

O/0557/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
REGISTRATION NO. 3213086
IN THE NAME OF WOOLF DRINKS LIMITED
FOR THE TRADE MARK:**

ARTFUL DODGER

IN CLASSES 21, 25, 32, 33, 35, 41, 43

AND

**AN APPLICATION FOR REVOCATION
UNDER NO. 504962
BY VALENSYS LTD**

Background and pleadings

1. Woolf Drinks Limited (“the proprietor”) is the registered proprietor of the trade mark **ARTFUL DODGER**, under registration number 3213086 (“the proprietor’s mark”). The proprietor’s mark was filed on 16 February 2017 and became registered on 9 June 2017 in respect of the following goods and services.

- Class 21: Household and kitchen utensils and containers; combs; sponges; brushes; articles for cleaning purposes; articles of glassware, porcelain and earthenware (not included in other classes); dinnerware; glass dishes; crystal beverage ware, wine glasses, cups and mugs, pitchers, paper plates; parts and fittings for all the aforesaid goods.
- Class 25: Clothing, footwear and headwear.
- Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; soft drinks; non-alcoholic (de-alcoholised) beers and wines.
- Class 33: Alcoholic beverages (except beers); low alcoholic and reduced alcoholic beverages.
- Class 35: Advertising, marketing, publicity, business management and business information services; advertising and promotional services; the promotion of products and services for others; business administration services; distribution of samples; retail store services, online retail store services, mail order retail catalogues services connected with the sale of beverages (alcoholic and non-alcoholic) household utensils, glassware, earthenware, clothing, footwear and headgear; retail store services, online retail store services, mail order catalogues services relating to life styles, namely beverages (alcoholic and non-alcoholic), clothing, footwear, headgear; provision of

consumer product information, relating to beverages and life styles available via searchable indexes and databases and via online electronic documents and databases; administration, organisation and management of shows and exhibitions for commercial or promotional purposes; administration and management of lectures, seminars and symposiums for commercial or promotional purposes; connecting sellers with buyers via a website; providing an online marketplace for the buying and selling of beverages and foodstuffs; administration, organisation and management of business incentive and loyalty schemes; administration, management and organisation of customer loyalty programs including such programs involving discounts or incentives; advice, consultation and information services relating to the aforesaid services.

Class 41: Entertainment and cultural activities; organisation and arrangement of competitions, music, cultural, educational and entertainment events; prize draws; providing online entertainment and media content; entertainment services, in the form of live audio and visual performances by actors; film and television (including cable television) production and direction; radio programme services; ticketing and event booking services; wine tasting events; food and drink tasting events for educational and entertainment purposes; education and training services relating to wines and other alcoholic beverages; publication of electronic books, magazines, journals and web blogs; electronic publishing of books and magazines for others; organisation of lectures, seminars and symposiums for commercial or promotional purposes; advise, consultation and information services relating to the aforesaid services.

Class 43: Services for providing food and drink; restaurant services; bar services; business catering services; cafe services; canteen services; food and drink catering; hospitality services; mobile

catering services; serving of alcoholic and non-alcoholic beverages; public house services; pubs; restaurant services incorporating licensed bar facilities; wine bar services; wine bars; wine tasting services (provision of beverages); beverage and food tasting services; accommodation services.

2. Valensys Ltd (“the applicant”) seeks revocation of the proprietor’s mark under section 46(1)(a) of the Trade Mark Act 1994 (“the Act”). The applicant’s claim is directed against all the goods and services of the proprietor’s mark.

3. Revocation is sought under section 46(1)(a) as a result of alleged non-use of registration during the five-year period immediately following the date on which the mark is registered, i.e. 10 June 2017 to 9 June 2022. The applicant requests an effective date of revocation of 10 June 2022.

4. The proprietor filed a counterstatement in which it defended its registration of all the goods and services, claiming use in relation to clothing in class 21, glassware in class 25, preparations for making beverages in class 32, alcoholic beverages in class 33, sales of beverages retail, online and via trade shows in class 35, entertainment and education tasting events in class 41, and serving alcoholic beverages in class 43. No claim is made to there being any proper reasons for non-use.

5. Only the proprietor filed evidence in these proceedings. The applicant is professionally represented by Sipara Limited, whilst the proprietor represents itself. No hearing was requested and only the applicant filed written submissions in lieu of a hearing. Therefore, this decision is taken following a careful perusal of the papers before me.

6. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

Evidence

7. The proprietor filed evidence alongside its counterstatement consisting of a statement of use and four exhibits. Whilst I do not propose to summarise the evidence here, I have taken it all into consideration in reaching my decision and will refer to it below, as and where necessary.

DECISION

8. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) [...]

(c) [...]

(d) [...]

(2) For the purpose 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) [...]

(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 existing 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 relevant period of assessing whether there has been genuine use of the proprietor’s mark under section 46(1)(a) is 10 June 2017 to 9 June 2022.

11. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] 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 Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C 416/04 P *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 Bunderversammlung 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 P *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. Further, proven use of a mark which fails to establish that the “commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.

13. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, 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. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/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. I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹ However, following a careful consideration of the evidence, I am not satisfied that the proprietor has demonstrated genuine use of its mark for any of the goods or services for which it is registered.

16. No information or evidence has been provided which would enable me to ascertain when use of the mark allegedly commenced. I note from the statement of use at Q6 the proprietor states "Over the years I would estimate over £100,000 of sales for the Artful Dodger brand". However, the proprietor has not specified the dates to which this sales figure relates. Furthermore, there is no annual breakdown of

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

precise figures for dates within the relevant period. Neither does the proprietor provide a breakdown of figures for each of the goods and services for which the mark is registered.

17. Provided in evidence is a price list dated 2022.² At the top of the price list are the words “THE ARTFUL DODGER WHISKY COLLECTIVE” with a figurative element above. I note that the products for sale, do not contain the “ARTFUL DODGER” mark, moreover, these products also contain other marks such as Jura. The mere presence of the price list does not evidence the actual sales that have been made, including the number of sales, the value of each sale, or their geographical extent. The remaining evidence consists of invoices.³ The most relevant is an invoice to Nickolls and Perks, located in the West Midlands, dated 6 May 2022 (which has been provided in duplicate).⁴ This shows the sale of 30 bottles of whisky under the “Artful Dodger” mark, at the price of £1,692. In addition, there is an invoice dated, 29 September 2022, which post-dates the relevant period. However, even if it was dated within the relevant period, it is also addressed to the same address that is listed for the proprietor on the invoice i.e. 23 Trafalgar square, Brighton, BN1 4EQ. Furthermore, the name of the company shares a distinct commonality in the word “Woolf”. Without any explanation for this, I find that it is indicative of internal use only and fails to show a real commercial exploitation of the mark as required under the case law set out above. The two remaining invoices are both invoices from third parties to the proprietor in the course of their business. One being for fees for an exhibition that the proprietor attended dated 10 and 11 September (after the relevant date),⁵ and one dated 20 August 2018, (i.e. within the relevant period) for “25 Mixed AD Tees with front and back prints”,⁶ these presumably being T-shirts bought by the proprietor. Although these could show stock bought in preparation for sale, they are not evidence of sales made by the proprietor under the mark, within the relevant period.

18. There are a number of other deficiencies in the proprietor’s evidence. For example, the proprietor has not provided any precise details of its turnover, market

² Exhibit 1

³ Exhibits 2, 3 and 4.

⁴ Exhibit 3

⁵ Exhibit 2

⁶ Exhibit 4

share or amounts spent on promotional activities within the relevant period. I acknowledge that the exhibition may have been for promotional purposes, however, except for dates of the exhibition, and fees paid, I have no further details about this event. For example, did people purchase anything at the event, or did people sign up for email updates to hear more about the proprietor's products or services. Regardless, the event is dated 10-11 September 2022, which is after the relevant period. The evidence or information does not allow me to assess the scale and extent of the use of the proprietor's mark. Similarly, I have no evidence to determine the geographical extent of use within the relevant period, other than a single invoice to a company located in the West Midlands. Further, I have nothing before me from which I can ascertain whether such use is warranted in the economic sectors concerned to maintain or create a share in the market for the goods and services protected by the mark. However, even without market share information, in the context of what is likely to be an extremely large market in the UK, the invoice suggests a very small turnover, i.e. £1,692 for 30 bottles of whisky. In my view, this is insufficient to create a market for those goods.

19. Taking all of the above into account, I do not consider the evidence sufficient to meet the standard of proof that is required. The proprietor has failed to demonstrate that the mark has been put to genuine use in the UK during the relevant period.

Conclusion

20. The application against the proprietor's mark under section 46(1)(a) has been successful. As a consequence, the proprietor's mark will be revoked from the earliest date requested, namely, 10 June 2022.

Costs

21. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016. Applying this guidance, I award the applicant the sum of **£600**, which is calculated as follows

Preparing a statement and considering the proprietor's counterstatement	£200
Considering the proprietor's evidence ⁷	£100
Preparation of written submissions	£300
Total	£600

22. Accordingly, I hereby order **Woolf Drinks Limited** to pay **Valensys Ltd** the sum of **£600**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of June 2023

Sarah Wallace
For the Registrar

⁷ Although the sum awarded for this activity falls below the scale minimum, I note that this part of the scale is for "preparing evidence and considering and commenting on the other side's evidence". The applicant neither filed its own evidence nor commented upon that filed by the proprietor other than in its written submissions. Further, the evidence provided by the proprietor was extremely brief and would not have taken long to review. As such, I consider the sum to be appropriate in the circumstances.