

**O/418/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 2593038**

**IN THE NAME OF AIK ELECTRONICS LIMITED**

**FOR THE MARK:**

**ICEPOINT**

**AND**

**AN APPLICATION FOR REVOCATION THEREOF (NO. 501757)**

**BY KB EUROPE LIMITED**

## Background and pleadings

1) AIK Electronics Limited (“the Registered Proprietor”) is the proprietor of UK trade mark registration 2593038 for the trade mark shown below:

### ICEPOINT

It was filed on 30 August 2011 and completed its registration procedure on 9 December 2011. It is registered in respect of the following goods:

**Class 11:** *Apparatus for freezing, refrigerating and cooling; freezers, refrigerators, ice boxes, ice chests, cool boxes; washing machines, dishwashers; wine coolers, wine cellars.*

2) By an application filed on 10 August 2017 KB Europe Limited (“the Applicant”) seeks revocation of the registration in respect of all of the goods for which it is registered. It bases this application on non-use under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). The relevant time periods when the Applicant claims non-use are:

- i) under section 46(1)(a): 10 December 2011 to 9 December 2016 (“the first relevant period”);
- ii) under section 46(1)(b): 10 December 2011 to 9 December 2016 (“the first relevant period”), 1 April 2012 to 31 March 2017 (“the second relevant period”) and 10 August 2012 to 9 August 2017 (“the third relevant period”).

Revocation is sought under section 46(1)(a) with effect from 10 December 2016 and under section 46(1)(b) with effect from 10 December 2016, 1 April 2017 and 10 August 2017 respectively.

3) The Registered Proprietor filed a counterstatement, denying, in relation to all the goods, that there has been no use of the contested mark within the relevant periods. It subsequently filed evidence and the Applicant filed submissions in reply. Neither party requested a hearing or filed written submissions in lieu of attendance at a

hearing. I therefore give this decision after a careful review of all the papers before me. The Applicant is represented by HGF Limited. The Registered Proprietor is represented by Bailey Walsh & Co.

**The law**

4) Section 46(1) of the Act provides as follow:

“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 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.”

5) 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.”

6) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to 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 Bunderversvereinigung 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 Merken 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 Evidence**

7) In a witness statement of 19 December 2017 Mr Martin Goldman states that he is the Registered Proprietor’s Managing Director. His witness statement is very brief. Having stated that he and his company have had a business relationship with the Applicant, the key passage is as follows:

“4. The business relationship with KB - Europe Ltd was straightforward, they had access to low cost finance in Taiwan and I had a few good customers wanting electrical consumer goods such as refrigerators and freezers branded ICEPOINT, so I initiated the first few orders in June 2015 and started [*sic*] sharing the profits with KB Europe Ltd. This relationship lasted until around end July 2017. During this time there was a verbal licence in place where I gave KB Europe Ltd. permission to use the mark ICEPOINT during the business relationship. I attach hereto as Exhibit MG1 emails concerning payments between myself representing the Proprietor and the Cancellation Applicant.

5. Prior to getting involved with KB I used the ICEPOINT [*sic*] in relation to refrigerators and freezers when my company supplied them to Makro Cash and

Carry. I attach as Exhibit MG2 invoices and orders relating to the supply of goods under the ICEPOINT mark to Makro.”

8) The Applicant filed no evidence. Instead, in response to the Registered Proprietor’s evidence it filed written submissions criticising that evidence. Rather than summarising these submissions at this point, I shall refer to them, as appropriate, in the course of my decision.

9) Exhibit MG1 to Mr Goldman’s witness statement contains emails between the Registered Proprietor and the Applicant together with spreadsheets showing data relating to an agreement the exact nature of which is not explained with precision by either party. The Applicant concedes in its submissions that the exhibit contains details of a “financial agreement between the parties”, but provides no further explanation of its form. Mr Goldman refers to the arrangement in his witness statement simply as a “business relationship with the Applicant” under which the Registered Proprietor “star[t]ed sharing the profits with KB Europe Ltd.”

10) Exhibit MG1 contains documents which on their face were prepared by the Applicant (“K&B Europe Ltd.”) to show “Commission paid to Martin Goldman”. The first set of documents, sent to Mr Goldman with an email of 7 June 2017, show “goods invoiced by K&B Europe to both EGL and Makro”. Page 4 of Exhibit MG1 shows a schedule of 25 invoices and credit notes, headed “Re: Express Gifts Limited”, giving in each case their respective dates, “goods amounts”, total profit, and profit allocation between “K&B” and “MG”. Page 5 of Exhibit MG1 follows the same format, this time showing a schedule of 30 invoices and credit notes (dating from 22.12.15 to 08.05.17), headed “Re: Booker (Makro)”, and showing a total “goods amount” value for all the items (net of VAT) of £492,882.60. In neither schedule is any indication given of the goods invoiced, nor of any trade mark used. Product descriptions and “icepoint” references do appear, however, on page 3 of Exhibit MG1, which contains a list of four items headed “Orders in hand”. The last, for the customer “EGL”, contains no explicit “icepoint” reference. The first three, however, are for the customer “Booker” (which, when shown on the schedule described above, was followed by “Makro” in brackets). Their respective dates, product descriptions and “goods amounts” are as follows:



07.12.16, “300 pcs icepoint u/c chiller”, £23,025; 23.02.17, “600 pcs icepoint u/c chiller”, £46,050; 28.02.17, “1800 pcs icepoint u/c chiller”, £141,750.

11) The second set of documents in Exhibit MG1, sent to Mr Goldman with an email of 16 December 2017, also shows “goods invoiced by K&B Europe to both EGL and Makro”, and follows the same format as described above. The lists of invoices shown are in fact the same as those in the first set of documents, except that the first set contain the additional invoices added after December 2016. Once again, neither schedule gives any indication of the goods invoiced, nor of any trade mark used. Again, however, product descriptions and “icepoint” references do appear on page 8, which contains a list of five items headed “Orders in hand”. Those for the customer “EGL” contain product codes bearing no explicit connection with the contested mark, but one for the customer “Booker” (which, when shown on the schedule described above, was followed by “Makro” in brackets), dated 25.07.16, and showing a “goods amount” (net of VAT) of £ 87,000, bears the product description “1200 pcs Icepoint u/c chiller”.

12) Exhibit MG2 contains as its first page a single page, apparently intended to be completed online, headed “Article Agreement (Page 1 of 4) – All none [sic] shaded areas (where applicable) to be completed by the Supplier” (“AIK Ltd” being given as the supplier). It is filled in to show, amongst other things, availability date (17.07.2013), unit cost and buying unit (275 and 227 respectively) for items described as “ICEPOINT ICE-95 COMPACT FRIDGE/FREEZER” and “ICEPOINT ICE-103”. Exhibit MG2 also contains an email of 15 May 2014 from Makro to the Registered Proprietor raising orders with order numbers quoted respectively in invoices of 27 July 2014 and 18 August 2014, each of these invoices being made out for £17,252 in respect of 227 items designated as “ICE 103-ICEPOINT CHEST FREEZER”.

### **Evaluation of the evidence**

13) It will be convenient to begin my assessment by looking at the documents in Exhibit MG2. Although the “ARTICLE AGREEMENT” document states on its face that it consists of four pages, only the first page is reproduced in the exhibit. Apart from the fact that it states that it is to be completed by the supplier, the document also

provides on its face for dated signatures – “BUYER SIGNATURE”, “HEAD OF BUYING SIGNATURE” and “SPACE PLANNING SIGNATURE” – none of which are supplied. No evidence is provided that the document was transmitted to the intended customer, Makro. For these reasons, in the absence of further explanation, I am unable to attach any weight to this document as evidence of use of the contested mark on the market.

14) On the other hand, the invoices of 25 July 2014 and 18 August 2014 (pages 3-4 of Exhibit MG2) in respect of supplies of “ICE 103-ICEPOINT CHEST FREEZERS” in response to an order from the customer Makro Self Service Wholesalers Ltd. (page 2 of Exhibit MG2) clearly demonstrate use of the word mark ICEPOINT, as registered, on the market for the goods in question. I shall return later to the question of whether this instance of use satisfies the tests of genuine use. For the present, I note that this exhibit supports Mr Goldman’s statement that prior to its involvement with the Applicant the Registered Proprietor had used the contested mark in relation to the supply of (at any rate) freezers to Makro Cash and Carry. It also fits with his statement that at the time he entered the business relationship with the Applicant he had “a few good customers wanting electrical consumer goods such as refrigerators and freezers branded ICEPOINT”.

15) Referring to the business relationship with the Applicant, he goes on to state that he “initiated the first few orders in June 2015”. It is clear that when he did so with “customers wanting electrical consumer goods such as refrigerators and freezers branded ICEPOINT” the customers in question will have been given to understand that they were to be supplied with ICEPOINT goods. He goes on to state that the Applicant was licensed to use the ICEPOINT mark during the business relationship. It is clear that Mr Goldman’s understanding of the arrangement is that the goods covered by it were to continue to be supplied to customers under the ICEPOINT trade mark.

16) It is also clear from the fact that the Applicant accounted to the Registered Proprietor from the profits earned under the arrangement that it performed a customer-facing role in taking payment from the customers, which one would normally expect to involve at least having sight of the relevant invoices and orders in hand; on the face of it, the Applicant would appear to be in a good position to provide details as to how the

goods it accounted for in Exhibit MG1 were described in invoices to the customer – or, at least, to explain why it was not in a position to provide these details. The Applicant has neither challenged Mr Goldman’s statements nor filed any evidence to contradict them. Instead, it has confined itself simply to pointing out in submissions in reply that its use of the ICEPOINT mark in the documents in Exhibit MG1 is purely internal use rather than consumer-facing use, and that the Registered Proprietor has not provided the kind of evidence normally supplied to show actual use of a mark on the market for the relevant goods.

17) I remind myself that in accordance with section 100 of the Act it is the Registered Proprietor which bears the burden of proving use. I also bear in mind that in its judgment in Case T-431/15, *Fruit of the Loom Inc. v. EUIPO* the General Court makes the point that use cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of actual and sufficient use on the market concerned.

18) Given the particular facts of the present case, however, I think it is also helpful to bear in mind a point made by Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Williams and Williams v. Canaries Seaschool SLU* (“CLUB SAIL”) [2010] RPC 32, in which he cited the following words of Lord Bingham of Cornhill in *Fairchild v. Glenhaven Funeral Services Ltd*:

“... I think it is salutary to bear in mind Lord Mansfield’s aphorism in *Blatch v. Archer* (1774) 1 Cowp 63 at 65, 98 ER 969 at 970 quoted with approval by the Supreme Court of Canada in *Snell v. Farrell*:

‘It is certainly a maxim that all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted.’”

19) It is not strictly necessary to exhibit any particular kind of documentation to prove use. The Registered Proprietor’s evidence could certainly have been fuller, more focused, and more clearly and precisely presented. In particular, in his witness statement Mr Goldman could have given fuller details of the licensing arrangement,

acknowledged that his evidence contains no direct evidence of use, and explained the reason for its absence. However, I must look at all the evidence submitted and, in doing so, I must not simply consider each item of evidence individually, but step back and consider the evidence as a whole to see what it establishes.

20) It should be noted that it does not necessarily have to be shown that the mark was affixed to the goods. The crucial question is whether the mark is shown to have performed a role as an indication of trade origin in relation to the goods. It is clear that it was performing such a role in respect of the supplies made by the Registered Proprietor to Makro which were shown in the invoices of 27 July 2014 and 18 August 2014 in Exhibit MG2; and the obvious conclusion to be drawn from the evidence of Mr Goldman and supporting documentation in Exhibit MG1 which I have described in paragraphs 8-11 is that customers under the arrangement with the Applicant were to be provided with goods under the ICEPOINT brand (and, in particular, that Makro was to continue to be supplied with ICEPOINT-branded goods).

21) It should have been a simple and easy matter for the Applicant to challenge this, and to provide evidence to counter this conclusion. It has not done so. The Applicant is perfectly correct in pointing out that its use of the ICEPOINT mark in the documents in Exhibit MG1 is purely internal use; but that is perfectly consistent with the mark's having been used in sales to customers. In the absence of any evidence to the contrary I conclude that the goods accounted for by Applicant in the documentation in Exhibit MG1 were sold to the customer under the ICEPOINT brand.

22) The Registered Proprietor provides no sales figures for goods supplied under the contested mark. I infer from this that the sales reflected in the documentation he has provided represent in effect the sum of sales under the mark. The invoice schedules on pages 4-5 and 10-11 of Exhibit MG1 contain no indication of the goods covered by the invoices. Product descriptions and "icepoint" references do appear, however, in the items listed for the customer "Booker" (designated as "Makro" in brackets on the invoice schedule) on pages 3 and 8. Their respective dates, product descriptions and "goods amounts" (net of VAT) are as follows: 25.07.16, "1200 pcs Icepoint u/c chiller", £ 87,000; 07.12.16, "300 pcs icepoint u/c chiller", £23,025; 23.02.17, "600 pcs icepoint u/c chiller", £46,050; 28.02.17, "1800 pcs icepoint u/c chiller", £141,750.

23) I bear in mind that these are “orders in hand” rather than sales; some may not have resulted in sales; but, seen in the context of the schedules of goods actually invoiced, they must give a significant indication of the magnitude of sales of “u/c chillers”; it is surely telling that they are included in the calculation of commission payable. The sales are all made to a single wholesaler in the north west of England, but this is still use on the wholesale market, and use of the mark by a single client which imports the relevant goods has, for example, been held to be sufficient to demonstrate that such use is genuine, if it appears that the operation has a genuine commercial justification for the proprietor<sup>1</sup>.

24) Though the figures may be relatively modest in terms of what must be a very large UK market for chillers, they are by no means insignificant, and indicate a certain consistency over time. I am satisfied that the use of the mark in respect of chillers in the period from 2015 to 2017, as evidenced by Mr Goldman’s witness statement and the supporting documentation in Exhibit MG1, must be seen as warranted in the marketplace to create and maintain market share for those products, and thus amounted to genuine use of the mark for those goods during the third relevant period, as specified by the Applicant under section 46(1)(b). This is sufficient to preserve the registration in respect of those goods.

25) Both the invoices of 25 July 2014 and 18 August 2014 (pages 3-4 of Exhibit MG2) issued by the Registered Proprietor to the customer Makro show sales of 227 items designated as “ICE 103-ICEPOINT CHEST FREEZER”. Thus, the total sales of chest freezers to the customer under the contested mark over those two months amounted to 454 items with a total invoice value (net of VAT) of £34,504. The Applicant points out that these are mass market goods, and submits: “... thus it is expected that large quantities of the item would have been sold if genuine use of the mark had indeed been made. Furthermore, given Makro is a wholesale retailer, one would expect there to be large quantities of the product being ordered, a continual supply or numerous repeat orders of the product. This is not the case based on the Registrant’s evidence”.

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<sup>1</sup> *La Mer Technology Inc. v Laboratoires Goemar SA* (C-259/02) at paragraph 24.

26) I bear in mind that the purpose of the requirement for genuine use is not 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 (*Sunrider v OHIM — Espadafor Caba (VITAFRUIT)* T 203/02, paragraph 38 and the case-law cited). I must also bear in mind, however, that not every proven commercial use of the mark may automatically be deemed to constitute genuine use. This is clear from the reasoned order of the Court of Justice of the European Union (“CJEU”) in *Reber Holding & Co KG v OHIM* Case C-141/13 P

27) I am satisfied that the sales of chest freezers reflected in these two invoices were not token sales, that is to say, sales serving solely to preserve the rights conferred by the registration of the mark. The question I must address, therefore, is whether two sales of a total of 454 chest freezers with a total value of £34,000 net of VAT in the summer of 2014 were commercially warranted in the marketplace to create and maintain market share for those products, taking account of all the relevant facts and circumstances of the case, which are interdependent. While I accept the Applicant’s point that these are mass market goods, even viewed in isolation I do not regard these sales as insufficient to amount to genuine use; I consider that they do amount to a real attempt to create or preserve a market for the chest freezers.

28) Moreover, I must in any case take account of all the circumstances. As I shall discuss later, though freezers do not belong to the same category of goods as chillers, they are similar goods, and viewing the freezer sales to Makro in 2014 against the background of the subsequent sales of chillers made to the same customer in the period 2015-2017 further reinforces my view that the 2014 sales do amount to a real attempt to create or preserve a market for chest freezers, and thus represent genuine use of the contested mark in respect of those goods. 2014 falls within all the relevant periods specified by the Applicant under section 46(1)(a) and (b), but the use I have found in the third relevant period suffices to preserve the registration in respect of these goods.

29) Apart from u/c chillers and freezers the evidence does not show use of the contested mark for any of the other goods covered by the Registered Proprietor’s

specification in any of the relevant periods specified by the Applicant under section 46(1)(a) or (b).

### **A fair specification**

30) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

31) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

32) I have found genuine use of the contested mark in respect of u/c chillers and chest freezers. The purpose and function of a chiller is that of any other refrigerator: to keep items chilled, i.e. at a constant low temperature above freezing point. The purpose and function of a freezer is to keep items frozen, i.e. at a constant low temperature below freezing point. I do not consider that the average consumer would regard chillers as being different in substance from refrigerators of any other description, nor chest freezers as being different in substance from freezers of any other description. I think that *refrigerators* and *freezers* would be the appropriate categories, or sub-categories, to which the average consumer would naturally and fairly assign these products, and I consider that these terms constitute a fair specification of the goods for which the Registered Proprietor has shown use. No use has been shown in respect of any other goods listed in the registered proprietor's specification.



## **Outcome**

33) The registration is hereby revoked under the provisions of section 46(6)(a) of the Act with effect from 10 December 2016 in respect of: *Apparatus for freezing, refrigerating and cooling; ice boxes, ice chests, cool boxes; washing machines, dishwashers; wine coolers, wine cellars* in Class 11.

The specification left standing will read:

**Class 11:** *Freezers, refrigerators.*

## **Costs**

34) The Applicant has succeeded in reducing substantially the Registered Proprietor's specification. On the other hand, the Registered Proprietor has successfully defended the core of its specification. The result might be described as a "score draw". Neither side will be favoured with an award of costs.

**Dated this 11 day of July 2018**

**Martin Boyle**

**For the Registrar,  
The Comptroller-General**