

# O-158-17

## TRADE MARKS ACT 1994

**IN THE MATTER OF  
REGISTRATION Nos. 1180215, 1379187, 2177779A, 2177779B & 2505233  
STANDING IN THE NAME OF BENTLEY 1962 LIMITED**

**AND IN THE MATTER OF CONSOLIDATED  
REVOCATION APPLICATIONS Nos. 500871, 500872, 500873, 500874 & 500875  
BY BENTLEY MOTORS LIMITED**

**AND IN THE MATTER OF  
AN APPEAL TO THE APPOINTED PERSON BY THE APPLICANT  
AGAINST A DECISION OF MR G W SALTHOUSE DATED 3 AUGUST 2016**

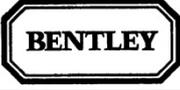
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### DECISION

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#### Background

1. On 4 June 2015, Bentley Motors Limited (“the Applicant”) made 5 x applications to cancel for non-use under Section 46(1) of the Trade Marks Act 1994, the following 5 x UK trade mark registrations standing in the name of Bentley 1962 Limited (“the Proprietor”) :

Mark	Registration No.	Class
	1180215	25
	1379187	25
BENTLEY 	2177779A (series of 2)	25
	2177779B	25
BENTLEY	2505233	25

2. In Notices of defence and counterstatements filed on 14 August 2015, the Proprietor contended that the marks in suit had genuinely been used in the alleged non-use periods.
3. Both sides filed evidence, and attended an oral hearing before Mr. G W Salthouse, the Hearing Officer acting for the Registrar, which took place on 8 June 2016.
4. The Hearing Officer made the following findings in his written decision issued on 3 August 2016 (BL O/369/16), in brief:
  - (1) The Proprietor had succeeded in showing genuine use of Registration number 2505233 for the word mark BENTLEY in the relevant Section 46(1)(a) period in relation to: *Clothing; headgear*. The Hearing Officer put to the Applicant at the oral hearing that the Proprietor's evidence of use in this regard was "simply overwhelming", from which the Applicant did not dissent. In fact, the Applicant withdrew its cancellation action against this registration for clothing and headgear (but not footwear). Instead the Applicant filed an invalidity action against Registration number 2505233 (which I understand is ongoing).
  - (2) No use had been made by the Proprietor in the relevant Section 46(1)(a) period of the word mark BENTLEY for footwear. The Proprietor accepted that its registration would need to be amended accordingly.
  - (3) There had been genuine use by the Proprietor in the relevant Section 46(1)(b) period of the first mark in the series of 2 x trade marks (i.e., the word BENTLEY) in Registration number 2177779A for certain of the goods in that registration, namely: *Clothing; headgear; articles of knitted clothing; knitwear, jumpers, pullovers, cardigans, sweaters, shirts, sweatshirts, T-shirts, polo shirts, coats, jackets, top coats, overcoats, raincoats, car coats, waistcoats, blousons, articles of clothing for casual wear, shorts, articles of sports clothing, blouses, hats, caps, scarves, gloves, anoraks*. No specific use had been shown on the other items listed in that registration, which would be deleted.
  - (4) No use had been shown by the Proprietor of the trade mark in Registration number 1180215 in the form in which it was registered. The Applicant labelled this mark "the lozenge mark", which despite its perceived inappropriateness as a descriptor (Transcript, p. 4), was used by the Hearing Officer to refer to the mark in his decision.
  - (5) Nevertheless, use by the Proprietor of the word mark BENTLEY sufficed to maintain Registration number 1180215, because this was 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" within the meaning of Section 46(2) of the Act. The registration would be maintained in its entirety for: *Articles of knitted clothing; shirts and waistcoats*.

- (6) Likewise, use of the word mark BENTLEY was use of an acceptable variant under Section 46(2) for the purposes of maintaining the second mark in series Registration number 2177779A for the goods listed at paragraph 4(3) above.
- (7) No use had been shown in the relevant Section 46(1)(b) period of Registration numbers 1379187 and 2177779B, which would be revoked from the effective date.
- (8) No proper reasons for non-use (where applicable) were established by the Proprietor in relation to its marks in suit.
- (9) There would be no costs award since both parties had enjoyed a measure of success.

### **The appeal**

5. On 30 August 2016, the Applicant filed Notice of appeal to the Appointed Person under Section 76 of the Act against the Hearing Officer's findings 4(5) and 4(6) above, namely that use of the word mark BENTLEY constituted acceptable variant use of the so-called "lozenge" marks in Registration numbers 1180215 and 2177779A within the meaning of Section 46(2) of the Act.
6. The Proprietor duly filed a Respondent's notice dated 18 November 2016, which in the main contained the Proprietor's arguments in response to the Applicant's contentions in its Statement of grounds of appeal. However, the Proprietor also put forward the alternative submission that the Hearing Officer should in any event have held that genuine use of the "lozenge" marks was established in the relevant period on the evidence that the Proprietor had filed (Respondent's notice, paras. 22 – 25).
7. At the appeal hearing (as before the Hearing Officer), the Applicant was represented by Ms. Charlotte Scott of Counsel instructed by Eversheds LLP. The Proprietor was represented by Mr. Christopher Lees with Mr. Robert Lees in attendance, Directors of the Proprietor.

### **Standard of review**

8. As Robert Walker LJ made clear in *REEF Trade Mark* [2002] EWCA Civ 763, at paragraphs 17 – 29, since this appeal is by way of review, not rehearing, I should be reluctant to interfere with the Hearing Officer's decision in the absence of material error. Moreover:

“The appellate court should not treat a judgment or written decision 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 the recent judgment of this court in *English v Emery Reimbold & Strick Ltd* (and two other appeals heard with it) [2002] EWCA Civ 605, 30 April 2002, para 19:

“ ... the judgment must enable the appellate court to understand why the Judge reached his decision. This does not mean that every factor which weighed with the Judge in his appraisal of the evidence has to

be identified and explained. But the issues the resolution of which were vital to the Judge's conclusion should be identified and the manner in which he resolved them explained. It is not possible to provide a template for this process. It need not involve a lengthy judgment. It does require the Judge to identify and record those matters which were critical to his decision."

9. Ms. Scott referred me to the recent summary of principles (including the above) from the case law on the appellate function, set out by Mr. Daniel Alexander QC sitting as the Appointed Person in *TALK FOR WRITING Trade Mark*, BL O/017/17, which I have borne in mind.

### **Grounds of appeal**

10. The main ground of appeal was that the Hearing Officer erred in finding that use of the word BENTLEY was use of the "lozenge" marks in Registration numbers 1180215 and 2177779A in a form which did not alter the distinctive character of the marks in the form in which they were registered pursuant to Section 46(2).
11. That main ground of appeal was said to split down into 3 x sub-grounds, as I understood them:
  - (a) The Hearing Officer failed to take into account the differences produced by the presentation of the word BENTLEY in serif font and bold in the "lozenge" marks.
  - (b) The Hearing Officer failed to identify the average consumer of the registered goods, or address the matter through his or her perspective, when assessing the distinctive character of the "lozenge" marks.
  - (c) The Hearing Officer failed to take into account that the purchase of clothing was primarily a visual act.
12. In the result, the Applicant contended that the Hearing Officer failed correctly to apply the test for assessment of an acceptable variant for the purposes of Section 46(2) set out by Mr. Richard Arnold QC sitting as the Appointed Person in *NIRVANA Trade Mark*, BL O/262/06 (emphasis indicated by the Applicant):

"33. ... The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period ...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

## **Section 46(2)**

13. Section 46(2) of the Act relevantly provides<sup>1</sup>:

“For the purposes of subsection (1) [whether genuine use has been established under Section 46(1)(a)/46(1)(b)] 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 ...”

14. The objective of Section 46(2): “... which by avoiding imposing a requirement for strict conformity between the form used in trade and the form in which the trade mark was registered, is to allow the proprietor of the mark, in the commercial exploitation of the sign, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned ” (Case C-252/12, *Specsavers International Healthcare Ltd v. Asda Stores Ltd*, EU:C:2013:497, para. 29, Case C-553/11, *Bernhard Rintisch v. Klaus Eder*, EU:C:2012:67, para. 21).

15. An authoritative set of questions to guide the tribunal’s enquiry under the first part of Section 46(2) was given in *NIRVANA*. However, the test itself is contained in the wording of the statute (*OAO “Alpha-Bank” v. Alpha Bank AE* [2011] EWHC 2021 (Ch), para. 12).

## **Serif font/bold**

16. A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14, ).

17. The serif font in which the word BENTLEY is presented in the “lozenge” marks is unremarkable, and the highlighting in bold is irrelevant. The word BENTLEY in the “lozenge” marks is “identical” to the word mark on the Register.

18. I therefore reject the first sub-ground of appeal.

19. Mr. Christopher Rees rightly mentioned that the Hearing Officer dealt with the serif font and bold highlighting, albeit at the oral hearing rather than in his written decision (Transcript, pp. 4 – 5). He dismissed Ms. Scott’s argument on much the same basis as I have.

20. Mr. Christopher Rees also made the point that the Proprietor’s evidence contained several examples of use of the word mark BENTLEY in the same serif font as the “lozenge” marks, which I accept.

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<sup>1</sup> Giving effect to Article 5.C(2) of the Paris Convention.

### **Average consumer**

21. It is true that the Hearing Officer did not expressly identify the relevant consumer of clothing and headgear as the general public in his decision.
22. Nevertheless, he clearly knew that he was dealing with clothing and headgear, and his detailed review of the parties' evidence of uses and practices in the clothing field ran to several pages and encompassed various types of clothing and headgear.
23. The Registrar's hearing officers are well versed in assessing the distinctiveness of signs from the viewpoint of the average consumer of the goods or services concerned.
24. Further, it is well established that the Hearing Officer was entitled to form his own view as to the perceptions of the average consumer of clothing and headgear regarding the distinctiveness of the registered marks in suit vis-à-vis the mark in use (*esure Insurance Ltd v. Direct Line Insurance Plc* [2008] EWCA Civ 842, Arden LJ, para. 56). Ms. Scott naturally accepted that the Hearing Officer himself was a potential buyer of the goods.
25. Ms. Scott criticised the Hearing Officer's use of: "To my mind ..." when assessing the distinctiveness of the "lozenge" marks. However, I agree with Mr. Christopher Lees that here, he was doing no more than saying that this was his opinion.
26. The second sub-ground of appeal is also rejected.

### **Visual aspect**

27. The third sub-ground of appeal was that the Hearing Officer ignored that the visual aspect was of prime importance in the purchase of clothing, which in my view was unfounded.
28. It is quite clear that the Hearing Officer did give precedence to the visual aspects of the "lozenge" marks. This follows from his finding that the device elements therein would simply be regarded as edging (with no trade mark significance), which was precisely how the marks were intended to be presented on the labels of garments.
29. He therefore concluded that the distinctive character of the "lozenge" marks resided in the word BENTLEY alone. On that basis proven use of the word mark BENTLEY sufficed to maintain the "lozenge" marks in Registration numbers 1180215 and 217779A (the latter in part as described in para. 4(3) above) pursuant to Section 46(2).

### **Conclusion on the appeal, Respondent's notice and costs**

30. In my judgment the Hearing Officer was entitled to make the above findings for the reasons I have given. The appeal is dismissed.
31. Although the outcome makes this strictly unnecessary, I will briefly consider the alternative ground for upholding the Hearing Officer's decision raised in the Respondent's notice.

32. The Proprietor contended that its evidence did show genuine use of the “lozenge” marks. The evidence primarily relied on was Exhibit CRL6 (undated), which pictured clothes on a rail underneath a large BENTLEY sign. Mr. Christopher Lees contended that the “lozenge” mark could be seen on the neck label of 1 of the garments, and that CRL6 could be dated within the relevant use period by reference to an order for the sign, which I believe appeared at Exhibit CRL56.
33. The Hearing Officer did consider this evidence at paragraphs 14 and 41 of his decision but concluded that it was too tenuous to count as evidence of genuine use.
34. I have seen no reason to disturb his findings on this point but, as I have said, this is of no consequence given the outcome of the appeal.
35. Since the appeal was unsuccessful, the Proprietor is entitled to an award of costs in its favour. I will order the Applicant to pay to the Proprietor the sum of £350 towards the Proprietor’s costs of this appeal, such sum to be paid within 21 days of the date of this decision.

Professor Ruth Annand, 29 March 2017

Ms. Charlotte Scott of Counsel instructed by Eversheds LLP appeared for the Applicant/Appellant

Mr. Christopher Lees with Mr. Robert Lees in attendance appeared for the Proprietor/Respondent