

O-144-10

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION
BY EURO GIDA SANAYI VE TICARET LIMITED SIRKETI
TO REVOKE REGISTRATION NO 2252920
IN THE NAME OF GIMA (UK) LIMITED

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by EURO GIDA SANAYI VE TICARET LIMITED SIRKETI
to revoke registration No. 2252920
in the name of GIMA (UK) LIMITED

Background and evidence

1. Trade Mark No. 2252920 is for the mark “Melis” which is registered for the following goods:

Class 29

Meat, fish, poultry and game, preserved, pickled, dried and cooked fruits, vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, cheese, edible oils and fats, salami and sausages, soup powder.

Class 30

Rice, bulgur, sago, tapioca, artificial coffee, tea, cocoa, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces, spices and ice, and pasta.

Class 31

Agricultural, horticultural and forestry products and grains, fresh fruit and vegetables, seeds, natural flowers and nuts.

Class 32

Mineral and aerated waters and others non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages.

2. The registration stands in the name of Gima (UK) Limited (“Gima”) and the registration procedure was completed on 11 May 2001.

3. By an application dated 11 August 2008, EURO GIDA SANAYI VE TICARET LIMITED SIRKETI (“Euro”) applied for the registration to be revoked under grounds founded on section 46(1)(a) and (b) of the Act. In brief, Euro claims that its investigations into the use of the mark leads it to conclude that the mark has not been put to genuine use in relation to the goods for which it is registered with the exception of “combi cheeses, chicken salami, chicken sausage, salami beef and sausage beef”. Whilst Euro accept that the mark may have been used in relation to these limited goods, it indicates that it is not aware of the extent of any such use and thus puts Gima to proof in respect of all goods.

4. Gima filed a counterstatement in which it said that it had been “selling that brand now over years” and was “still active selling this brand/product”. Attached to the counterstatement are a number of printouts which Gima says is proof of its use of the mark. There is a single page which is said to be a printout of the company’s catalogue. It does not, as far as I can see, bear any date but it does list a number of beef and chicken sausage and salami products which bear the Melis mark. The remaining ten pages all show pictures of numerous cardboard boxes. These are said

to be "pictures of MELIS products in our cold room from the 03/09/2008". As well as showing the cardboard boxes, these latter printouts each show one or more packets. Whilst it is not possible for me to see in some of the printouts what these packets contain, others (some of which appear to be duplicates) show them to be various beef and/or chicken-based sausages and salamis.

5. Gima later filed a witness statement from Ismail Gun dated 22 July 2009. Mr Gun states that he has been General Manager of the company since March 2008. He states that the mark MELIS was first used in the UK by Gima in 2000 when it was used in relation to various types of sausages and salamis. Since 2005 it has been used in relation to various types of cheese. Mr Gun further claims there are plans to trade in pickled products but he gives no further details of these plans.

6. Mr Gun gives the following details of sales made under the mark:

| | |
|-------------------------|---------------------|
| Dates 1/5/2008-6/5/2009 | Amount (£'s) 266056 |
|-------------------------|---------------------|

Sales are said to have been made throughout the UK. Mr Gun states that during this period some £5000 was spent on promoting the goods though no details are provided to show what promotion took place.

7. Attached to Mr Gun's witness statement are 14 exhibits:

1. A picture of beef sausages with the mark MELIS visible on the packets;
2. A close up of the above;
3. A picture of chicken sausages with the mark MELIS mark visible on the packets;
4. A picture of "chicken sausage with beef" again showing the MELIS mark;
5. A picture of what is said to be chicken salamis and their boxes showing the MELIS mark;
6. As 5;
7. A picture said to be a pallet of "chicken twin salami". It does not show the mark;
8. A picture of a box bearing a label "MELIS 50+ Combi White"
9. A picture of a label for "MELIS Combi White";
10. A picture of "MELIS Combi White";
11. What is said to be a poster of MELIS products as displayed in the company's warehouse;
12. As 11;
13. An advertising flyer for GIMA's products which is said to include MELIS sausages;
14. What is said to be a list of sales figures " to Supermarkets, Off License and Bestway Cash& Carry from 2008 and 2009".

8. No further evidence was filed in these proceedings. Neither party requested to be heard but Euro filed written submissions in lieu of a hearing. I give this decision after a careful review of all material before me.

The Law

9. The application for revocation is based on sections 46(1)(a) & 46(1)(b) of the Act. Euro seeks revocation with effect from either 12 May 2006 (section 46(1)(a)) or from 11 August 2008 (section 46(1)(b)). The relevant periods are:

Section 46(1)(a) – The registration procedure for Gima’s mark was completed on 11 May 2001. Therefore, the five year period begins on 12 May 2001 and ends on 11 May 2006. Revocation would take effect (if the application succeeds) from 12 May 2006.

Section 46(1)(b) – Revocation is sought with effect from 11 August 2008. Therefore, the five year period begins on 11 August 2003 and ends on 10 August 2008.

10. The relevant parts of section 46 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.”

11. 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.”

The leading authorities

12. The leading authorities on the principles to be applied in determining whether there has been genuine use of a mark are the judgments of the European Court of Justice (“ECJ”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks* [2006] F.S.R. 5 (“*La Mer*”). From these judgments, the following points are of particular importance:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*La Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*La Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*La Mer*, paragraph 44).

13. Gima's evidence, as detailed above, is not extensive. Except to the extent that some of the photographs of products show sell-by dates printed on some of the packets (all of which post date the relevant periods) none of the exhibits are dated though some of the photographs are said to have been taken in September 2008 and are therefore from outside the relevant periods. Gima has provided some details of its turnover and advertising spend but none of the figures given relate to the period relevant to my consideration under section 46(1)(a). And whilst the figures given cover a period which encompasses the latter three months of the period relevant to my consideration under section 46(1)(b), I am not able to break them down in such a way that would allow me to determine how much, if any, sales were made during this period nor the goods to which they relate.

14. Despite these shortcomings, Gima gives evidence, through Mr Gun, of use of the mark on sausages and salamis since 2000 and on white cheese since 2005 and claims that this trade is ongoing. Furthermore, Euro confirms in its written submissions that the use of the mark on beef sausage, chicken sausage, beef salami, chicken salami and white cheese "is not contended by the Applicant". So, notwithstanding that I do not know the exact scale of the use, it is clear that there has been use which has created and preserved a market share and I find that there has been genuine use in relation to these goods at the dates claimed.

15. Having found that there has been genuine use, I am left to consider what would be a fair specification to reflect the use which has been shown. In determining this, I take into account the helpful guidance provided in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, where Aldous LJ stated:

"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 the 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”.

16. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“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 pernickety 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 these has only been use for three-holed 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.”

17. Gima’s mark is registered for goods in classes 29, 30, 31 and 32 as set out in paragraph 1 above. The registration in class 29 includes cheese, salami and sausages. Whilst the evidence shows that Gima has used the mark in relation to beef sausages, beef salamis, chicken sausages, chicken salamis and white or “combi” cheese, I do not propose such a pernickety specification. In my view, cheese, salami and sausages is how the consumer would perceive the goods and is a perfectly reasonable specification for the use shown.

18. The application for revocation is partially successful. Gima’s registration is hereby revoked under the provisions of section 46(6)(b) of the Act with effect from 12 May 2006 for all goods other than:

Class 29: Cheese, salami and sausages.

Costs

19. As both sides have achieved a measure of success, I do not propose to favour either with an award of costs.

Dated this 11 day of May 2010

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