

O/077/12

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 2261283
IN THE NAME OF WWRD IPCO LLC

AND

AN APPLICATION FOR REVOCATION THEREOF
UNDER NO 83881 BY PIASTEN GMBH & CO KG

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IN THE MATTER OF Registration
No 2261283 in the name of
WWRD IPCO LLC and
an application for revocation
thereof under No 83881 by
Piasten GmbH & Co KG

Background

1. Registration No 2261283 stands in the name of WWRD IPCO LLC (“WWRD”) and is for the trade mark ROYAL DOULTON. The trade mark completed its registration process on 19 July 2002.

2. On 18 October 2010, Piasten GmbH & Co KG (“Piasten”) filed, on Form TM26(N), an application seeking to revoke the registration insofar as it is registered for the following goods and services:

Jellies, jams, marmalades, processed fruits and vegetables, preserved, dried and cooked fruits and vegetables, fruit sauces

Tea, coffee, cocoa, coffee beans, bread, biscuits, pastry, cakes, confectionery, sweets, chocolate, honey and sauces

and

The bringing together, for the benefit of others, of a variety of goods enabling customers to view and purchase those goods in a department store or a wholesale outlet.

The above goods and services are classified in classes 29, 30 and 35 respectively according to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3. The application for revocation of the registration is made under grounds based on sections 46(1)(a) and (b) of the Act. Piasten claims there has been no use of the mark in the relevant periods in relation to the above goods and services and that there are no proper reasons for non-use.

4. WWRD filed a counter-statement denying the claims made.

5. WWRD filed evidence and both parties have filed written submissions. Neither party requested to be heard. I give this decision after a careful review of all the written material before me.

Decision

6. Sections 46(1)(a) & 46(1)(b) of the Act read:

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

(c)

(d)

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

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

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

(4) An application for revocation may be made by any person, and may be made 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.”

7. Section 100 of the Act is also relevant, this reads:

“**100.** 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.”

8. Piasten seeks revocation of the mark under section 46(1)(a) with effect from 20 July 2007 and under section 46(1)(b) with effect from 18 October 2010. The relevant periods within which WWRD must show genuine use of the mark (or proper reasons for its non-use) are therefore 20 July 2002 to 19 July 2007 (under section 46(1)(a)) and 18 October 2005 to 17 October 2010 (under section 46(1)(b)). These periods overlap. If WWRD show genuine use (or proper reasons for non-use) of the mark in relation to the goods and services under attack within the period applicable under section 46(1)(b), then the claim made under section 46(1)(a) will fall away. I note that WWRD have made no claim that it relies on the defence of proper reasons for non-use; rather it claims to have made genuine use of the trade mark.

WWRD's evidence

9. WWRD filed four witness statements. The first is from Anita M Jones and is dated 5 April 2011. Ms Jones states she has been the Assistant General Counsel EMEA and Asia Pacific for WWRD United Kingdom Ltd (“WWRDUK”) since December 2009.

10. Ms Jones states that Josiah Wedgwood & Sons Ltd, Royal Doulton (UK) Ltd and Waterford Wedgwood PLC were related companies which went into administration on 5th January 2009. The business assets of these companies, including intellectual property rights, were bought by WWRD Holdings Ltd (“Holdings”). The registration in suit was originally in the name of Royal Doulton (UK) Ltd but was later assigned to WWRD which is a related company to Holdings and WWRDUK.

11. Ms Jones states the ROYAL DOULTON brand has been in use in the UK for some 200 years having begun as a small pottery business specialising in practical and decorative stoneware. The pottery grew into the Royal Doulton (UK) Ltd business and generated annual sales in 2003 in excess of £115m with almost £50m sales in the UK alone. She states the brand has appeared on a range of goods including china, figurines, glassware, giftware and foodstuffs. The brand is said to enjoy an exceptional renown, consistently being recognised as a top brand in the UK as shown by the Superbrand Consumer Surveys exhibited at AMJ-1 which are compiled annually by the London-based Centre for Brand Analysis. This exhibit includes results from surveys between 2006 to 2011. The Royal Doulton brand is listed as high at No 6 (2008/2009) and as low as No 63 (2006/2007). I note that in

each survey, the brand is stated as being known for either Household Products (2006/2007) or Household-General (all others). An accompanying article taken from the Thisisstaffordshire website (which is duplicated within the exhibit) is undated but appears to refer to the 2011 survey and describes Royal Doulton as a world-famous pottery brand.

12. Ms Jones comments on the services of the registration and states that WWRD or its predecessors in business began to operate retail stores, department store concessions and wholesale and factory outlets in 1994. She states that at its height, (she does not say when this might have been), there were 45 retail locations in the UK though, as at the date of her witness statement, that number had reduced to just six. The London store, on Piccadilly, operated between 1994 and 2007. The outlet superstore in Etruria, Stoke on Trent, first opened in 2001 and continued to operate at the date of the witness statement. Between 2000 and 2009, wholesale and factory outlets are said to have operated in at least 3 locations in Stoke on Trent. She states that in-store concessions began operation in 1994 with up to 200 in operation in 1998. One such concession operated in Harrods in London from 1994 until 2009. WWRDUK opened its in-store concession in Harrods in 2010 and is said to “showcase” a range of products from dinner and stemware to luxury gifts and limited edition prestige pieces. What form these “luxury gifts and limited edition prestige pieces” take is not explained.

13. At AMJ-2,3,4 and 5 Ms Jones exhibits copies of selected lease agreements, photographs and a variety of documents or publications to demonstrate the operation of retail locations under the mark ROYAL DOULTON. Much of the exhibit is either undated or refers to circumstances either before or after the relevant periods, bears no reference to ROYAL DOULTON or is of such poor quality that I cannot make out what it might show and some is duplicated and, for this reason, I do not intend to summarise it in its entirety. There is, however:

- A review, dated 30 November 2008, taken from the Qype website. It refers to a Royal Doulton Outlet Store selling a range of tea sets, dinner ware, glassware and gifts. It does not identify exactly where this store is located (AMJ-2);
- A copy of a 3 year lease dated 12 October 2010 between WWRDUK and other parties. The lease relates to a property at the Braintree Outlet Village. Whilst the lease is dated (just) within the relevant period, I am given no details of if, and if so when, the property was occupied and used for trading purposes. There are also copies of leases which refer to properties in Manchester and Etruria which appear to be from 2004 but again I am given no further details of any use which might have been made of these properties (AMJ-2) ;
- A selection of pages taken from a number of UK phone books all dated 2006/2007. All list contact details for various Royal Doulton operations, some of which refer to the same location despite being listed in different books. The London Central listing is very poorly photocopied and the only reference I can make out is to Royal Doulton Hotel and Airline Division. Others refer to Royal Doulton Factory Shops (Stoke on Trent), Royal Doulton Factory Outlet

(Bridgend) and Outlet Village store (Ellesmere Port). Other entries refer to contact details for Royal Doulton at the House of Fraser (Lakeside) and David Evans (Swansea) stores (AMJ-2);

- A copy of Frommer's 2007 London Guide. A US publication, it provides information for those planning a trip to London. It refers to the Royal Doulton shop in Piccadilly as a store where one can buy china, crystal and giftware (AMJ-2);
- An extract from the southportvisitor.co.uk website dated 12 January 2009. The article reports on redundancies at Royal Doulton shops in Southport and Worthing (AMJ-2);
- Copy of an agreement between Harrods Ltd and WWRDUK along with associated letters. These relate to an agreement for a Royal Doulton concession within the Harrods store and confirms the continuance of the initial agreement (dated 30 August 1994) through to 2008 (AMJ-3).

14. Secondly, a witness statement from Shaun P Kelly is dated 5 April 2011. Mr Kelly states he has been the Licensing Manager of WWRDUK since December 2009. Between 1994 and April 2000 he was employed by Royal Doulton (UK) Ltd as Director of Licensing. Between September 2007 and December 2008 he was retained by them as an independent consultant to identify and secure licensing arrangements for the Royal Doulton brand. He confirms that WWRDUK is a related company to Holdings and WWRD and states that when Holdings bought Royal Doulton's assets in 2009, he was engaged by them in a similar capacity.

15. Mr Kelly states that the core business centres around ceramic tableware, however, during the period 2007 to 2009 it expanded to include cutlery, lighting, kitchen textiles, home fragrances and co-branded credit cards. In the late 1990s, Royal Doulton (UK) Ltd made efforts towards granting licenses to use the mark ROYAL DOULTON internationally in respect of foods and drinks and, in 2004, it granted a licence to The Essential Box Co Ltd of London ("Essential"). A copy of the licence is exhibited at SPK-1. It is dated 20 October 2004 and is signed by Royal Doulton (UK) Ltd as licensor and Essential as licensee. It grants Essential the non-exclusive right to use the mark ROYAL DOULTON solely in connection with the manufacture, distribution and sale of named articles and states that the licence is in force for the period 1 October 2004 to 31 December 2007 with the "product" to be on the market by Spring 2005. The agreement relates to the UK, Ireland, Australia, New Zealand, USA and Canada. Mr Kelly states that when the licence expired at the end of 2007, a one year agreement was entered into with Walkers Chocolates Ltd of Birmingham ("Walkers"). A copy of this licence is also exhibited at SPK-1 and shows it to have a commencement date of 1 January 2008. It relates to use of the trade marks ROYAL DOULTON and ROYAL ALBERT within the UK and elsewhere. Both licences cover a range of goods which includes some which would be included within the specification of goods of the registration under attack.

16. At SPK-2 Mr Kelly exhibits copies of what he calls 'product presentations' prepared by Walkers along with, at SPK-3 and 4 magnified images from these. They show various packaged sets containing articles of ceramic or glassware along with

various foodstuffs such as oils, mustards and jams. Mr Kelly says these documents date from 2009. This is after the date the licence with Walkers expired.

17. Mr Kelly states that it has been difficult to locate and verify detailed accounting records concerning the sale of the licensed goods because of marked changes in the structure of the business between 2008 and 2010 coupled with the conversion of company accounting data to a new accounting software system. At SPK-5, however, he exhibits a summary of the quantities of Royal Doulton combination sets reported by Essential to Royal Doulton (UK) Ltd as sales orders made by John Lewis in the UK. The exhibit consists of a single sheet containing two tables. The first is headed Quantities Ordered for Christmas 2006 (Units) and shows the number of 'units' ordered by John Lewis, UK. The table lists various sets, all of which are identified by the letters RA or RD (which, though not specified, I take to refer to goods sold under the marks Royal Albert or Royal Doulton which are the marks the subject of the licence). The list shows orders made by John Lewis UK of 2706 RD Jam & Marmalade sets, 2490 RD Olive Sets, 2010 RD Espresso sets.

18. At SPK-6, Mr Kelly exhibits what he says is an "historic" webpage screenshot showing sets sold by John Lewis. The first three pages bear no dates or other identifiers. The second page advertises a Royal Doulton Luxury Jam set (ceramic dishes plus small pots of jam and marmalade) at £15 and the third a Royal Doulton Espresso Coffee set (coffee cups and saucers with sachets of coffee) at £18. The remaining pages of the exhibit show them to have been downloaded on 5 April 2011, i.e. after the relevant period, and show the same products offered for sale at the same prices.

19. Exhibit SPK-7 to Mr Kelly's witness statement shows pictures of a Royal Doulton Gourmet conserve and marmalade set which bears a label and ribbon which have upon them the words Royal Doulton. Mr Kelly states these goods were sold by the Waitrose chain of supermarkets in the UK in the latter half of 2007 with between 2000 and 3000 sets having been sold.

20. At SPK-8, Mr Kelly exhibits what he says are quarterly Royalty Return Forms from Royal Doulton (UK) Ltd's business records and which cover the period 2006 to 2008. The first page of the exhibit is on Royal Doulton headed paper, refers to the quarter ended 30 September 2006 and indicates that it relates to Essential. It lists the licensed articles as being 01-10-04-06 (Royal Doulton) and 01-10-04-07 (Royal Albert). As for the Royal Doulton entry, whilst it shows a sales value of £67,379.55 and a royalty percentage value of £4042.77, it gives no indication of the particular goods to which these values relate.

21. The second page is headed 'invoice' and is on non-headed paper. Dated 29/1/2007, it is addressed to Essential and relates to royalties for the quarter ending December 2006. It indicates that it relates to royalties for the quarter ending December 2006 of some £6649.15 for 'Ceramic & Food Gift Sets' sold under the brand "RD/RA" but does not separate them by individual brand or give any indication of what foodstuff may have been included within the set.

22. The third page of the exhibit is again on non-headed paper. Entitled “inventory – Customer Sales” it shows the relevant period to be 01/10/06 to 31/12/06 and refers to Essential Box. The inventory lists a number of items which includes:

Customer No.	Name	Invoiced Quantity	Amount
C00074	John Lewis plc	2,490	18,724.80
	RD Olive-set	2,490	18,724.80
C00074	John Lewis plc	1,664	11,980.80
C00140	John Lewis & Co	-312	-2,248.40
	RD Espresso set	1,352	9,734.40
C00074	John Lewis plc	2,700	19,089.00
	RD Jam	2,700	19,089.00
	& Marmalade Set		

The list also includes other items such as oil drizzler sets.

23. Next, there is a Royalty Return Form on Royal Doulton Company headed paper and for the quarter ended 31 December 2006. The form shows that Royal Doulton licensed articles accounted for 12008 items sold to a value of £82363.20, which led to a realisation of royalty percentage value of £32620.45 @ 6% =1957.23 and 49742.75 @ 4%=1989.71. It does not specify the particular goods sold. Lastly, the exhibit has three pages which are headed ‘Invoice’. They are dated 11 December 2007, 18 March 2008 and 6 October 2008 respectively. Addressed to Essential (the first invoice) and Walkers (the other two invoices) they all relate to unspecified RD/RA ceramic and food gift sets. I note that the first invoice has a handwritten note on it indicating “cancelled Mar/08 covered by Walkers chocolates”.

24. Next is a witness statement of Olivia Lau dated 20 April 2011. Ms Lau states she is employed by WWRDUK and has been the manager of the Royal Doulton concession located in the Debenhams store in Oxford Street London since October 2007. She states that it operated within the Debenhams’ store for many years prior to that date and that over the years the concession has been positioned in various locations within the store. She states the concession moved to its ‘current’ location in August 2010. Ms Lau states that the concession ‘currently’ showcases a variety of ROYAL DOULTON products including dinner sets, glass stemware and figurines but that the products available to purchase change over time. That said, she indicates that the arrangement of the space and displays within the concession remain the same and, as now arranged, is largely unchanged from when she started in October 2007. Ms Lau’s evidence includes a number of exhibits:

- OL-1 consists of photographs showing the concession. The display area shows the words ROYAL DOULTON on signs placed on the fitments. The shelving and table areas display figurines, tableware, glassware and photograph frames
- OL-2 is a close-up photograph of a display stand displaying tableware and glassware

- OL-3 is a detailed photograph of part of a display stand which shows the words ROYAL DOULTON and lion's head device.

25. Lastly, there is a witness statement dated 20 April 2011 from Eduardo Gobbi who is the General Manager of the Waterford, Wedgwood and Royal Doulton concession located in the Harrods store in London. This is a position he has held since March 2010. He confirms the concession is operated by WWRDUK. Mr Gobbi states he was previously employed by Harrods as a floor manager for three years from 2007 and that the floor he managed contained seventy concessions including that of Royal Doulton which had been located there for many years prior to that time. He states he is aware that there was an entire room dedicated to Royal Doulton products, though he does not specify what these products were.

26. Mr Gobbi exhibits a number of photographs. These are:

- EG-1: three photographs of the current concession which was originally arranged in March 2010 and has remained the same ever since. They show displays of glassware, cutlery and tableware. I cannot make out any reference to ROYAL DOULTON but am able to see the words Albert (second photograph) and Wedgwood (third photograph)
- EG-2: Photographs of the products 'currently' on display. Again they show tableware and cutlery. A box containing cutlery shows the words ROYAL DOULTON
- EG-3: Photographs of signs showing the entrance to one of the rooms within the concession. The signage above the doorway reads:

WATERFORD CRYSTAL · WEDGWOOD · ROYAL DOULTON.

27. That concludes my summary of the evidence to the extent I consider it necessary.

The authorities on genuine use

28. The leading authorities on the principles to be applied in determining whether there has been genuine use of a trade mark are: *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. The general principles were summarised by the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd (Sant Ambroeus Trade Mark)* [2010] RPC 28 as follows:

“(1) Genuine use means actual use of the mark by the proprietor or 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].”

29. In relation to determining what constitutes a fair specification, I must keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of

allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

30. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on

the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

31. Finally, the following comments of the Court of First Instance in *Reckitt Benckiser (España), SL v OHIM*, Case T- 126/03 are also relevant:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

32. In its written submissions, Piasten refer to the fact that some of the evidence does not show the words ROYAL DOULTON alone but rather show it in conjunction with a lion’s head device. It submits that such use is not use of the mark as registered, nor is it use of the mark in a form differing in elements which does not alter the distinctive character of the trade mark. For its part, WWRD submit that “whether other device elements may be used adjacent to the Trade Mark does not alter the distinctive element of the ROYAL DOULTON Trade Mark in the specific circumstances of how the ROYAL DOULTON Trade Mark is used”.

33. Where the evidence shows the lion’s head device, it appears either above and separate from the words ROYAL DOULTON (e.g. on labels within boxed gift sets) or is used as a method of separating the words ROYAL DOULTON appearing many times along a piece of ribbon. Wherever it appears, its size is small and is not disproportionate in relation to the words ROYAL DOULTON. In line with the

guidance in *Esber, SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-353/07, I find that the use of the lion's head device does not alter the distinctive character of the mark ROYAL DOULTON. I go on to consider the evidence of use of the mark.

Use in relation to the goods in classes 29 and 30

34. For ease of reference, the goods to be considered are:

Class 29

Jellies, jams, marmalades, processed fruits and vegetables, preserved, dried and cooked fruits and vegetables, fruit sauces

Class 30

Tea, coffee, cocoa, coffee beans, bread, biscuits, pastry, cakes, confectionery, sweets, chocolate, honey and sauces

35. The primary evidence of use in relation to the disputed goods covered by the registration is provided by Mr Kelly. He has not provided any details of e.g. turnover or advertising costs or even an estimate of them but has explained there have been difficulties in collating information due to the restructuring of the business coupled with computer and other record changes. Despite these difficulties, he has provided a number of documents intended to show the sale of goods under the trade mark.

36. Mr Kelly's evidence indicates that predecessors in business to WWRD entered into licences for the manufacture and sale of various packaged sets containing items of either ceramic or glassware in conjunction with various foodstuffs. As indicated above, within the evidence there are multiple references to foodstuffs which are not covered by the specification of goods under consideration (e.g. oils and mustards). At SPK-1, he exhibits a copy of a licence with Essential which he states was in force between 1 October 2004 and 31 December 2007. Another licence, with Walkers, extended to the end of December 2008. He lists the various products to be licensed, a list which includes a wide range of goods, but only some of which could be included within the specification of the registration. These include e.g. 'Jam, biscuit and tea selection', 'three jam selection', 'filled mug-tea' and 'filled mug-coffee' amongst others. The existence of a licence does not mean of itself, of course, that the goods listed under it were produced and sold.

37. At SPK-2 Mr Kelly has exhibited pictures taken from "product presentations" dated 2009 produced by Walkers which shows a number of products as packaged goods. No explanation is given of what these presentations were intended to be. One picture shows what appears to be a Walkers product and other pages include a contact number for Essential but the exhibit is dated 2009, which is after the expiry of each of the licences with these companies. No explanation is provided as to the purpose of these documents but given the expiry date of the licence with Walkers it seems likely this is material prepared for internal use which, pursuant to the decision in *Ansul* cannot count towards maintaining a registration.

38. Other material does show some evidence of sales. At SPK-5, Mr Kelly gives details of sales orders said to be made by John Lewis for Christmas 2006 for sets

containing jam and marmalade, preserved olives and coffee. This information appears to be supported by documents included within SPK-8 (3rd page). At SPK-7 he exhibits pictures which he states show examples of goods sold in the latter half of the following year (2007). He states that there were sales of between 2000 and 3000 Royal Doulton Gourmet conserve and marmalade sets.

39. The first page of SPK-8 to Mr Kelly's witness statement shows that sales of goods were made under the mark but, crucially, this evidence does not specify which particular goods were sold so I cannot establish whether these sales relate to goods covered by the registration (other evidence, for example, refers to sales of oil drizzler sets which goods would not be included within the specification of the registration). Other evidence, within the same exhibit, gives details of royalties paid for 'Ceramic and food gift sets' sold under the licence but the evidence refers to such royalties as relating to both Royal Doulton and Royal Albert marks as a single figure and therefore I am unable to determine how much, if any, of these royalties relate to sales for goods under the Royal Doulton mark. Even if I could determine this, the actual foods the gift sets contain are not specified.

40. The evidence of use filed is not particularly extensive and shows minimal sales of a small range of goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* the GC stated:

"32 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a share in the market for the goods or services protected by the mark (*VITAFRUIT*, paragraph 27 above, paragraph 42, and *LA MER*, paragraph 26 above, paragraph 57; see, by analogy, *Ansul*, paragraph 24 above, paragraph 39, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21)."

41. There is, therefore, no de minimis level of use to establish genuine use (also see inter alia *Sonia Rykiel création et diffusion de modèles v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-131/06* and *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-416/04 P*). In *Ajax Brandbeveiliging BV v Ansul BV Case C-40/01* the Court of Justice of the European Union (CJEU) held that it is necessary to establish whether the use "is viewed as warranted in the economic sector

concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark". In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-234/06 P* the CJEU stated:

"73 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider v OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22)."

42. The evidence of use filed is far from extensive or detailed. But there is evidence from Mr Kelly that a number of sets containing foodstuffs were sold during the slightly more than two year period beginning October 2006 and ending at late 2008. There is some, very limited evidence that a number of sets combining ceramic wares with items of food have been sold through John Lewis and Waitrose and those sets included within them goods which are covered by the specification of the registration, being jam, marmalade, preserved olives and coffee. I have no evidence of the size of these markets however they are everyday items consumed by vast numbers of persons on a regular basis. They are goods which are readily available. The relevant markets are likely to be enormous. But there are many producers of such goods, some of whom will be small traders. Mr Kelly states that between 2000 and 3000 sets containing each of these goods were sold in the latter months of 2006 through John Lewis with a similar number of sets containing jam being sold the following year through Waitrose. Given his position within the company at that time, he would be well placed to know this information and it is certainly not incredible. Indeed his statement is supported to some extent by the historical screenshots at SPK-6 which shows the mark on relevant goods and by the royalty details provided at SPK-8. The amount of use is small but, as Mr Kelly states, the then proprietor was seeking to expand its product range into new areas of business. The use is not token or sham. Taking all the evidence together, I am satisfied that the proprietor did make genuine use of the mark during the relevant period.

43. Whilst I accept that genuine use has been made of the mark, such use has not been established in relation to every type of food listed in the specification for the mark. In reaching a fair description for the goods for which genuine use has been shown, and which fall within the parameters of the specification, I must not be over-precise and must keep in mind how the relevant public, which for these goods would be the public at large, would describe the goods. Jams (class 29), marmalade (class 29) and coffee (class 30) are discrete items within the specification. Use has also been shown on preserved olives. This is not a discrete term within the specification but such goods would be included within the term *preserved fruits*. The evidence of use does not support the retention of such a broad term. Olives are a recognised, and somewhat specialised category of fruit. In my view, the appropriate specification of goods is *preserved olives*.

Use in relation to the services in class 35

44. For ease of reference, the disputed services set out in class 35 are:

The bringing together, for the benefit of others, of a variety of goods enabling customers to view and purchase those goods in a department store or a wholesale outlet.

45. Ms Jones' evidence at AMJ-3 shows that the lease for the Royal Doulton concession within Harrods was extant at least between August 1994 and 2008. Evidence of the existence of a lease for a concession within a store does not, of itself, prove the concession actually operated, however, evidence from Mr Gobbi states he has been the General Manager of the Royal Doulton concession within Harrods since March 2010 (i.e. within the period applicable under section 46(1)(b)). He states that from 2007 he managed the floor on which the concessions operated and that the Royal Doulton concession operated there before that time. For her part, Olivia Lau confirms she has been the manager of a similar concession at the Debenhams store in London since October 2007 (again within the period applicable under section 46(1)(b)). There are also extracts exhibited at AMJ-2 to Ms Jones' evidence which report redundancies of staff in January 2009 from the Royal Doulton shops in Southport and Worthing. When taking the evidence as a whole, I have no hesitation in finding that it shows that these concessions and shops did operate within the relevant period.

46. Whilst the services the subject of the application for revocation relate to the bringing together of a variety of goods, the goods themselves have not been specified to any degree. Whilst there is evidence that a number of retail and factory outlet premises have operated at various times, there is little or no evidence of what may have been sold from most of these premises. Mr Gobbi states that Royal Doulton 'products' were sold at the Harrod's concession but does not specify which products these were. But he exhibits photographs showing how the concession was arranged within, and since, the relevant period and which indicates that glassware, tableware and cutlery were offered for sale in this store. Ms Lau also exhibits photographs which show the Debenham's concession which, she says, has been largely unchanged since October 2007. They show china figurines, tableware, glassware and photograph frames being offered for sale.

47. In *Praktiker Bau- und Heimwerkermärkte AG v Deutsches Patent- und Markenamt* Case C-418/02, the CJEU stated:

"2. For the purposes of registration of a trade mark for such services, it is not necessary to specify in detail the service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate."

48. On the basis of the evidence before me it is clear that the goods offered for sale under the mark in the concessions are the company's core products i.e. ceramic tableware but that it has also offered for sale at (at least some of) these locations ceramic figurines, glassware, cutlery and photograph frames. There is no evidence of any other products having been offered for sale through these outlets. This is a

broad range of goods which are not easily put into a single, meaningful category but instead are items which are themselves separate, identifiable goods. In my view, a reasonable and fair way to describe the use made of the trade mark in relation to the services concerned is: The bringing together, for the benefit of others, of a variety of ceramic tableware and figurines, glassware, cutlery and photograph frames enabling customers to view and purchase those goods in a department store or a wholesale outlet.

49. In summary, the registration is to be revoked under section 46(1)(a) of the Act with effect from 20 July 2007 to the extent that it is reduced to:

Class 29

Jams, marmalades, preserved olives.

Class 30

Coffee

Class 35

The bringing together, for the benefit of others, of a variety of ceramic tableware and figurines, glassware, cutlery and photograph frames enabling customers to view and purchase those goods in a department store or a wholesale outlet.

Costs

50. Both parties have achieved a measure of success and I consider that each should bear its own costs.

Dated this 21st day of February 2012

**Ann Corbett
For the Registrar
The Comptroller-General**