

O/223/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 2182923
IN THE NAME OF JATINDER SINGH WASU
FOR A SERIES OF MARKS



AND IN THE MATTER OF APPLICATION FOR REVOCATION
NO. 501937 BY ZAMIR HUSSAIN

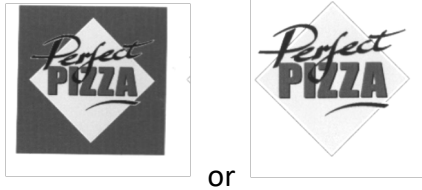
AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
FROM THE DECISION OF MRS JUDI PIKE
DATED 13 MAY 2019

DECISION

1. This is an appeal from a decision of Mrs Judi Pike, on behalf of the Registrar, BL O/404/19, in which she revoked trade mark registration No. 2182923 for non-use. The proprietor, Mr Wasu, appealed to the Appointed Person.

Background

2. Trade mark No. 2182923 was registered on 30 June 2000 as a series of marks, as shown above. Each mark in the series consisted of the words *Perfect* PIZZA (with italics and capitals as shown) on a diamond shaped outline, some with and some without an additional square background. I shall refer to the series as “the Mark”:



or

3. The Mark was registered for certain foodstuff in Class 30 (including pizzas and bread), a range of transport services in Class 39 and “catering services for the provision of food and drink; restaurant services; bar services; take-away food services; preparation of food and drink” in Class 43.
4. It was common ground that the Mark was used in relation to a number of take-away restaurants, mostly run by franchisees, until about 2011. Mr Hussain was one such franchisee. He contended that such use ceased in around late 2011, when the chain started to make use of a new mark. An application was filed to register the new mark on 23 December 2011:



5. Mr Hussain filed his application to revoke the Mark for non-use on 12 January 2018, alleging that the Mark was not put to genuine use for 3 periods: 1 August 2011-31 July 2016, 23 December 2011-22 December 2016, and 6 July 2012-5 July 2017.
6. A counterstatement was filed and both sides filed evidence. Mr Wasu was professionally represented throughout. Mr Hussain had representation at the outset, but then acted in person. A hearing was held on 4 March 2019, at which Mr Wasu was represented by Mr Graham Johnson of Appleyard Lees IP LLP, whilst Mr Hussain attended in Newport.
7. On the appeal, Appleyard Lees continued to act for Mr Wasu. They filed the notice of appeal and provided a skeleton argument. They did not attend the hearing of the

appeal. Mr Hussain provided me with a number of documents for the appeal,¹ and appeared in person, supported by a friend, Mr Mohammed, who acted as interpreter as well (I think) as making some observations of his own.

Standard of appeal

8. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC sitting as the Appointed Person at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch). Mr Alexander QC said in particular that

“... In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).”

9. Subsequently, the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 dealt with the role of the appellate court at [78] to [81]. Lord Hodge said:

“78. ... Where inferences from findings of primary fact involve an evaluation of numerous factors, the appropriateness of an intervention by an appellate

¹ These included a witness statement from a Mr Ullah. Mr Hussain had tried to rely upon the same statement below. The Hearing Officer refused to give permission to introduce the witness statement late, and it is my view there were no reasons to admit it on appeal, given the stringent requirements for late evidence on appeal and the lack of any explanation for adducing it late. I have not placed any reliance on the witness statement.

court will depend on variables including the nature of the evaluation, the standing and experience of the fact-finding judge or tribunal, and the extent to which the judge or tribunal had to assess oral evidence: *South Cone Inc v Bessant , In re Reef Trade Mark* [2002] EWCA Civ 763; [2003] RPC 5 , paras 25-28 per Robert Walker LJ.

...

80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible. ...

81. Thus, in the absence of a legal error by the trial judge, which might be asking the wrong question, failing to take account of relevant matters, or taking into account irrelevant matters, the Court of Appeal would be justified in differing from a trial judge's assessment of obviousness if the appellate court were to reach the view that the judge's conclusion was outside the bounds within which reasonable disagreement is possible. It must be satisfied that the trial judge was wrong ..."

The Grounds of Appeal

10. Mr Wasu contended that the Hearing Officer had erred, as the Mark had been used in all three periods identified in the TM26. It seems to me that the points taken in the Grounds of Appeal can be put into in three categories. It was said that the Hearing Officer erred in:

- a. Giving too much weight to a lack of promotional material showing use;

- b. Ignoring certain aspects of the evidence of use of the Mark, especially use inside one take-away restaurant in 2014, use on a webpage and use on menus; and
 - c. Concluding that any use after February 2012 did not amount to real commercial exploitation of the Mark.
11. Mr Wasu also made a “fall-back” request for the Mark to be maintained for “take-away food services” in Class 43. So far as I can see, there was no evidence of use of the Mark at any time on any other goods or services.

The decision below

12. The Hearing Officer set out the relevant law, referring in particular to the summary set out by Arnold J (as he then was) in the *London Taxi Corporation Ltd v Frazer-Nash Research Ltd* [2016] EWHC 52, [2016] FSR 20. No criticism was made of that analysis, and I shall not set out again Arnold J’s summary.
13. The Hearing Officer found Mr Wasu’s evidence of use of the Mark to be unsatisfactory in a number of ways. She referred at [31] to Mr Wasu’s contention in his second witness statement that use on a single shop would suffice to refute the allegation of non-use and rejected that claim, saying at [32]:
- “32. This statement over-simplifies the law. In *La Mer*, there was use of the mark by a single client in relation to imported goods, which was deemed to be sufficient to demonstrate that such use was genuine because it was found that the import operation had a genuine commercial justification for the proprietor. In contrast, *Reber* concerned a single chocolate shop in Germany. Commercial use was proven, but it was not found to be genuine. The point in both these cases is that the evidence, as a whole, must present a picture of real commercial exploitation of the mark, which includes whether the use is warranted in the economic sector concerned to maintain or create a share in the market. In *SdS InvestCorp AG v Memory Opticians Ltd* (BL O/528/15), Professor Ruth Annand, sitting as the Appointed Person, observed that “it is clear from the CJEU case law including *Reber* that the relevant question for the

tribunal to address is whether the proven use was commercially warranted in the marketplace taking account of all the relevant facts and circumstances of the case, which are interdependent.” I am required to look at the evidence as a whole and not necessarily to conclude that the presence on one (or two) shop front(s) of the contested mark automatically equals genuine use.”

14. The Hearing Officer commented at [33] that Mr Wasu’s evidence in chief related to a single shop (the Fordhouse store) which his company took over from the previous franchisee in 2014. Pictures from Google Maps’ street views from April 2015 and April 2017 showed the Mark on the fascia of the restaurant, and inside the store in 2014, but the 2017 photograph showed the new mark in use inside the shop. She also considered the use on the Fordhouse shop in [37] of the decision, and concluded that the “high point” of Mr Wasu’s evidence was that the Fordhouse shop appeared to have a counter showing the Mark in 2014 as well as the external signage in 2017.
15. In Mr Wasu’s evidence in reply he said that “it was recognised that the [Mark] had a reputation and that there was goodwill associated with the mark and that making and permitting continued use of the [Mark] was beneficial to the business.” Mr Wasu said that the Mark was accordingly used on a number of franchise locations after 6 July 2012, and he produced images of a single, additional shop in Stevenage.
16. The Hearing Officer described the evidence produced by Mr Wasu as “thin.” She considered that his claim that the Mark had been used by franchises other than the Fordhouse shop was not backed up by the documentary evidence. She commented on the poor quality of the evidence of use on the Stevenage shop, which she considered was not clear enough to show the signage save for a single image from October 2015. She commented at [33] that it was “possible to take an educated guess” that the Mark appeared on the fascia of the shop, but added “that is a guess based upon what the Fordhouses shop looked like. It is not solid evidence.” The Hearing Officer was concerned about the lack of any evidence from Mr Wasu’s Fordhouse store from 2014 of use on promotional literature, whilst Mr Wasu had produced a contract of employment for the manager of the Fordhouses shop from 2014, which

used the new mark. This led her to conclude that at least by 2014 it was the new mark that was used on such materials.

17. Mrs Pike cited a passage from BL O/236/13, *Plymouth Life Centre* in which Mr Alexander QC referred at paragraph 20 to the burden falling on the proprietor to prove use, and said “it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid.” The Hearing Officer noted that there was no evidence of use of the Mark on promotional materials such as menus, flyers or posters. She was also concerned about a small amount of evidence which consisted of pages from the proprietor’s website which both sides had found on the Wayback Machine. Mr Wasu’s evidence in chief included print outs of 2 pages showing the Mark on the Perfect Pizza website for 5 October 2011 and 10 July 2012. Mr Hussain filed some similar pages from 15 February 2012, 29 June 2012 and (again) 10 July 2012, all of which showed the new mark but not the Mark. The Hearing Officer noted that the difference between the two pages for 10 July 2012 had not been explained by Mr Wasu in reply, which led her to doubt the probity of Mr Wasu’s internet prints.
18. The Hearing Officer also found it “curious” that whilst Mr Wasu had said that he and his company had consented to the continued use of the Mark by the franchisees after the new mark was developed in 2011, Mr Hussain’s evidence was that Mr Wasu had sent instructions to the franchisees to change their signage boards to reflect the new trade mark. She considered that Mr Hussain’s evidence was supported by a reference on a menu from early 2012² to the change of logo and thought this “helps to form a picture that the public was being educated early in 2012 that the logo had been changed.”
19. She went on to conclude at [39] that early in 2012 the new mark was adopted and promoted to the public. She attributed the continued use of the Mark on the

² The menu was undated but made reference to a special offer ending 2 April 2012

Fordhouse and Stevenage store fascias to “an oversight or a lack of action in changing the external signage on the part of the franchisees of those stores. The insides of those stores bore the new branding ... the remaining signage showing the contested mark does not appear to me to be sham or token use for the purpose of preserving the registration; I think it results from an oversight/lack of action by individual franchisees.”

20. The Hearing Officer therefore concluded:

“40. Does the fact that the signage is there, nevertheless, constitute trade mark use according to the essential function of trade marks which is to enable consumers to distinguish the goods and services of one undertaking from another? Mr Wasu’s position is that the external signage plays a key role in attracting customers. However, taking into account all the relevant facts and circumstances, I do not agree with that view. Certainly, after February 2012, the attention of consumers was being directed to the new mark. Mr Wasu (or predecessors-in-title) did nothing to draw attention to the contested mark other than to say that it had changed to the new mark. This does not indicate a business endeavouring to create or maintain a market share in relation to the contested mark. This very low-key use, coupled with the very geographically limited use shown in the evidence, is insufficient to constitute real commercial exploitation of the contested mark in the UK market for these particular goods and services. I, therefore, find that Mr Wasu has not shown that the contested mark was put to genuine use in the UK after February 2012.

41. This leaves a question as to the position between 1 August 2011 and February 2012. As said earlier, the burden is on Mr Wasu to produce satisfactory, solid evidence. There is no satisfactory evidence of use of the contested mark during this period.”

The Mark was revoked with effect from 1 August 2016.

Merits of the appeal

21. The various points which I have identified in the Grounds of Appeal are closely interlinked and I will deal with them compendiously, with reference to the skeleton lodged on the appeal.
22. In the skeleton argument, it was submitted on behalf of Mr Wasu that the Hearing Officer had erred in her application of the law: although she found in [39] of the decision that the proprietor's use was not sham or token, it was submitted that she failed to apply the remaining criteria identified by Arnold J in *London Taxi*. She was said to have erred by focussing on the low-key, geographically limited use shown, and concluding that such use was insufficient.
23. The skeleton relied upon paragraph 26 of Case T-434/09 *Centrotherm*, in which the General Court held:

“26. Although the concept of genuine use therefore excludes all minimal and insufficient use as the basis for a finding that a mark is being put to real and effective use on a given market, nevertheless the requirement of genuine use does not seek to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to the case where large-scale commercial use has been made of the marks (Case T-194/03 *Il Ponte Finanziaria v OHIM – Marine Enterprise Projects (BAINBRIDGE)* [2006] ECR II-445, paragraph 32).”
24. However, on the appeal in *Centrotherm*, Case 609/11, the CJEU held that the point in paragraph 26 could not be read in isolation:

“71 To begin with, the assessment made in paragraph 26 cannot be read in isolation from paragraph 25 of the judgment under appeal, where the General Court reaffirmed inter alia that there is ‘genuine use’ of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not

include token use for the sole purpose of preserving the rights conferred by the mark.

72 It was in the light of the principles it had just reiterated that the General Court stated, in paragraph 26 of the judgment under appeal, that the concept of genuine use ‘therefore’ excludes all minimal and insufficient use ‘as the basis for a finding that a mark is being put to real and effective use on a given market’, before referring, in the same paragraph, to the case-law according to which the requirement of genuine use does not seek to assess commercial success or to review the economic strategy of an undertaking; nor is it intended to restrict trade mark protection to the case where large-scale commercial use has been made of the marks.

73 Moreover, nor must it be forgotten that paragraphs 25 and 26 are part of a broader review of the case-law relating to the concept of genuine use of the mark, including references to guidance from the case-law on the extent of use and, in particular, the commercial volume of the use, as discussed in paragraphs 27 to 29 of the judgment.

74 It follows that the statement in paragraph 26 of the judgment under appeal, by which the General Court restricts itself to looking back at consistent guidance from the case-law, contains no error of law.”

25. In the circumstances, it is clear that the Hearing Officer had to consider more than just the question of whether the proprietor’s use of the Mark, whilst not sham or token, was commercially successful. I consider that she did so.

26. Mr Wasu complained in his skeleton argument that the Hearing Officer had focussed upon the scale of use of the Mark and the locations of use, and so had made a material error of principle in assessing whether the use was genuine, in terms of being real commercial exploitation of the Mark made for the purpose of creating or preserving a market for the goods or services sold under that mark. However, the Hearing Officer did not simply dismiss the use which had been shown to have been made because of its scale or lack of geographical spread, but also importantly because she concluded from all the evidence before her that the proprietor had not sought – after the

decision to use the new mark had been communicated to the franchisees – to use the Mark to create or preserve a market for the goods or services sold under that mark. As the skeleton put it, the use of the Mark from 2012 onwards was to maintain customer loyalty generated by use of the Mark whilst growing use of the new mark and so amounted to genuine use of the mark as it served a real commercial purpose. Certainly, that was a point put forward by Mr Wasu in his evidence in reply. However, I note that he did not claim that any franchisees had asked to continue making use of the Mark after early 2012 and that such requests had been approved by him, nor that he had given any instructions to franchisees to make continued use of the Mark for the benefit of the business. The claim that the Mark continued to be used on that basis was therefore unsupported by the rest of the evidence, whilst it was inconsistent with Mr Hussain’s evidence. In the circumstances, the Hearing Officer was entitled to reject that part of his evidence and to find that the evidence did not establish that the business was endeavouring to create or maintain market share in relation to the Mark.

27. It was submitted that the Hearing Officer had ignored some elements of the evidence of use for the purpose of creating or preserving an outlet for the goods/services bearing the Mark. For instance, it is said that the Hearing Officer failed to take into account the commercial relationship between the parties. However, I do not understand how it is said that proved use of the Mark in the relevant period.
28. The Grounds of Appeal complained of failure to take into account the menu from early 2012 which used the Mark and the same point was made as to use of the Mark upon signage at the premises. All of those uses, it was said, were designed to commercially exploit the Mark and maintain the market share of the Mark. In my view, these matters were expressly considered by the Hearing Officer at [38] to [40]. She concluded at [40] that such use as was made of the Mark after February 2012³ was not designed to create or preserve a market share for the Mark – the attention was on the new mark for the business. For example, in the menu relied upon by Mr Wasu

³ A further criticism of the decision was the Hearing Officer’s failure to take into account an invoice sent by the proprietor to Mr Hussain dated 12 February 2012 which bore the Mark, but as her conclusions in [40] refer to the position after February 2012 this does not seem to me to compromise the decision.

the only use of the Mark was as part of an explanation that the business had rebranded and was going to use the new mark. In my view, therefore, it was open to the Hearing Officer to conclude that this was not use designed to create or preserve a market share for the Mark.

29. It is clear from [40] of the decision that the Hearing Officer did not look only for commercial success of the Mark after February 2012, but looked at the purpose of the use made of the Mark. She did not accept that the limited continuing use shown by Mr Wasu amounted to real commercial exploitation of the Mark in that period. Whilst it was submitted that the Hearing Officer had wrongly focussed upon the scale and limited locations of use, that was not the sole reason for the conclusion she reached. In addition to the “very low-key use” which had been shown, and its geographical limitations, the Hearing Officer took into account the points just mentioned. It was the combination of those factors which led her to conclude that genuine use had not been shown. In my view, she was applying the appropriate principles and cannot be said to have erred in principle on this point.
30. In the skeleton argument, it was also submitted that the Hearing Officer had misapplied Professor Annand’s decision in *SdS InvestCorp AG v Memory Opticians Ltd* apparently because it was said that she had failed give due weight to the use of the Mark whilst growing use of the new mark. However, the point added nothing to the matters which I have discussed above.
31. A further criticism of the decision was that the Hearing Officer had wrongly applied *Plymouth Life Centre* by taking account of the lack of examples of promotional material provided by Mr Wasu. However, Mr Wasu did not put any such examples in evidence showing use of the Mark, nor did he claim that there had been any such promotional use of the Mark, or explain why he could not provide copies of any such material. There was no substantive reply to Mr Hussain’s evidence that from July 2012 he received promotional material bearing only the new mark. In the circumstances, the explanation given in the Grounds of Appeal and skeleton argument, that such items are transitory and not generally retained, was not supported by the evidence.

In the circumstances, I do not accept that there was any error of principle in this regard.

32. Another criticism was that the Hearing Officer failed to take into account the use inside the Fordhouse shop in 2014. However, she expressly mentioned this in [37]. I do not consider that there is an error in the decision simply because she did not explicitly mention that use again in her summary in [40].
33. Lastly, in the skeleton argument filed on behalf of Mr Wasu for the appeal, a point was taken complaining that paragraphs [41] and [42] of the decision which determined the date of revocation are inconsistent with other parts of the decision, for instance [36] which referred to use of the Mark on the menu in 2012. At best, this point would have pushed forward the date of effective revocation. However, this point was not raised in the Grounds of Appeal, and as a result I do not propose to deal with it as part of the appeal.
34. For all these reasons, the appeal fails. Mr Hussain is entitled to a contribution towards his costs of the appeal. He told me that he had spent at least 2 weeks in preparing for the appeal, which seems to me excessive. Bearing in mind the hourly rate applicable to a litigant in person's costs, I will order the proprietor to pay Mr Hussain £200 in respect of his costs of the appeal. That sum is to be paid, together with the £200 costs awarded by the Hearing Officer, by 24 April 2020.

Amanda Michaels
The Appointed Person
8 April 2020