

**BL O/0177/26**

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK2645011 IN THE NAME OF MARCOS CARS LIMITED IN RESPECT OF THE TRADE MARK



IN CLASSES 12 & 25

AND IN THE MATTER OF AN APPLICATION FOR THE REVOCATION THEREOF UNDER NO. 503582 BY MARCOS SPORTSCARS LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF L NICHOLAS (O/805/25) DATED 29 AUGUST 2025.

-----  
DECISION  
-----

**Introduction**

1. This is an appeal by Marcos Cars Limited ("**Appellant**") from decision O/805/25 of Laura Nicholas ("**Decision**") concerning the application for revocation by Marcos Sportscars Limited ("**Respondent**") to the Appellant's registered trade mark No. UK2645011 ("**Mark**"), details of which are as follows:



Filing date: 7 December 2012

Registration date: 10 May 2013

Goods registered:

Class 12: *Vehicles; apparatus for locomotion by land; motors and engines for land vehicles; vehicle body parts and transmissions.*

Class 25: *T-shirts; base ball caps; sweat shirts and shirts.*

2. On 21 January 2021 the Respondent filed an application for revocation against all the goods under ss. 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“**the Act**”).
3. The period during which the Respondent alleged non-use under section 46(1)(a) was the five years after registration of the Mark, being 11 May 2013 to 10 May 2018 with revocation sought from 11 May 2018. Under the section 46(1)(b) ground, the Respondent alleged non-use of the Mark for two periods, being 21 January 2016 to 20 January 2021 with revocation sought from 21 January 2021 and 22 October 2015 to 21 October 2020 with revocation sought from 22 October 2020.
4. The Appellant contested the application, and both parties filed evidence. A hearing took place on 7 August 2024, attended only by the Appellant, with the Respondent filing written submissions in lieu.
5. Ms L. Nicholas for the Registrar held that the application was successful. On 15 October 2025 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

### **The Hearing Officer’s decision**

6. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):
  - a. The evidence filed by the Appellant showed use of the Mark on some invoices, on a prototype car and on some polo shirts. The Appellant has never sold any vehicles under the Mark, and there is no evidence of any sales of clothing bearing the Mark.
  - b. The prototype car has been displayed at certain events, and an order for a car has been taken, albeit construction of that car has not yet started.
  - c. Taken as a whole, the evidence filed by the Appellant does not establish genuine use in respect of any of the Goods in any of the periods in contention.

### **Grounds of Appeal**

7. The Appellant’s Grounds of Appeal were professionally drafted and are as follows:
  - a. **Ground 1:** Misapplication of the test for genuine use - The Hearing Officer’s decision is inconsistent with the established principles set out in *Polfarmex v EUIPO* pertaining to the acknowledgment that despite there being no sales in the relevant period, there had been a genuine use of the Mark in relation to sports cars;
  - b. **Ground 2:** Failure to consider all relevant evidence collectively - The Hearing Officer erred in principle by failing to assess the Appellant’s evidence of use (including the invoices and promotional material) cumulatively and in context;
  - c. **Ground 3:** Mischaracterisation of Class 25 evidence - The Hearing Officer incorrectly concluded that Class 25 goods (clothing) had not been used genuinely because there were no sales;
  - d. **Ground 4:** Procedural/reasoning errors - The Hearing Officer failed to adequately explain why preparatory steps, marketing and promotional activities were disregarded or given minimal weight, contrary to established case law regarding assessment of genuine use.

8. At the appeal hearing, the Appellant represented itself by way of its directors, William Story and Tony Brown. The Respondent did not attend the hearing, nor did it file submissions in lieu.

#### **Standard of review**

9. The approach to be adopted in an appeal hearing has been laid down a number of times in case law, most recently in *Iconix Luxembourg Holdings SARL v. Dream Paris Europe Inc* [2025] UKSC 25 at §§94-95:

“94. It is perhaps obvious, and certainly an inevitable conclusion drawn from experience, that reasonable minds, and in particular reasonable judicially trained minds, each faithfully applying the relevant law and principles, will come to different conclusions about the answer to these multifactorial questions. While of course the decision of an appellate court trumps that of the court below, the law has imposed structured constraints designed to prevent a free for all in a higher court whenever a party (with the necessary resources) wishes to challenge the first instance decision of the trial judge. The reasons for these constraints are set out in a string of well-known authorities including, in the intellectual property context, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5; [2014] FSR 29, per Lewison LJ at para 114. The reasons there set out relevantly include the following:

- (i) The trial is not a dress rehearsal. It is the first and last night of the show.
- (ii) Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court.
- (iii) In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping.

95. In *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8; [2024] Bus LR 532 this court reviewed those constraints in a trade mark context. After citing from the *Fage* case this court in a joint judgment said, at paras 49- 50:

"49. That does not, however, mean the appeal court is powerless to intervene where the judge has fallen into error in arriving at an evaluative decision such as whether an activity was or was not targeted at a particular territory. It may be possible to establish that the judge was plainly wrong or that there has been a significant error of principle; but the circumstances in which an effective challenge may be mounted to an evaluative decision are not limited to such cases. Many of the important authorities in this area were reviewed by the Court of Appeal in *In re Sprintroom Ltd* [2019] 2 BCLC 617, paras 72–76. There, in a judgment to which all members of the court (McCombe, Leggatt and Rose LJJ) contributed, the court concluded, at para 76, in terms with which we agree, that on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.

50. On the other hand, it is equally clear that, for the decision to be 'wrong' under CPR r 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation."''

10. Further guidance was provided in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

“24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS O/039/21*), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

- i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
- ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS O/039/21* at [14]);
- iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);
- iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
- v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).
- vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

- vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).
  - viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).
  - ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)])."
11. To the above should be added the judgment of the Court of Appeal in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262, where Arnold LJ said at §110 "It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable".
  12. I shall bear all the above in mind when reviewing the Decision.

## Discussion

### (1) Misapplication of the test for genuine use

13. By way of background, Marcos Engineering Limited was a British sports car manufacturer founded in 1959 by Jem Marsh and Frank Costin (the name Marcos is a portmanteau of the founders' surnames). The company produced and sold a number of sports cars in the 1960s and early 1970s, but went out of business in 1971. There were subsequently a number of attempts by the original founders and others to revive the marque, the last of which ended in 2007.
14. In 2010 Mr Brown incorporated the Appellant company. As explained in his evidence, the Appellant does not have "anything directly to do with any of the previous Marcos companies owned and started by Mr Jem Marsh, nor with the Marcos company later owned by Mr Anthony Stelliga". Nevertheless, as Mr Brown's evidence states, the original co-founder Jem Marsh did advise the Appellant on its cars and business prior to his death, and the Marcos Owners Club (which is concerned primarily with historical Marcos vehicles) is supportive of the Appellant's attempts to revive the marque.
15. The Appellant has not yet sold any cars under the Mark, however it has produced a prototype of an entirely new car, the "Marcos Spirit 220", which has been exhibited in public and has undergone track testing and trials. It has received an order to construct a vehicle for a paying customer, although work on construction has not yet commenced.

16. The Hearing Officer made reference to s. 100 of the Act, which establishes that the burden of proof in revocation for non-use actions lies with the proprietor to show use. She then cited Arnold LJ's account of the relevant law in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Bunderversvereinigung 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 Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]; *Ferrari* at [33].

(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].”

17. After assessing the evidence of use, she considered the case of *Polfarmex S.A. v EUIPO*, Case T-677/19, EU:T:2020:424, in which the General Court upheld a decision by the EUIPO Board of Appeal that, despite there being no sales in the relevant period, there had been genuine use in relation to racing cars. She cited from the decision as follows:

“69. Moreover, the content of all those documents is not disputed by the applicant. Likewise, it should be noted that, in the light of the observations in paragraphs 63 to 68 above, the applicant is not justified in claiming that the goods covered by the contested mark were never actually placed on the market or were never about to be placed on the market. It should be specified that the placing on the market of goods or services also includes circumstances in which that product or service is actually offered for sale, even if it has not yet been sold.

70. It must also be stated that the Board of Appeal, in paragraph 48 of the contested decision, relied on the Court’s case-law, which it was fully entitled to consider relevant in the present case. **As is apparent from the case-law, it is common knowledge that the market for high-end sports cars with technical specifications that are not intended for normal, everyday road use and the price of which exceeds that of most private use cars is often characterised by relatively low demand, by production to specific order and by the sale of a limited number of vehicles.** The Court held that, in such circumstances, the provision of accounting documents setting out sales figures or invoices is not necessary for the purposes of establishing genuine use of the mark in question. Further, the Court noted that publications demonstrated that the mark in question was the subject matter

of public discussion in anticipation of a revival of production and sale of a car model bearing the mark in question (see, to that effect, judgment of 15 July 2015, *TVR ITALIA*, T-398/13, EU:T:2015:503, paragraph 57).

71. It follows that, having regard to the specific features of the relevant market, duly taken into account by the Board of Appeal when it relied on the case-law cited in paragraph 70 above, the evidence produced by the intervener shows the existence of various preparatory tasks and advertising efforts in relation to the SYRENA Meluzyna R model. Moreover, it shows, as contended by EUIPO, not only that the car was about to be marketed, but also that it was available to order.

72. Moreover, it should be borne in mind that, contrary to the applicant's claims, it is apparent from the case-law cited in paragraph 41 above that use of the mark can be shown by evidence that the goods at issue are about to be marketed.

73. Accordingly, the Board of Appeal was fully entitled to consider that genuine use of the contested mark had been shown in respect of sports cars. That finding cannot be called into question by the applicant's other arguments." (**Hearing Officer's emphasis**)

18. At §36 she said:

*"I do not consider that Mr Brown is producing cars that can be categorised as high-end sports cars. This is due to the price point of his cars being around £50,000, and therefore this takes us away from the finding in the above case".*

19. The Appellant contends that "The Hearing Officer failed to give adequate weight to [the Appellant's] circumstances, and in particular to the economic and practical realities of a (initially) small-scale specialist car manufacturer".

20. In my view, the Hearing Officer was correct to categorise the likely price of the Appellant's cars – around £50,000 – as not being "high-end" in the context of sports cars. I take judicial notice in this regard of sports cars retailing at prices one or even two orders of magnitude higher e.g. Bugatti, McLaren etc. However, by focusing only on price, thereby distinguishing the principle laid down in *Polfarmex*, the Hearing Officer fell into error.

21. Considering the passage in *Polfarmex* emphasised by the Hearing Officer: "As is apparent from the case-law, it is common knowledge that the market for high-end sports cars with technical specifications that are not intended for normal, everyday road use and the price of which exceeds that of most private use cars is often characterised by relatively low demand, by production to specific order and by the sale of a limited number of vehicles" (my underlining).

22. It is clear, therefore, that the General Court saw price as only one relevant factor. Considering the other factors in light of the facts of this case:

- Technical specifications that are not intended for normal, everyday road use – the Appellant's prototype is a mid-engined two-seater with a V8 engine. It is clearly not intended for normal everyday road use;
- Relatively low demand – the target market for the Appellant's vehicle can be viewed as a niche within a niche, namely people interested in a sports car which is a continuation of a historical British marque which has been largely defunct for decades;

- Production to specific order – the Appellant’s evidence before the Hearing Officer made clear that production will be on an *ad hoc* basis, dependent upon an order being placed and a deposit paid.
  - Sale of a limited number of vehicles – at least initially, the Appellant intends to produce no more than a few dozen vehicles a year if orders are placed for the same.
23. Accordingly, therefore, price notwithstanding, the Appellant’s situation falls firmly within the scope of *Polfarmex*, such that actual sales of vehicles is not a necessity for establishing genuine use. Instead, genuine use may be established by factors including:
- The existence of various preparatory tasks and advertising efforts;
  - Publications demonstrating that the mark in question was the subject matter of public discussion in anticipation of a revival of production and sale of a car model bearing the mark in question; and
  - The fact that the car was about to be marketed.
24. The first ground of appeal accordingly succeeds. It will therefore be necessary for me to reassess the evidence of use to determine whether it suffices in the context of *Polfarmex*. I shall do so in the context of the second ground of appeal.

**(2) The Hearing Officer failed to consider all relevant evidence collectively**

25. The Appellant contends that the Appellant’s evidence demonstrates:
- a. Use of the Mark on prototypes and body shells;
  - b. Marketing and promotion at car shows and events;
  - c. Sales of branded clothing and use of the mark on invoices, letters and communications;
  - d. Continued development and engagement with potential clients, despite the pandemic restrictions.
26. It contends that the Hearing Officer treated individual pieces of evidence in isolation, rather than considering its cumulative effect.
27. The Appellant is certainly correct to say that it is the cumulative effect of the evidence of use that is important. The Hearing Officer reminded herself of this at §31 where she said “*An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself*”.
28. The Hearing Officer went on to make a careful analysis of the evidence filed by the Appellant. She noted what each category of evidence did and did not show. She finally stood back and reached her overall conclusion. I accordingly do not accept that the Hearing Officer failed to consider the evidence collectively. On the contrary, it is clear that she did.
29. Given the Hearing Officer’s error identified above in relation to ground 1, however, it is necessary for me to reconsider the Appellant’s evidence of use to determine whether it suffices to constitute genuine use. I have read the Appellant’s witness statements filed before the Hearing Officer, and also considered the exhibits thereto. Although the Appellant’s witness statements addressing use of the Mark are not as clear as they might be, it is tolerably clear

from the exhibits that at least the following use was made of the Mark in relation to at least some of the class 12 goods during the first period in question (11 May 2013 – 10 May 2018):

- August 2013: the Marcos Spirit 220 prototype was revealed at the Prescott Hill Climb event. The prototype was run at the event, and was subsequently featured in issue 99 of the Marcos Owner's Club magazine "Marcos Torque";
- November 2013: the prototype was displayed at the NEC Classic Car Show;
- Early 2014: the prototype was again featured in issue 101 of the Marcos Owner's Club magazine "Marcos Torque", which included a report of its display at the NEC Classic Car Show in 2013;
- July 2014: Reports of a forthcoming speed record attempt were published in the Western Telegraph;
- August 2014: the prototype was again shown at the Prescott Hill Climb event;
- September 2014: the prototype was displayed at the Corran Classic Car Show;
- November 2014: the prototype was again displayed at the NEC Classic Car Show;
- Autumn 2014: the prototype was the subject of an extended feature in issue 104 of the Marcos Owner's Club magazine "Marcos Torque";
- August 2015: the prototype was again shown at the Prescott Hill Climb event.

30. Thereafter, the evidence is less clear, however the prototype and the Appellant's plans were advertised throughout the relevant period on the Facebook page at [www.facebook.com/MarcosCarsLtd](http://www.facebook.com/MarcosCarsLtd). A post was published on 14 May 2015 with the wording "So now you can be part of the Marcos Cars brand. Please share and like as much as possible", together with a link titled "CLICK HERE to support Re floating the Marcos Car brand".

31. The Appellant's evidence of use in this first period is certainly thin. However, it seems to me that the evidence does establish that the Appellant was engaged in the following (taken from *Polfarmex*):

- Various preparatory tasks and advertising efforts: the Appellant constructed a prototype, and displayed/ran it at public events. The Appellant's first witness statement refers to gaining sponsorship from Beta Tools, Toyo Tyres, Burton (Ford), Prescott Revival and Red Wolf Vodka, and this is borne out by the photographs of the prototype bearing the insignia of those sponsors;
- Publications demonstrating that the mark in question was the subject matter of public discussion in anticipation of a revival of production and sale of a car model bearing the mark in question: a prototype bearing the Mark was featured at least three times in the magazine of the Marcos Owner's Club, and was also on the Appellant's Facebook page throughout the period;
- The fact that the car was about to be marketed: It is clear from the Appellant's evidence that it was undertaking the above tasks with a view to receiving orders for production.

32. Standing back and carrying out a global assessment, as I am required to do, I consider that the use made was "consistent with the essential function of a trade mark, which is to guarantee the

identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin" (*Ansul v Ajax* at §36). Although its use was limited, I am just about persuaded that the Appellant has shown genuine use for at least some of the class 12 goods in the first period.

33. The second and third periods overlap. Evidence of the prototype being displayed at events during these periods is thinner, although it continued to be featured throughout on the Appellant's Facebook page. Critically, though, in July 2018 the Appellant received an order to build a car, as evidenced by an invoice issued by the Appellant on 27 July 2018. The Respondent submitted below that there is no evidence that the order was followed through, and the Appellant concedes that it has not yet constructed the car in question. Nevertheless, there is nothing in the evidence I have seen to suggest that the order was anything other than *bona fide*. That order must be viewed in the context of what is essentially a "cottage industry", namely one-off manufacturing of cars to order in a niche sector. It seems to me that an order to construct a car in return for money, in the context of ongoing (albeit limited) promotional efforts, suffices to show genuine use of the Mark in the second and third periods in the context of a niche sports car.
34. The question now arises whether use has been proven for all the goods for which the Mark is registered in class 12, or only for some of those goods, and if so whether the registration should be partially revoked so as to limit the specification. A summary of the relevant principles was provided by Kitchin LJ (as he then was) in *Merck KGaA v Merck Sharp and Dohme Corp* [2017] EWCA Civ 1834:

"245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered from the viewpoint of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark."

35. The Mark is registered for *Vehicles; apparatus for locomotion by land; motors and engines for land vehicles; vehicle body parts and transmissions*. At §39 the Hearing Officer said:

"I note that the current class 12 specification includes 'motors and engines for land vehicles; vehicle body parts and transmissions' but I have not been provided any evidence in relation to these goods specifically and I would consider the rev counter put forward

in evidence (which the Cancellation Applicant submits is actually provided by another company anyway) to be an instrument and not a vehicle body part and therefore, it is of no assistance here”.

36. I agree, and consequently the Mark should be revoked in respect of *motors and engines for land vehicles; vehicle body parts and transmissions*. As for the remaining categories, it seems to me that both *vehicles* and *apparatus for locomotion by land* are very broad categories, each of which has a number of independent subcategories. In my view, the average consumer would regard the Appellant’s use as being in relation only to *motor cars*. I accordingly consider that confining the class 12 goods to *motor cars* would be a fair specification, having regard to the use which has been made of the Mark.
37. The second ground of appeal accordingly succeeds in relation to *motor cars* in class 12.

### **(3) The Hearing Officer mischaracterised the Class 25 evidence**

38. I turn now to the class 25 goods. At §33 the Hearing Officer said:

“In relation to the class 25 goods, being ‘T-shirts; base ball caps; sweat shirts and shirts’, the only evidence I have been provided with that shows clothing available to purchase is the screenshot of the polo shirts for sale. As pointed out by the Cancellation Applicant in their submissions, there is no evidence of any actual sales. All other evidence showing clothing bearing the contested mark appears to be promotional wear at no more than a handful of events rather than being offered for sale to the public. I also have no sales or marketing figures relating to these goods. It goes without saying that the clothing market is extremely large and therefore even a small market share could be significant, however, I have not been given any evidence that allows me to make a finding that there has been genuine use in relation to these goods”.

39. The Appellant contends that the Hearing Officer incorrectly concluded that Class 25 goods (clothing) had not been used genuinely because there were no sales. The Grounds of Appeal state that “As per the established principles, use by the Appellant for promotional purposes at car shows and events, linked directly to marketing vehicles, constitutes genuine use in a commercial context (*Ansul BV v Ajax Brandbeveiliging BV*)”.
40. I do not agree that the above is an accurate summary of the applicable law. At paragraph 12-089, the authors of Kerly’s Law of Trade Marks and Trade Names, having cited a passage from *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-496/07) EU:C:2009:10, state:

“This judgment does not mean that use on promotional items can never constitute genuine use. The test is whether the proprietor of the mark is using the mark in order to create an outlet for the goods in question.” (my underlining).

41. The fact that clothing may have been given away rather than sold is therefore not necessarily a bar to a finding of genuine use, but the giving away of the clothing must be with a view to establishing a market for the clothing itself, rather than for some other category of goods. As the Hearing Officer stated, there is no evidence of any sales, nor is there any evidence that the use of the clothing was anything other than by way of promotion of the Appellant’s cars. The Hearing Officer was accordingly entitled to make the finding she did.
42. I dismiss this third ground of appeal.

### **(4) The Hearing Officer made procedural/reasoning errors**

43. The Appellant contends that the Hearing Officer failed to adequately explain why preparatory steps, marketing, and promotional activities were disregarded or given minimal weight, contrary to established case law regarding assessment of genuine use.
44. I believe I have addressed the above in the context of the second ground of appeal, where I revisited the Hearing Officer's analysis of the Appellant's evidence of use.
45. I dismiss this fourth ground of appeal.

#### **Conclusion**

46. The appeal succeeds in relation to *motor cars* in class 12, but is unsuccessful in relation to the other goods in class 12, and all the goods in class 25. With effect from 11 May 2018, the Mark is restricted to *motor cars* in class 12, and is revoked for all other goods in class 12 and all goods in class 25.

#### **Costs**

47. The Appellant has been partially successful. Although it acted for itself in the hearing, it will have incurred costs in relation to the professional drafting of the Grounds of Appeal. In accordance with the scale costs in TPN 2/2016 (as the application for revocation was filed prior to the commencement date for TPN 1/2023), I order that the Respondent should pay the Appellant the sum of £500.
48. As for the costs below, the Hearing Officer ordered that the Appellant should pay the Respondent £700. I set that costs order aside. Given that each party has achieved a degree of success, I make no order as to costs in relation to the proceedings before the Hearing Officer.
49. Accordingly, the Respondent must pay the Appellant the sum of £500 within 21 days of this decision.

**Dr. Brian Whitehead**

**1 March 2026**

#### **Representation**

William Story and Tony Brown, directors, for the Appellant

The Respondent did not participate in the appeal