mark was not put to genuine use in the United Kingdom by the registered proprietor or with its consent in connection with the goods and services in respect of which it is registered in the five years following the date of registration or in any of the following five-year periods:

Start date	End date	Effective revocation date
23 July 2014	22 July 2019	23 July 2019
22 November 2007	21 November 2012	22 November 2012
22 November 2011	21 November 2016	22 November 2016

3. The registered proprietor filed a defence and counterstatement denying the claims made.

4. The registered proprietor filed evidence. I shall summarise this to the extent that I consider it necessary. The applicant made written submissions in lieu of a hearing on 17 August 2020. These will not be summarised, but I shall refer to them as and where appropriate during my decision.

5. Neither party requested a hearing so I have taken this decision following a careful consideration of the papers. In these proceedings, the applicant was represented by Marks & Clerk LLP and the registered proprietor by Serjeants LLP.

EVIDENCE

6. The registered proprietor's evidence comes from Mr Dewan Fazlul Hoque Chowdhury and is dated 9 December 2019.

7. Mr Chowdhury states that he has been using the contested mark since 2000. He says that "lifestyle vitamins", skincare products and DNA screening have been sold since 2000 via his website mydna.co.uk which he has owned since 21 March 2000. Exhibit DC1 contains the "Whois" record for that domain name.

8. Exhibit DC2 contains invoices for marketing activities, logo and label design and website design, dating from 29 April 2016 to 28 December 2016. Mr Chowdhury also states that he has met with distributors around Europe and attended exhibitions, with the result that "our brandname myDNA has been very well known amongst those circles".¹ The evidence gives no indication of how the mark has been used on products or in relation to services.

DECISION

9. Section 46 of the Act is as follows:

"(1) The registration of a trade mark may be revoked on any of the following grounds –

¹ Witness statement, paragraph 9.

(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;

...

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

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

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

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

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

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

(5) Where grounds 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.

10. Section 100 of the Act is as follows:

“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.

11. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch);

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeviliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle*

GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

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

(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] and [76]-[77]; *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. The applicant submits that the evidence filed by the registered proprietor is “evidently inconclusive and does not sufficiently demonstrate the genuine use of the Subject Mark during the relevant periods”.²

13. In *Pan World Brands Limited v Tripp Limited (EXTREME Trade Mark)*, BL O-161-07, Richard Arnold QC (as he then was), sitting as the Appointed Person, considered where the burden of proof lay in revocation proceedings. He said:

“The legal burden of proving that the requirements for revocation under section 46(1)(a) or (b) are met lies on the applicant for revocation. By virtue of section 100, however, the evidential burden of showing what use has been made of the mark lies upon the proprietor. Similarly, by virtue of rule 31(3)(a), if the mark has not been used, the evidential burden of showing what the reasons for non-use are lies upon the proprietor. The evidential burden may shift during the course of the proceedings: if, for example, the applicant for revocation were to accept that the proprietor’s evidence showed use of the trade mark but to content that the use was not genuine because it was purely for the purpose of preserving the registration, then the evidential burden of showing that that was the case would lie upon the applicant (although the applicant might be able to discharge that burden by relying upon the proprietor’s own evidence). Finally, once the evidence is complete, the tribunal should not decide whether there has been genuine use, or proper reasons for non-use, purely on the basis that the party

² Written submissions, paragraph 13.

bearing the burden of proof has not discharged that burden unless it cannot reasonably make a finding in relation to that issue despite having striven to do so: see *Stevens v Cannon* [2005] EWCA 222 at [46].”³

14. Later in the decision he said:

“Basing himself upon the first three sentences of the passage I have quoted from *MOO JUICE*, counsel for the applicant submitted (1) that a mere assertion of use of a trade mark by a witness did not constitute evidence of use sufficient to defeat an application for non-use, and (2) it followed that mere testimony from a representative of the proprietor was not enough and such testimony had to be supported either by documentary records or corroborated by an external witness. I accept submission (1) but not submission (2). Kitchin J’s statement that ‘bare assertion’ would not suffice must be read in its context, which was that it had been submitted to him that it was sufficient for the proprietor to give evidence stating ‘I have made genuine use of the trade mark’. A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used would not in my view constitute bare assertion. ...”⁴

15. In *PLYMOUTH LIFE CENTRE*, BL O/236/13, Mr Daniel Alexander QC, sitting as the Appointed Person, stated that:

“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

³ Paragraph 24. The equivalent provision to Rule 31(3)(a) is Rule 38 of the Trade Marks Rules 2008.

⁴ Paragraph 31.

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.”⁵

16. At this point, it is appropriate to return to the registered proprietor’s witness statement. He states that the mark has been used on lifestyle vitamins and skincare products in the UK, and that “we” also provide DNA testing screening. He adds that products bearing the mark have been sold from the website mydna.co.uk since it was established in 2000. According to Mr Chowdhury’s witness statement, the mark is also used on the website. He also states that he has promoted the brand at exhibitions and to European distributors.

17. In my view, the evidence provided in the witness statement falls short of the kind of narrative that the Appointed Person in *EXTREME* held to be more than bare assertion. There is no evidence to show how and when the mark has been used and no financial information to demonstrate whether any sales have been made in the UK. It seems to me that it ought not to have been difficult to provide such evidence. The invoices in Exhibit DC2 do not assist either. The invoice dated 29 April 2016 concerns marketing activity for a range of vitamins and the invoice dated 29 July 2016 is for designs and artwork for water bottle labels.⁶ There is no indication that the mark appears on these products and, even if there were, there is no evidence of sales in the UK. Furthermore, water or bottles for water are not among the goods and services covered by the mark. The remaining invoices concern logo and packaging design for unspecified products and website design, build and hosting. Finally, the ownership of a domain name does not in itself mean that there is genuine use of a trade mark.

⁵ Paragraph 22.

⁶ Exhibit DC2, pages 1 and 2 respectively.

18. I find that no use of the mark has been shown, nor has the registered proprietor given any proper reasons for non-use, for any of the relevant periods.

Conclusion

19. As the proprietor has shown no use of the trade mark, it will be revoked. I am satisfied that grounds for revocation existed as of 22 November 2008 and so the mark will be revoked in its entirety from this date.

Costs

20. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2006. In the circumstances I award the opponent the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement:</i>	<i>£200</i>
<i>Preparing written submissions:</i>	<i>£300</i>
<i>Official costs:</i>	<i>£200</i>
<i>TOTAL:</i>	<i>£700</i>

21. I therefore order Dewan Fazlul Hoque Chowdhury to pay DnaNudge Limited the sum of £700. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of September 2020

**Clare Boucher,
For the Registrar
The Comptroller-General**