

BL O-135-20

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION NO. 502414

TO REVOKE ON THE GROUNDS OF NON-USE

TRADE MARK REGISTRATION

NO. 3021082

OF THE MARK:

ASPAVA

OWNED BY

DENIZ KONCA

Background

1. These proceedings concern the trade mark **ASPAVA** which was filed on 6 September 2013 and entered in the register on 6 December 2013. The trade mark is registered in class 43 in the name of Deniz Konca (“the proprietor”) in respect of the following services:

Bar services; Bistro services; Cafe services; Cafés; Canteen services; Canteens; Carvery restaurant services; Catering (Food and drink -); Catering for the provision of food and beverages; Catering of food and drinks; Catering services; Catering services for the provision of food; Catering services for the provision of food and drink; Cocktail lounge services; Coffee shop services; Coffee shops; Fast food restaurant services; Fast-food restaurants; food takeaway service; Provision of food and drink; Public house services; Pubs; Restaurant services; Restaurants; Restaurants (Self-service -); Self-service restaurants; Snack-bars; Tea rooms; Wine bars.

2. On 3 January 2019, Tracy Wilson-Durmus and M Durmus (“the applicants”) applied for the revocation in full of the above trade mark, relying upon section 46(1)(a) of the Trade Marks Act 1994 (“the Act”). Under this section, “the relevant period” is 7 December 2013 to 6 December 2018 (with revocation sought from 7 December 2018). In their application, the applicants state:

“The company (Aspava Ltd) – No. 08710401 – Companies House, never traded and was dissolved on 6.5.14 (Form DS01 on 17.12.13) and struck off the register on 21.1.14. We feel this is a ground for non-use.”

3. The proprietor filed a counterstatement in which he indicates he is defending the application in respect of “Restaurant” and “Catering services.” He states:

“I previously registered my trade mark "Aspava" for my intended catering business on 6th September 2013 and incorporated a company "Aspava Limited" on 30th September 2013. I then proceeded with the purchase of a 20-year lease for a restaurant "Aspava," addressed 421 GREEN LANES, GROUND

FLOOR SHOP, LONDON, UNITED KINGDOM, N4 1EY. Unfortunately, after several months of negotiations the deal fell through and I dissolved my company "Aspava Ltd" on 6th May 2014. Since then I have been searching for a suitable premise for opening a restaurant and have tried to purchase other leases over the past years.

I have dealt with "Goldman Stanley" law office and you can contact them if you have further questions about the above dates and my further lease negotiations for restaurant spaces to the date of this email.

Upon learning that my trade mark was being used last year, I contacted the party who wants to challenge and revoke my trademark. I asked said party to consider changing their brand name as it would cause a conflict once my restaurant opens. I made it clear that I am in the process of searching for a suitable premise for my restaurant.

I have several trademarks already registered and I am using all of them under my company "Konca Limited." I am not registering trademarks and just parking them. They (who are challenging my registered trademark) have been operating for a very long time, and have been using my trademark without having properly researched the trademark database before opening their restaurant. It's very disappointing that they have ignored all of my calls and waited for 5 years to pass to make an application for revoking my trademark.

I have recently registered a domain name and am currently building www.aspavacatering.co.uk to provide catering services for events. I expect my website to be operational in April 2019 and I will be operating under my other company "Konca Ltd," which has been active since 08th July 2011. I'm also going to be naming my restaurant "Aspava" and use my trade mark "Aspava" once I find a suitable new shop.

Considering my traceable efforts to use the "Aspava" trademark in the past few years and taking it on line within a few months, I believe that I have the right to maintain ownership of my trademark."

4. In these proceedings both parties are unrepresented. Although only the proprietor filed evidence, the applicants filed written submissions during the evidence rounds. Neither party asked to be heard nor did they elect to file written submissions in lieu.

Legislation and leading case-law relating to revocation

5. The pertinent legislation is contained in section 46 of the Act, the relevant parts of which read:

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

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

(b)...

(c)...

(d)...

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that

paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

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

(4)

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

6. Section 100 is also relevant; it reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

7. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: *Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV*

[2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant

goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

The proprietor’s evidence

8. This consists of three witness statements. The first, is from the proprietor, Mr Konca. He explains that “[his] restaurant was still under construction back in August 2014...”. Exhibit DK1 consists of an image from August 2014 which Mr Konca explains was taken “from official Google Street view car” at which time Mr Konca was, he further explains, “waiting for the lease exchange to open my restaurant (421 Greens Lane).” A larger version of this image is provided as exhibit DK5. Above a typical retail unit on the high street there appears a temporary sign reading “ASPAVA RESTAURANT OPENING SOON.”

9. Exhibit DK2 consists of a certificate of incorporation of company no. 8710401 ASPAVA LIMITED which was incorporated on 30 September 2013. I note that in his counterstatement Mr Konca explains that this company was dissolved on 6 May 2014.

10. Exhibit DK3 consists of what Mr Konca explains is a “floor plan of the shop that I was in the process of leasing.” Although the floor plan contains a reference to “421 Green Lanes” and “Restaurant”, it is undated and makes no reference to ASPAVA.

11. Exhibit DK4 consists of an email exchange dated 25 September 2013 between Mr Konca and “the landlady regarding the purchase of the lease”. I note the exchanges include the following: “...we need to make the quarterly installment tomorrow for our new restaurant Aspava”, “...we would need a few days to open our new business account for the restaurant...” and “...the works are finally starting this week. We have agreed with a team of builders...”.

12. The second statement is from Nil Akbas. Ms Akbas explains that her company, NDesign, “designed a logo, sign and menu for Aspava restaurant...”. A copy of the logo Ms Akbas’ company designed, provided as exhibit NA1, is shown below:



13. A copy of the email sent to Mr Konca which accompanied that logo, dated 1 October 2013, is provided as exhibit NA2. It contains four logos in PDF format, one of which is the same as that shown above and one, which although partially obscured, also contains the word ASPAVA.

14. The final statement comes from David Jablonka. Mr Jablonka is, he states, “an independent freelancer.” He explains that on 13 September 2013 he helped prepare a business plan for Mr Konca “for his proposed restaurant named Aspava, located in 421 Greens Lane N4 1EY.” That business plan included “financial planning, SWOT analysis, market analysis and operation plan.” The plan was, he explains, completed within 3 weeks and delivered to Mr Konca.

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

Decision

16. I begin by reminding myself of the relevant period in play in these proceedings i.e. 7 December 2013 to 6 December 2018. In their submissions, the applicants argue that within the relevant period Mr Konca has neither shown genuine use of his trade mark nor has he given any proper reasons for non-use.

Chronology of events

6 September 2013 – trade mark application for ASPAVA filed;

13 September 2013 – Mr Jablonka helps prepare a business plan for Mr Konca;

25 September 2013 – email exchange regarding the purchase of a lease, building work on the restaurant set to commence;

30 September 2013 – ASPAVA LIMITED incorporated;

1 October 2013 – Ms Akbas sends Mr Konca proposals for, inter alia, a logo;

6 December 2013 – ASPAVA trade mark registered;

6 May 2014 – ASPAVA LIMITED dissolved having never traded;

August 2014 – ASPAVA trade mark appears on a temporary sign on a building indicating that it is “opening soon”;

Mr Konca has “recently” registered a domain name and is “currently” building www.aspavacatering.co.uk which is “expected” to be operational in April 2019.

17. On the basis of the information provided in the counterstatement and evidence, there is, in my view, nothing to suggest that within the relevant period Mr Konca has made genuine use of his ASPAVA trade mark. Rather, in his counterstatement, he states:

“Unfortunately, after several months of negotiations the deal fell through...Since then I have been searching for a suitable premise for opening a restaurant and have tried to purchase other leases over the past years....”

18. That, in my view, is a reliance on what Mr Konca regards as proper reasons for non-use, the correct approach to which was outlined by the European Court of Justice in *Armin Häupl v Lidl Stiftung & Co. KG*, Case C-246/05, when the court held that:

“52. In particular, as correctly stated by the Advocate General in [79] of his Opinion, it does not suffice that “bureaucratic obstacles”, such as those pleaded in the main proceedings, are beyond the control the trade mark proprietor, since those obstacles must, moreover, have a direct relationship with the mark, so much so that its use depends on the successful completion of the administrative action concerned.

53. It must be pointed out, however, that the obstacle concerned need not necessarily make the use of the trade mark impossible in order to be regarded as having a sufficiently direct relationship with the trade mark, since that may also be the case where it makes its use unreasonable. If an obstacle is such as to jeopardise seriously the appropriate use of the mark, its proprietor cannot reasonably be required to use it nonetheless. Thus, for example, the proprietor of a trade mark cannot reasonably be required to sell its goods in the sales outlets of its competitors. In such cases, it does not appear reasonable to require the proprietor of a trade mark to change its corporate strategy in order to make the use of that mark nonetheless possible.

54. It follows 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. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable. It is the task of the national court or tribunal, before which the dispute in the main proceedings is brought and which alone is in a position to

establish the relevant facts, to apply that assessment in the context of the present action.

55. Having regard to the foregoing considerations, the answer to the second Proper question referred for a preliminary ruling must be that Art.12(1) of the Directive must be interpreted as meaning that obstacles having a direct relationship with a trade mark which make its use impossible or unreasonable and which are independent of the will of the proprietor of that mark constitute “proper reasons for non-use” of the mark. It is for the national court or tribunal to assess the facts in the main proceedings in the light of that guidance.”

19. While the evidence shows that having applied for his ASPAVA trade mark in September 2013 Mr Konca took a number of initial steps to begin using it, he was unable to do so because lease negotiations were unsuccessful. In the years that followed he has, he states, been searching for a suitable property but attempts to purchase other leases have been unsuccessful. Although Mr Konca explains that the law firm of Goldman Stanley can provide more information in relation to these dates, had he wished to rely upon such evidence the onus was on him to provide it.

20. In *Cernivet Trade Mark* [2002] RPC 30, the Appointed Person explained that proper reasons for non-use must have been operative during the relevant period. Bearing that in mind, the references to “recently” registering a domain name and “currently” building a website mentioned in Mr Konca’s counterstatement signed by him on 11 March 2019 are unlikely to assist him, as they are likely to have taken place after the relevant period expired in December 2018.

21. The five year period following registration is a generous one in which to put a trade mark into use. Although the property at Greens Lane still bore the temporary sign mentioned above in August 2014, having taken the initial steps mentioned earlier in September and October 2013, no evidence has been provided of any actions taken by Mr Konca after Aspava Limited was dissolved in May 2014 i.e. a little over four and a half years before the relevant period expired. On the basis of the evidence provided, the circumstances described by Mr Konca do not, in my view, constitute proper

reasons for non-use, the consequence of which is that the application for revocation succeeds in full.

Conclusion

22. The application for revocation has succeeded and, subject to any successful appeal, the proprietor's trade mark will be revoked with effect from 7 December 2018.

Costs

23. As the applicants have been successful, they are, in principle, entitled to a contribution towards their costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. In an official letter to the applicants dated 4 December 2019, the tribunal stated:

"If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party...

If there is to be a "decision from the papers" this should be provided by 2 January 2020.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action, (excluding extensions of time), may not be awarded..."

24. The applicants did not respond to that invitation either by the deadline set or by the date of the issuing of this decision. As the only official fee they have incurred is in relation to the filing of their application i.e. £200, that is the only costs to which they are entitled.

25. I order Deniz Konca to pay to Tracy Wilson-Durmus and M Durmus (jointly) the sum of **£200**. This sum is to be paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 4th March 2020

C J BOWEN

For the Registrar,

The Comptroller-General