

O/010/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 2180562  
IN THE NAME OF HARRY MUNRO SINGER  
OF THE TRADE MARK:**

**CHINGGIS KHAN**

**AND THE APPLICATION FOR REVOCATION THERETO  
UNDER NO. 83913  
BY APU JOINT STOCK COMPANY**

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### **BACKGROUND**

1. On 19 November 2010, APU Joint Stock Company (“the applicant”) filed an application for the revocation of registration number 2180562. The registration is for the mark CHINGGIS KHAN and it is registered for *alcoholic beverages (except beers)* in Class 33. The registration stands in the name of Harry Munro Singer. Completion of the registration procedure for 2180562 took place on 23 April 1999.
2. The applicant seeks revocation of the registration in full under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). It claims that no use has been made of the mark in the five years prior to the application for revocation and that there is no evidence of use of the mark since registration. The five year period relating to section 46(1)(a) is 24 April 1999 to 23 April 2004. Success for the applicant would mean a date of revocation of 24 April 2004. The five year period under section 46(1)(b) is 19 November 2005 to 18 November 2010, with a date of revocation of 19 November 2010. The applicant has made a late request to add a further date range under section 46(1)(b) of 31 January 2001 to 30 January 2006, with a revocation date of 31 January 2006; however, for reasons which will become clear, it is unnecessary to add the third date range to the pleadings.
3. Mr Singer filed a counterstatement in which he said he had been actively using and promoting the mark since its inception.
4. Both sides filed evidence and submissions and I make this decision bearing all of their documents in mind<sup>1</sup>.

### **Evidence**

5. Mr Singer has provided two witness statements and the applicant has filed evidence by way of a witness statement from Mr Erdenebileg Tseveenjav, it’s managing director. Mr Tseveenjav’s evidence consists of a report from commercial investigators Eccora Ltd who have looked at whether Mr Singer has used his mark. Mr Singer’s second witness statement is in reply to this evidence.

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<sup>1</sup> The parties were reminded of their right to be heard.

## Mr Singer's evidence

6. Mr Singer states that, whilst he was trading oil internationally, he became involved with an Outer Mongolian firm and “followed up on Chinggis Khan vodka”. He states that his solicitors drew up an exclusive distribution agreement with the distillery covering the UK, Singapore and Nigeria in 1998. He formed Vodkhan Limited on 28 October 1998 “exclusively to promote the trademark Chinggis Khan vodka”, which he had applied for the previous day, and “solely to handle this business when it took off”. In his second witness statement, Mr Singer states that he could not use Vodkhan Ltd to trade an unreliably supplied product, but that this had not stopped him from promoting the trade mark. Mr Singer states that he has attended the London International Wine and Spirit Fair every year since 1998 “to promote and advertise Chinggis Khan vodka” by distributing literature, postcards and pens and “showing samples from our very limited supply”. He provides a copy of his exhibition pass from 2010<sup>2</sup>, which is after the relevant date for these proceedings.

7. Exhibit HMS4 is a copy of an email sent to Mr Singer on 2 January 2007 by the head of APU Company's Executive Director's office<sup>3</sup>. The body of the email says:

“Dear Mr. Harry Singer,

We, at APU Company, received your letter of 7 December addressed to Ms. Oyunsara, today. We highly appreciate your efforts to promote our Chinggis Khan Vodka within the UK. We have already informed Ms. Oyunsara that APU Company is developing a re-branding of its Chinggis Khan vodka, which is expected to be completed within 1<sup>st</sup> half of 2007. Once the design and re-branding exercises are completed we will be ready to start working with potential distributors at various international markets, including the UK. Having said the above, we are pleased to learn that Vodkhan Limited has already moved a long path in distributing our vodka, such as trade mark registration and some awareness efforts, which will obviously make it easy for us to work together.”

8. Mr Singer states that since 1999 he has designed and purchased a wide range of promotional media to promote the Chinggis Khan trade mark “and vodka”. Mr Singer describes exhibits HMS5 to HMS10 as (respectively):

(i) a promotional postcard.

The undated postcard refers to CHINGGIS VODKA. The words CHINGGIS KHAN do not appear.

(ii) a Chinggis Khan/Vodkhan envelope.

CHINGGIS KHAN appears on the envelope, with a pyramid device above the words.

(iii) Chinggis Khan promotional poster.

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<sup>2</sup> Exhibit HMS3

<sup>3</sup> The intended assumption throughout Mr Singer's evidence is that APU Company is the applicant, although it is not stated by either party that “APU Company” or “APU” is, in fact, the applicant.

The word CHINGGIS appears along with the description “Original Mongolian Vodka”, a device of a Mongolian warrior and a sort of globe device, all on a picture of a bottle. The poster says “CHINGGIS ORIGINAL MONGOLIAN VODKA”. If one looks extremely closely at the bottle label, it is possible, beneath the picture of the warrior’s face, to see the words “Chinggis Khan 1162-1227”.

(iv) Chinggis Khan/Vodkhan business cards 1999-2010

There are six undated business cards. Four of the cards refer only to Vodkhan Limited. The other two cards also refer to Vodkhan Limited, with the words “Chinggis Mongolian vodka – that’s the spirit!” The words CHINGGIS KHAN do not appear.

(v) Chinggis Khan/Vodkhan promotional pens

One of the pens says CHINGGIS KHAN vodka along its length.

(vi) Chinggis Khan/Vodkhan letterhead

The letter heading says Vodkhan Limited. CHINGGIS KHAN does not appear.

9. Mr Singer states that, over the years, he has extensively canvassed major outlets such as Oddbins, Harrods, Sainsbury’s and Tesco. Exhibit HMS11 is a letter from Mr Singer dated 10 December 1998 to Oddbins. Some of the content is as follows:

“Thank you for taking the time recently to briefly discuss Oddbins possible interest in Mongolian vodka...I have enclosed the requested sample bottle.”

“...our main... business is oil trading but we occasionally diversify where convenient. When the long established Outer Mongolian distillery offered us the marketing rights we carried out taste tests in various UK and Nordic State countries which have proved encouraging enough for us to develop the concession. Our original plan was to exhibit the vodka at various trade fairs in the New Year...”.

“I realise that you already have a fair selection of suppliers but maybe none has the cachet of Chinggis Khan to appeal to customers looking for something different”.

No reply letter is shown in the evidence.

10. Exhibit HMS12 shows a copy of an email exchange between Mr Singer and Harrods. These are dated 12 and 13 October 2004. Mr Singer begins by explaining that he is being “chased by the Mongolian Ambassador as to when he is going to arrange a display of “Chinggis vodka”. The Harrods employee replied that he was being forwarded some shipping quotes from ‘MCS’ and that he believed that things were “moving in the right direction”. HMS13 shows a further email exchange between Mr Singer and ‘MCS’, dated 29 November 2004 and 3 December 2004, in which Mr Singer complains that he is losing potential business because of delays in getting responses from Mongolia and that he needs to get an order shipped to

Harrods and needs promotional brochures and posters. The 'MCS' employee apologised for the delay in his reply and says that he is talking with Harrods about shipping the first 30 cases of 'Chinggis vodka'. "Once they place a written order we will ship the vodka soon."

There are no exhibits relating to Sainsbury's and Tesco.

11. Mr Singer states that he had a business plan to import full strength spirit which Thames Distillery would then dilute as Chinggis Khan vodka, passing it through their bonded warehouse. An email from Thames Distillers Ltd to Mr Singer, dated 15 May 2004, says that the bottles will be shown and discussed with distributors the following week. Mr Singer does not provide any further evidence to show what progress was made, although he says that evidence can be provided. As can be seen from paragraph 13, below, the 'intention' was to form a joint venture, which indicates that this did not happen.

12. Mr Singer makes reference to his activities with European/Asian political and business fora which he states facilitate or increase "potential sales of Chinggis Khan". He was also invited to the Mongolian Embassy in recognition of his efforts to promote Mongolia and its vodka trade. Again, Mr Singer says that evidence is available, but does not provide it. He was contacted by the BBC on 6 October 2006 because the radio programme 5Live was researching a story on vodka, which Mr Singer states he attended as an expert.

13. Mr Singer states that "over time" he tried out the Mongolian distillery, APU (with whom he had the agreement referred to above), with deliveries to Singapore. Information from APU was not easy to obtain and neither were prices, quantities and delivery details. Mr Singer says:

"I was dynamic in testing the UK market by contacting major purchasers and purchasing marketing data. I intended to form a joint venture with the established Thames Distillery who distil gin in London and have contracts with Asda and Sainsbury's. For a commission I would be able to use their chemists, sales contacts and bonded warehouse.

The unreliability of possible supply was serious...Through Time APU has changed owners (including MCS) and we have had a rapport with them and modified our contract in 2003 on the same terms but no reliable supply could be counted on."

14. As evidence of problems of this nature, Exhibit HMS19 (dated 21 January 2000) shows Mr Singer cancelling his "prospective order of 120,000 bottles of Chinggis Khan" until he receives a signed contract and promised samples. There is no follow up email or letter to explain if the order was ever re-instated. HMS19 is a copy of an email from 'MCS Mongolia', dated 27 January 2004, explaining that MCS had no news from the bottle manufacturer and that orders were constantly getting postponed. MCS says the bottles "should be with us on 31 January" and that they will then ship the bottles to the UK. Mr Singer does not provide any evidence to show whether any progress was made. There is also no reference to Chinggis Khan in the email.

15. Mr Singer has filed three letters (which have been solicited for the purpose of these proceedings) from individuals who knew of his promotional efforts in relation to the trade mark. Michael Rapoport worked as a solicitor for the firm of solicitors which Mr Singer used to draw up his exclusive agreement in 1998. Mr Rapoport's evidence, although given in 2011, relates to 1997 (he retired from the firm in 1999). Mr Rapoport says that he remembers Mr Singer was introduced to at least one company who could dilute to market strength and bottle vodka to be shipped in bulk from Mongolia. This would overcome the problems Mr Singer had encountered with shipments of broken bottles of vodka from Mongolia "which frustrated fulfilment of orders obtained in the UK". The second witness statement is from Mr Alun P Jones, also a retired solicitor. Mr Jones says that he has attended trade fairs and has seen Mr Singer actively promote the trade mark in various ways including but not limited to handing out pens, brochures and holding meetings with potential clients and partners. The third letter is from Miss Handan Hazarhun who says that she is aware that Mr Singer has actively promoted the Chinggis Khan trade mark "over the last many years" and that she has helped him disseminate promotional materials such as pens, postcards and other literature at various fairs and events.

16. Mr Singer states that "over time" he was concerned that the distiller was trying to take over his trade mark without buying it and that APU had registered Chinggis Khan as a trade mark in the EU. Contact with APU dried up after 2008 until, in 2010, this application for revocation of Mr Singer's mark was made. Mr Singer says that APU may have withheld support over time to justify a claim that he has not actively been promoting Chinggis Khan.

#### Mr Erdenebileg Tseveenjav's evidence

17. Mr Erdenebileg Tseveenjav's witness statement chiefly serves to bring into evidence the investigator's report. However, I note that he also states:

"I confirm that my company did not sell vodka under the mark CHINGGIS KHAN to Mr Harry Munro Singer in the UK between 19 November 2005 and 18 November 2010 and to the best of my knowledge has never sold vodka to Mr Singer."

It is unnecessary to go into much detail regarding the report, save to note that the investigation found that Vodkhan Limited was formed in 1998 and has been dormant/non-trading since at least 2001 to the present date. Having conducted various searches, the investigators could not find any use by Mr Singer or Vodkhan Limited of CHINGGIS KHAN.

#### **Decision**

18. Section 46 of the Act reads as follows:

"(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) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes 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 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.”

19. Section 100 of the Act states:

“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.”

Consequently, the onus is upon Mr Singer to prove that he has made genuine use of the trade mark in suit or that there has been genuine use with his consent in the relevant periods. The evidential burden lies with Mr Singer.

20. Ms Anna Carboni, sitting as the appointed person in, *PASTICCERIA E CONFETTERIA SANT AMBROEUS S.R.L. v G&D RESTAURANT ASSOCIATES LIMITED*, case BL O-371-09, summarised a set of principles from the following leading Court of Justice of the European Union (“CJEU”) cases on the issue of genuine use: *Ansul BV v AjaxBrandbeveiliging BV*, Case C-40/01, [2003] ETMR 85; *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02, [2004] FSR 38; and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR:

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

21. At the heart of Mr Singer’s evidence and his submissions is his belief that the trade mark CHINGGIS KHAN was not “dormant” or “moribund”, but was instead creatively and actively promoted. I do not doubt that, at times during the relevant periods, he was actively trying to get vodka to market under the trade mark. However, there are large gaps in time in the evidence between activities and a great deal of the picture is missing. I also have no reason to doubt that he is knowledgeable in relation to Mongolia, Mongolian vodka and vodka in general (as evidenced by the approach from 5Live). However, being an expert in something does not mean that there has been genuine use of his trade mark in accordance with the cited legal principles.

22. The evidence does not show a single sale of a bottle of vodka (or any other alcoholic drink), under the mark CHINGGIS KHAN or any variation of that mark. Preparations for use can count towards genuine use, but there must be evidence that the preparations have been sufficient to establish a market for the goods and a level of commercial exploitation of the mark which is warranted in the economic sector concerned. Mr Singer has had (at the date of application) eleven years to create and maintain an outlet for the goods. The letter from APU Company in 2007, i.e. 6 years after registration, refers to potential distributors and to developing a re-branding of Chinggis Khan vodka. The approach to Oddbins appears to have got nowhere and, if it did, Mr Singer has not shown any evidence of it. It also appears that the 2004 orders by Harrods came to nothing. The Thames Distillery trail goes cold after 2004. There are no import or customs documents at any date. None of the exhibits, with the exception of the undated promotional pen and an undated envelope, show the mark as registered. The hearsay evidence from the three individuals does no more than point to the same picture that Mr Singer has drawn in his evidence, which is of sporadic, intermittent, and frustrated attempts at importing vodka to sell in the UK. There were supply obstacles all the way through; the position does not appear to have changed between 1999 and 2010. Proper reasons for non-use has not been pleaded as a defence in the counterstatement. Mr Singer has consistently maintained as his defence that the mark has been used/promoted. Mr Singer is a litigant-in-person, but it would be wrong for me to introduce a point

that he himself has not taken<sup>4</sup> and to do so would be protagonistic and contrary to the neutral nature of a tribunal. For the record, a ‘proper reasons’ defence is not to be pleaded lightly: the CJEU, in *Haupt v Lidl Stiftung & Co KG* Case C-246/05 [2007] E.T.M.R. 61, ruled that “only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as “proper reasons for non-use” of that mark. Normal business delays do not fall within that category.

23. I am left with the clear impression that Mr Singer’s evidence points to a picture of over a decade of hoping that there will be sales at some point in the future. Sporadic promotional activity which is confined to less than a handful of retailers and an annual presence at a trade fair, his contribution at which is unknown, and which has been in relation to CHINGGIS (on the few occasions in the evidence where a mark is shown) rather than CHINGGIS KHAN, cannot make up for zero trade over this length of time. If there was more evidence than this, Mr Singer did not provide it and the onus was on him to prove use of the mark which he has registered, rather than the applicant to prove lack of use. The application for revocation succeeds: the registration is revoked for all goods with effect from 24 April 2004.

### **Costs**

24. The applicant has been successful and is entitled to an award of costs on the following basis<sup>5</sup>:

Preparing a statement and considering the counterstatement	£200
Opposition fee	£200
Filing evidence and considering the applicant’s evidence	£500
Written submissions	£300
<b>Total:</b>	<b>£1200</b>

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<sup>4</sup> See the decision of Mr Iain Purvis as the Appointed Person, in *Hypnotiser* O/115/10, available on the Intellectual Property website.

<sup>5</sup> As per the scale in Tribunal Practice Notice 4/2007.

25. I order Harry Munro Singer to pay APU Joint Stock Company the sum of £1200. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of January 2011**

**Judi Pike  
For the Registrar,  
the Comptroller-General**