TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED APPLICATION NOS. 84628 & 16202 BY INDUSTRIA DE DISENO TEXTIL, S.A. FOR REVOCATION OF UK TRADE MARK REGISTRATION NO. 1395135 & INTERNATIONAL REGISTRATION NO. 834140 IN THE NAME OF FFAUF S.A.

BACKGROUND

1. UK Registration No. 1395135 is for the trade mark:

It was applied for on 16 August 1989 and the registration procedure was completed on 13 November 1992. The trade mark is registered for:

> Alimentary pasta; cereal and cereal preparations; prepared meals, snacks; farinaceous foodstuffs; prepared meals consisting wholly or substantially wholly of pasta; all included in Class 30.

The registration includes the following limitation:

> “In use in relation to goods covered by the specification other than pasta the mark will be varied by the substitution of the name and description of such goods for the word "Pasta"”.

2. International Registration (“IR”) no. 834140 is for the trade mark:

LE DELIZIE ZARA

On 23 July 2003 (claiming priority from a filing in Italy dated 24 January 2003), a request was received for protection of the IR in the UK. The IR, which has a date of protection in the UK of 18 March 2005, is protected for:

> **Class 29** - Meat, fish, poultry, game, meat extracts; salamis, hams, mortadella, sausages; preserves, as tomato puree, tomato juice for cooking; pickles; preserved meat, preserved fish; edible oils; eggs, milk and milk by-products; preserved, dried, cooked, frozen fruits and vegetables; jellies, jams, marmalades, compotes.

Class 30 - Fresh, dried, frozen, deep-frozen, ready to use (semi-cooked) pasta; coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour and cereal preparations, bread, pastries and confectionery, ice-creams; honey, treacle; yeast, salt, mustard, vinegar, sauces (condiments); spices; sauces for pasta.

Class 31 - Agricultural and horticultural products; fresh fruits and vegetables, malt.

Class 32 - Beers; mineral and carbonated waters, non-alcoholic drinks, fruit drinks and fruit juices; syrups and preparations for making drinks.

Class 33 - Wines, sparkling wines, draught wines, spirits, liqueurs.

Both trade marks are registered in the name of Ffauf S.A ("the proprietor").

3. On 14 December 2012, Industria De Diseno Textil S.A. ("the applicant") applied for revocation of these registrations under the provisions of sections 46(1)(a) and (b) of the Trade Marks Act 1994 ("the Act"), indicating that revocation is sought on the grounds of non-use of the trade marks for all of the goods for which they are registered. The applicant asks for: registration no. 1395135 to be revoked with effect from 14 November 1997 (under section 46(1)(a)) and 14 December 2012 (under section 46(1)(b)) and for IR no. 834140 to be revoked with effect from 19 March 2010 (under section 46(1)(a)) and 14 December 2012 (under section 46(1)(b)). The relevant five year periods are as follows:

UK no. 1395135

46(1)(a) – 14 November 1992 to 13 November 1997;
46(1)(b) – 14 December 2007 to 13 December 2012.

IR no. 834140

46(1)(a) – 19 March 2005 to 18 March 2010;
46(1)(b) – 14 December 2007 to 13 December 2012.

4. The proprietor filed forms TM8 and counterstatements (subsequently amended twice in relation to the IR) in which the basis of the actions is denied. In relation to UK no. 1395135, it indicates that the trade mark "including a trade mark used in a form differing in elements which do not alter the distinctive character of the registered trade mark" has been used, in relation to all of the goods for which it is registered, within the section 46(1)(b) period mentioned above. It further denies that there has been no use of the registered trade mark within the 46(1)(a) period. In relation to IR 834140, it indicates that it has made use of its trade mark within both the section 46(1)(a) and (b) periods and that, in relation to the section 46(1)(b) period, this use has been in relation to:

Class 29 – Preserves, as tomato puree, tomato juice for cooking; edible oils; preserved, cooked, frozen vegetables.

Class 30 – Rice; flour and cereal preparations; bread; vinegar; sauces (condiments); sauces for pasta.

5. Although only the proprietor filed evidence, the applicant filed written submissions during the evidence rounds. A hearing took place before me on 18 September 2014 at which the proprietor was represented by Miss Denise McFarland of counsel instructed by Ms Ariana Kumar of Marks & Clerk LLP; the applicant was not represented nor did it file written submissions in lieu of attendance at the hearing.

EVIDENCE

The proprietor's evidence

6. Although these proceedings are now consolidated, the consolidation only took place after the applicant had filed its written submissions. As a consequence, it was necessary for the proprietor to file separate witness statements each referring to the use that had been made of the differing trade marks at issue in these proceedings. Not surprisingly, a good deal of this evidence was duplicative. Whilst I shall try to refer to the general comments contained in these statements only once, I will refer to the evidence of use filed in support of the registrations separately. The proprietor's evidence-in-chief consists of two statements each from Furio Bragagnolo and Massimo Storaro. Mr Storaro's second statement is, save for the reference to the number of the registration concerned, identical to the first.

Mr Bragagnolo's general comments

7. Mr Bragagnolo is the Chairman of the Board of Directors of Pasta Zara S.p.A ("Zara"), a position he has held since 1997. He states that he has been involved "in the field of activities of [Zara] since 1980." Having explained that he is "conversant and familiar with the English language and have a good understanding thereof", Mr Bragagnolo states that Zara was incorporated in February 1964 with the name PASTIFICIO DI RIESE S.a.s di Dalla Costa Roberto & C; it adopted the name PASTA ZARA S.a.s di Dalla Costa Roberto & C in 1978 and changed to its current name in 1988. Following various mergers and name changes, Zara assigned the trade marks at issue to the proprietor, with whom a licensing agreement was entered into. Details of the various changes obtained from the website of the Intellectual Property Office (as at 3 June 2013) are provided as exhibit FB1. Mr Bragagnolo explains that the proprietor owns a controlling interest in Zara (exhibit FB2 refers). Exhibit FB3 consists of a copy of a "Trade Mark License Contract" (in Italian and translated into English) between the proprietor and Zara. The contract, which is dated 10 May 2010, commences on 1 June 2010 and remains in force for a period of 10 years from that date. It relates to "all domestic and international markets", is signed by both parties and grants to Zara an exclusive licence to use a range of trade marks which include the word ZARA including "PASTA ZARA" and "LE DELIZIE ZARA" in relation to "products relating to the food and food processing sector and, in particular, to dried pasta for human consumption."

8. Having provided background as to its history, Mr Bragagnolo states that Zara "is the first Italian exporter of pasta worldwide" and has a 10% share of the total Italian export market. The

quantity of pasta produced has, he explains, increased from 108,000 tons in 1999 to 208,000 tons in 2009. Export sales amount to 92% of total sales, with pasta produced by "the group" being exported to at least 101 countries. Globally, the proprietor's market share amounts to 21% of the total amount of pasta exported.

Mr Storaro's statements

9. Mr Storaro is the proprietor's Administrator; he has been associated with the proprietor since 2004. He confirms, inter alia, that the proprietor owns a majority shareholding in Zara and that Zara is a subsidiary of the proprietor.

Mr Bragagnolo's evidence in relation to the use of UK no. 1395135

10. Mr Bragagnolo states:

> "10...It is my opinion that the elements which make up the distinctive character of the PASTA ZARA brand are the words "pasta ZARA" or more particularly the name ZARA and the figure of a young woman holding a bail of wheat in her arms."

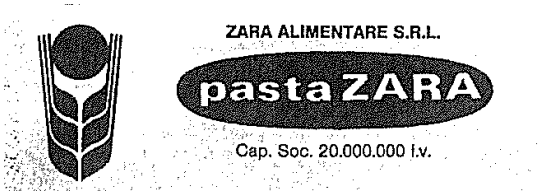
11. Mr Bragagnolo refers to what he considers to be use of the registered trade mark as it appears in exhibit FB4 which consists of a copy of Zara's 2011 Company Profile (which, in his evidence-in-reply, he states is "distributed to existing UK customers and potential customers at...trade fairs and exhibitions...") and by reference to specimen packaging provided as exhibit FB6. The examples in exhibit FB6 are as follows:

And:

12. He goes on to state that the trade mark has been used "in the UK in numerous locations", including London, Berkshire, Hertfordshire and Warwickshire since at least August 1996 "in relation to "pasta" and other goods discussed in [his] witness statement." The trade mark has

been used, he states, upon letter heads, invoices, product catalogues, Zara's website and on the Internet more generally.

13. Exhibit FB7 consists of a fax message dated 8 January 1997 from Mr Bragagnolo to Olympia Merchants Ltd in Bedfordshire. The fax message is in Italian and no translation has been provided. This exhibit also contains two invoices issued to Olympia Merchants Ltd by Zara Alimentare S.R.L dated 1 August 1996 and 25 September 1996. The invoices bear the following:



And:

Zara Alimentare is, explains Mr Bragagnolo, an associated company which subsequently merged with Zara. The invoices relate to various pasta products; Mr Bragagnolo states:

> "12...I would confirm that the packaging of the products delivered to Olympia Merchants Ltd, identified the registered trade mark."

14. Exhibit FB8 consists of a purchase agreement between Zara and Aldi Stores Limited dated November 1993. Also included is a copy of a fax message from Zara to Aldi dated 22 March 1996, an order confirmation from Aldi dated 18 December 1996, what Mr Bragagnolo refers to as "a shipment note " and a copy of the packaging. I note that Aldi placed an order for 2,250 cases of "Tortellini – two colour filled with cheese" to be delivered to its regional depots in Atherstone, Manchester and Darlington on 21 January 1997; the unit cost of each case was £9 i.e. the total value of the order was £20,250. The trade mark appearing on the packaging is as follows:

15. Exhibit FB9 consists of a range of correspondence between Zara and C.G.S. Foods Ltd of Barking, commencing with a fax message from C.G.S. to Zara dated 14 July 2000, in which reference is made to "...the IFE exhibition 2001". I note that CGS placed an order for 1900 cartons of a range of goods which Mr Bragagnolo describes as "numerous types of pasta including other farinaceous products, for example, gnocchi". Included in this exhibit is an invoice issued by Zara to C.G.S dated 7 August 2000 for a range of pasta. The invoice bears, inter alia, the following:

16. Exhibit FB10 consists of copies of Zara's catalogues from 2012 and 2013. Mr Bragagnolo states:

> "15. I confirm that [Zara] has sold "alimentary pasta", cereal and cereal preparations, prepared meals, snacks, farinaceous foodstuffs and prepared meals consisting wholly or substantially wholly of pasta" within the relevant period under the registered trade mark in the UK. It will also be noted that the list of products include "rice", "flour", "cous cous", "grissini (bread sticks)."

17. Mr Bragagnolo states that the "approximate turnover figures for all the products sold under the registered trade mark by [Zara] in the UK...were as follows":

Year	**Turnover (€)**
2007	967.68
2008	42,493.97
2009	81,073. 56
2010	73,000.56
2011	85,158.93
2012	112,082.19
Total	**394,776,89**

(The figures above and those in relation to exhibit FB12 below reflect amendments made by Mr Bragagnolo in his evidence-in-reply).

18. Exhibit FB11 includes the following: (i) two invoices dated 5 December 2002 to SEB Trading Ltd in Windsor. The invoices (neither of which are in the relevant periods) bear the following:

(ii) a range of invoices addressed to Il Piccolino's Ltd in Leamington Spa and dated: 21 January 2008, 26 May 2008, 20 August 2008, 15 October 2009, 19 February 2010, 9 July 2010, 24 August 2010, 19 May 2011, 31 August 2011, 5 April 2012, and 30 August 2012, and (iii) two invoices dated 29 July 2010 and 4 November 2010 to Taste of Sicily in Elstree. All of these invoices fall within the section 46(1)(b) period and all bear one or other of the following:

19. Exhibit FB12 consists of what Mr Bragagnolo describes as "a summary of some of the UK customers my company has supplied with the products sold under the registered trade mark in the UK..." The exhibit lists nine undertakings together with the "revenue generated" from each between 2007 and 2012. The names and (amended) figures are as follows: Food Network Ltd (Royston) - €52k, Moore Ingredients Ltd (Grimsby) - €2.3k, Il Piccolino's (Leamington Spa) - €27k, Goodies Foods Ltd (London) - €157k, Brite Trading Company (Edgware) - €15k, Max Olivia Limited (Ayoni Inc Limited – since 2011) (London) - €138k, Taste of Sicily (Elstree) - €1.8k, Banana Flame Limited (London) – €28 and Gruppo Mondo Ltd (Matlock) - €2.2k.

20. Exhibit FB13 consists of what Mr Bragagnolo describes as:

> "18...correspondence with UK importers and distributors of [Zara's] products as well as evidence that products were supplied in the form of orders placed, order confirmations, transport confirmations and pro forma invoices..."

21. The first batch of documents (the vast majority of which are in Italian) date from December 2005, January 2006, July-September 2007 and February-March 2009. They appear to relate to an exchange between Zara and its export agent in Italy, expor, in relation to orders for (I think), 22,000 kilograms of pasta (December 2005), 25,000 kilograms of pasta (January 2006), 25,000 kilograms of pasta (August 2007) and for 20,000 kilograms of pasta (February 2009), to be shipped to Food Network Limited in Royston, Hertfordshire, an importer/distributor of Zara's goods in the UK. Although only the documents from 2009 are within the section 46(1)(b) period, the invoice provided from February 2009 does not bear a device trade mark of the type shown above.

22. All of the remaining documents (commencing 29 October 2008) relate to exchanges between Zara and Goodies Foods Limited of Park Royal, London. I note that Goodies placed its first order for products on 30 October 2008 and the documents provided include invoices to Goodies from Zara dated 26 March 2010, 3 November 2010 and 25 March 2011. Although all of the invoices fall within the section 46(1)(b) period, other than the invoice dated 25 March 2011 which includes the following, none of the invoices provided bear a device trade mark of a similar kind:

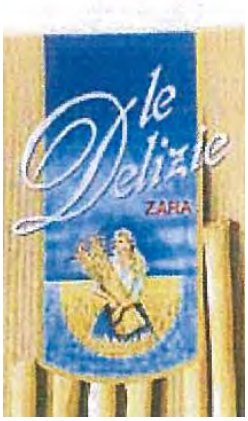
23. Mr Bragagnolo explains that Zara has promoted the trade mark to potential UK customers and in the UK through its website at www.pastazara.com, by attendance at UK trade fairs including the IFE exhibition held in 2001 (mentioned in exhibit FB9 i.e. the correspondence with C.G.S. Foods Ltd) and at major international food trade fairs including CIBUS 2010 (mentioned in the correspondence with Goodies Foods Limited included in exhibit FB13) which are, he states, attended by "UK customers" and at the SIAL International Food Exhibition held in Paris. Zara has also promoted the trade mark by its sponsorship of international women's cycling in the form of the Diadora-Pasta Zara Team who participated in the 2012 London Olympics and via You Tube, Facebook and Twitter. Exhibit FB14 consists of a range of website extracts all of which appear to have been downloaded between 22 and 25 June 2013. Whilst some of the extracts provided relate to the section 46(1)(b)period, for example, those from velonation.com and Cycling News dated 18 October 2011 and 25 July 2012 respectively, as do a number of the extracts from You Tube, all of the extracts from Facebook appear to be from after the relevant date (and are in Italian). Whilst some of the extracts from Twitter are from within the section 46(1)(b) period, once again, the vast majority are in Italian.

Mr Bragagnolo's evidence in relation to the use of IR no. 834140

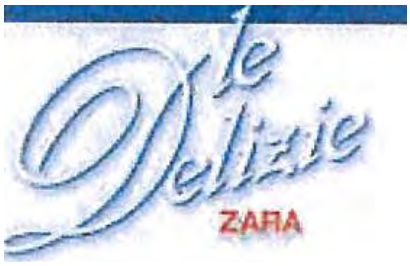
24. Mr Bragagnolo states that the trade mark has been used:

> "9...in relation to a range of products more specifically preserves, as tomato puree, tomato juice for cooking, all of these being in the form of sauces; edible oils; preserved, dried, cooked, frozen vegetables being in the form of sauces; flour and cereal preparations including rice ("riso") and bread sticks ("grissini"), bread, sauces in the form of condiments and various pasta sauces ("sughi")."

25. Exhibit FB4 consists of extracts taken from Zara's 2012 and 2013 product catalogues. By reference to various pages of these catalogues, Mr Bragagnolo states that these "identify the full range of products sold under the registered trade mark." The pages concerned relate to: rice, extra virgin olive oil, balsamic vinegar, breadsticks and a range of pasta sauces. On the packaging of the goods the trade mark looks like this:



And on the pages provided, it appears in the following format at the top of the pages:



And in the following format at the bottom of the pages:

26. Mr Bragagnolo goes on to state that:

> "9...The goods have been sold under the registered trade mark in the UK since at least 2007 and probably earlier".

27. Exhibit FB5 – consists of (i) one invoice dated: 27 January 2005 to SEB Trading Ltd, (ii) a range of invoices to Il Piccolino's Ltd in Leamington Spa dated: 20 September 2007, 21 January 2008, 26 May 2008, 27 May 2009, 19 February 2010, 9 July 2010, 19 May 2011, 31 August 2011, 5 April 2012, and 30 August 2012 and (iii) invoices dated 29 July 2010 and 4 November 2010 to Taste of Sicily in Elstree. Although all of the invoices bear one or other of the device trade marks mentioned above, as Mr Bragagnolo points out, some of the invoices specifically refer to either "Le Delizie" or "Le Delizie pastaZARA". All but the first two invoices fall within the section 46(1)(b) period.

28. Exhibit FB6 consists of what Mr Bragagnolo describes as:

> "examples of correspondence, details of orders placed..."

Insofar as the correspondence with Goodies Foods Ltd is concerned, I have already commented upon this above. I do, however, note that the term rice with a value of €1120 has been highlighted in an invoice dated 26 March 2010. The remainder of the correspondence is between Zara and Il Piccolino's Ltd. It contains a range of invoices dated: 12 May 2011, 21 June 2011 and 28 June 2011; all of these invoices fall within the 46(1)(b) period.

29. Like the UK trade mark, Mr Bragagnolo states that goods sold under this trade mark have been available in the same "numerous locations" mentioned above and, by reference to exhibit FB7, that goods sold under the mark have been promoted through its website and via You Tube, Facebook and Twitter. All of the pages provided, which were downloaded from Zara's websites, were downloaded after and (possibly with the exception of page 115 which refers to an upload date of May 2011) appear to relate to a period after that under consideration under section 46(1)(b) of the Act.

The applicant's written submissions

30. As I mentioned earlier, the applicant responded to the proprietor's evidence-in-chief by way of written submissions in which it queried what it considered to be, inter alia, discrepancies in the evidence filed in (at that stage) the unconsolidated proceedings. The proprietor, inter alia,

explained and, where necessary, corrected these discrepancies in its evidence-in-reply. As the applicant did not challenge the proprietor's reply evidence in any way, i.e. by making oral submissions at the hearing/filing written submissions in lieu of attendance or by seeking leave to cross examine Mr Bragagnolo and/or Zara's customers, at the hearing, Miss McFarland submitted that the proprietor's evidence must be accepted; I agree. With that in mind, the main points in the applicant's submissions which remain are, in my view, and (insofar as possible) in the applicant's own words, as follows:

The UK trade mark

- "...the evidence filed only illustrates use in relation to goods of the words "pasta ZARA" in combination with device elements which are visually very distinguishable from the registered mark";

- "The visual differences between the various marks in use and the registered mark are palpable and readily noticeable by consumers. Bearing in mind that the word "pasta" is descriptive and non-distinctive in relation to products consisting of or used in combination with pasta and the low level of distinctiveness of the concept of a woman holding a bale of wheat in association with such products, we submit that the visual differences between the marks do alter the distinctive character...";

- Mr Bragagnolo "is not an independent or third person, and his assertions must be supported by additional objective evidence"..."we submit that the claims made within the witness statement have not been sufficiently substantiated and should therefore be treated as having very little weight";

- In relation to exhibit FB8 i.e. the order by Aldi, the applicant submits "that a single order of food to a UK supermarket is not sufficient to create or maintain a market share and therefore cannot constitute genuine use on its own";

- If all of the applicant's points are rejected, the evidence only shows use on:

  "pasta", "flour", "polenta" and "cous cous".

- As a consequence, the registration should only be maintained for:

  Alimentary pasta; farinaceous foodstuffs, namely couscous, polenta and flour; prepared meals consisting wholly or substantially wholly of pasta; all included in Class 30.

The IR

Having made many of the same general submissions, the additional points are, in my view:

- The registration must, under section 46(1)(a), be revoked from 19 March 2010 in relation to those goods for which no defence has been filed (I will return to this point later in this decision);

- "The registered mark is for the words LE DELIZIE ZARA in plain block letters. However, the evidence filed only illustrates use in relation to goods in the highly stylised form...and in combination with a distinctive device element. It is submitted that this is use differing in elements which alter the distinctive character of the registered mark in the form in which it is registered...it is not sufficient to maintain the registration for the mark LE DELIZIE ZARA";

- If all of the applicant's points are rejected, the evidence only shows use on:

  > "rice", "risotto", "olive oil", "breadsticks", "tomato sauces for cooking", "pesto" and "balsamic vinegar".

- As a consequence, the registration should only be maintained for:

  Class 29 – Tomato juice for cooking; edible oils.

  Class 30 – Breadsticks; vinegar; sauces for pasta.

The opponent's evidence-in-reply to the applicant's written submissions

31. Although this consists of six further witness statements, as the first, from the opponent's trade mark attorney Ms Ariana Kumar of Marks & Clerk LLP is procedural, it is not necessary for me to summarise it here.

32. The second statement is from the same Furio Bragagnolo mentioned earlier. The purpose of his statement is, as I mentioned above, inter alia, to correct errors/inconsistencies which appeared in his evidence-in-chief and to provide an explanation of the proprietor's invoicing system. Whilst I have read this statement and the exhibits which accompany it i.e. exhibits FB15 to FB20, as the applicant did not, as I explained above, challenge this evidence in any way it is not, in my view, necessary for me to summarise it here. I will, of course, keep it in mind and refer to it as necessary later in this decision.

Evidence from the proprietor's customers

33. The third statement is from Carlo Diforti, the Director of Taste of Sicily of Elstree, Hertfordshire. Having explained that he has held this position since 2005, Mr Diforti states:

> "3. My company has been a customer of [Zara] since at least 2010. I confirm that my company has sold goods bearing the registered trade marks in the UK..."

Attached to Mr Diforti's statement as exhibit CD1 are invoices dated: 29 July 2010 and 4 November 2010; these are the customer copies of the invoices provided by Mr Bragagnolo in exhibit FB11. At the top of each of the pages there appears the following:

34. The fourth statement is from Samantha Mawer, the Director of Moore Ingredients Ltd of Grimsby, Lincolnshire. Having explained that she has held this position for eight years having first become involved "in activities conducted by [her] company in 2002", Ms Mawer states:

> "3. My company was a customer of [Zara] in the period 2005-2008. My company purchased pasta goods in larger commercial pack quantities sold under the PASTA ZARA Logo which were subsequently sold to canneries and manufacturers of salads and ready meals throughout the UK since at least 2005."

Attached to Ms Mawer's statement as exhibit SM1 are invoices dated: 7 September 2005, 15 November 2005, 17 March 2006, 11 May 2006, 19 July 2007 and 18 January 2008. At the top of each page there appears the following:

35. The fifth statement is from Domenico Urso, the Director of Il Piccolino's Ltd of Leamington Spa. Having explained that he has held this position since 2005 when the company was incorporated, and for 30 years prior to its incorporation, Mr Urso states:

> "3. My company has been a customer of [Zara] for around 10 years. We came to purchase goods from [Zara] because we found their products to be of a high standard. We sell goods bearing the LE DELIZIE ZARA mark and the PASTA ZARA Logo via our delicatessen and we also put bottles of oil and vinegar that bear the mark LE DELIZIE ZARA on all our tables in our restaurants for customer use.
>
> 4...I can confirm that that goods bearing the mark LE DELIZIE ZARA and PASTA ZARA Logo have been sold and used by my company in the UK since at least 2007 to date."

Attached to Mr Urso's statement as exhibit DU1 are invoices dated: 3 July 2007, 20 September 2007, 30 November 2007, 21 January 2008, 3 April 2008, 9 May 2008, 24 July 2008, 29 October 2008, 12 May 2009, 15 October 2009, 19 February 2010, 9 July 2010, 4 November 2010, 20 December 2010, 25 August 2011, 14 August 2012, 14 December 2012 and 19 March 2013. There are, once again, customer copies of many of the invoices provided by Mr

Bragagnolo as exhibit FB11. At the top of the vast majority of the pages there appears either the following:

or the image shown above on the invoices provided by Ms Mawer.

36. The sixth and final statement is from Peter McDermott, the Director of Food Network Limited of Royston, Hertfordshire. Having explained that he has held this position since 1999 when the company was incorporated, Mr McDermott states:

> "3. My company first became a customer of [Zara] in 2002 and remains a customer to date. The pasta goods produced by [Zara] were recommended to my company on account of the high quality of the products. My company mostly purchase the 5kg commercial packs of pasta which are sold under the PASTA ZARA logo. These goods are sold on to manufacturers of salads and ready meals in the UK. However, my company also purchase the retail packs if customers order less than 10 tonnes of pasta in a single order. My company would also purchase retail packs if our customers order certain types of pasta shapes which are fragile and not suitable for transportation in the larger commercial packs.
>
> 4...I can confirm that goods bearing the PASTA ZARA Logo have been sold by my company in the UK since at least 2002 to date..."

Attached to Mr McDermott's statement as exhibit PM1 are invoices dated: 5 March 2009, 21 April 2009, 26 May 2009, 28 January 2010 and 12 February 2010. All of the invoices bear the same image shown on the invoices provided by Ms Mawer. I note that Messrs. Diforti, Urso and McDermott and Ms Mawer, all confirm that the invoices provided by them are taken from their company records.

37. That concludes my review of the evidence and submissions filed.

DECISION

The Law

38. Section 46 of the Act reads as follows:

> "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)…..

(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.”

Section 100 of the Act is also relevant and 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."

The relevant five year periods

39. I remind myself that the applications for revocation are based upon section 46(1)(a) and (b) of the Act and that the relevant five year periods are as shown in paragraph 3 above.

The basis of the defence in relation to IR no. 834140

40. Before I turn to consider the substantive issues in these proceedings, I need to deal with an issue relating to the basis of the proprietor's defence to the application for revocation. The IR stands registered for the goods shown in paragraph 2 above. In its application for revocation, the applicant claimed that there had been non-use in relation to all of these goods. The proprietor responded to that allegation in its original defence filed on 7 June 2013. That defence read as follows:

> "1. The registered proprietor denies the claim that there has been no use of the registered trade mark within the five year period of 14 December 2007 to 13 December 2012 in connection with any of the goods covered by the registered trade mark.
>
> 2. Contrary to the assertion that there has been no use of the registered trade mark within the period set out in paragraph 1 above, the registered proprietor will establish through its evidence that the registered trade mark has been used in relation to the goods covered by the registered trade mark as defined in section 7 of the Form TM8(N).
>
> 3. It is further denied that there has been no use of the registered trade mark within the 5 year period following the date of completion of the registration procedure – the period defined as 19 March 2005-18 March 2010. Further, the registered proprietor reserves the right to file evidence to substantiate this aforesaid contention if required to do so.
>
> 4. The registered proprietor asks that the application for revocation be rejected in so far as the goods of classes 29 and 30 covered by the registration for the registered trade mark..."

Paragraph 2 above refers to section 7 of the notice of defence. Question 7 reads as follows:

> "Please specify the goods and/or services of the registration for which you are submitting this notice of defence."

Having ticked the “Some goods and services” box, the proprietor indicated the following:

> “Class 29 - Meat extracts; preserves, as tomato puree, tomato juice for cooking; edible oils; preserved, dried, cooked, frozen vegetables.
>
> Class 30 - Fresh, dried, frozen, deep frozen, ready to use (semi cooked) pasta; flour and cereal preparations; bread, sauces (condiments); sauces for pasta.”

41. In a letter dated 13 August 2013, the proprietor sought, and, in an official letter dated 6 September 2013, was subsequently granted leave to amend its counterstatement (the first amendment). The list of goods it sought to defend was amended to read:

> “Class 29 - Preserves, as tomato puree, tomato juice for cooking; edible oils; preserved, dried, cooked, frozen vegetables.
>
> Class 30 - Flour and cereal preparations; bread, sauces (condiments); sauces for pasta.”

42. In its submissions dated 25 October 2013, the applicant stated:

> “As a preliminary point, it is noted that the registered proprietor has not filed a defence in relation to any of the goods [shown below] and the UK designation of IR No. 834140 must therefore be revoked with effect from 19 March 2010 in accordance with section 46(1)(a)...”
>
> Class 29 - Meat, fish, poultry, game, meat extracts; salamis, hams, mortadella, sausages; pickles; preserved meat, preserved fish; eggs, milk and milk by-products; jellies, jams, marmalades, compotes.
>
> Class 30 - Fresh, dried, frozen, deep-frozen, ready to use (semi-cooked) pasta; coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; pastries and confectionery, ice-creams; honey, treacle; yeast, salt, mustard, vinegar; spices.
>
> Class 31 - Agricultural and horticultural products; fresh fruits and vegetables, malt.
>
> Class 32 - Beers; mineral and carbonated waters, non-alcoholic drinks, fruit drinks and fruit juices; syrups and preparations for making drinks.
>
> Class 33 - Wines, sparkling wines, draught wines, spirits, liqueurs.

43. In a letter to the Tribunal dated 7 April 2014, the proprietor again sought leave to amend its counterstatement “as a result of issues brought to light in the preparation of the evidence of fact in reply.” In a letter to the Tribunal dated 22 April 2014, the proprietor stated:

> “Therefore, the form TM8(N) has been amended in respect of box 7 to include the goods rice and vinegar. The counterstatement has also been amended at paragraph 4 to clarify

the goods in classes 29 and 30 in respect of which the registered proprietor requests rejection of the application for revocation."

The amended counterstatement (the second amendment) was subsequently admitted into the proceedings and reads:

> "Class 29 -Preserves, as tomato puree, tomato juice for cooking; edible oils; preserved, cooked, frozen vegetables.
>
> Class 30- Rice; flour and cereal preparations; bread; vinegar, sauces (condiments); sauces for pasta."

Paragraph 4 of the amended counterstatement now reads:

> "4. The registered proprietor asks that the application for revocation be rejected in so far as the goods of classes 29 and 30 covered by the registration for the registered trade mark in respect of which genuine use has been made in the UK..."

44. At the conclusion of the evidence rounds, the Tribunal invites the parties to indicate on what basis they would like the substantive decision made i.e. at a hearing or from the papers on file. That letter includes a paragraph which reads:

> "The decision in relation to this case will be made on the basis of the evidence and/or submissions now accepted into the proceedings. The Hearing Officer will decide the case on the specification currently before him or her. If, however, the proprietor considers it has a fall-back position in the form of a limited specification, it should be made clear to the hearing officer (i.e. a limited specification should not be submitted for the first time at any appeal hearing). This will not represent a binding restriction of the specification and no inference will be made, by the hearing officer, if such a limitation is, or is not, offered."

45. In a letter to the Tribunal dated 27 June 2014, the proprietor noted the above and stated:

> "In the event that it is determined that the specification must be restricted, it is proposed that registration no. 834140 should at least be maintained for the following limited specification:
>
> Class 29:
>
> Preserves, as tomato puree, tomato juice for cooking; pickles; preserved meat, preserved fish; edible oils; preserved, cooked, frozen vegetables; jellies, jams, marmalades, compotes.

Class 30:

Fresh, dried, frozen, deep frozen, ready to use (semi cooked) pasta; cocoa, sugar, rice, tapioca, sago; flour and cereal preparations, bread; pastries and confectionery; salt, mustard, vinegar, sauces (condiments); spices; sauces for pasta."

Class 31:

Agricultural and horticultural products; fresh fruit and vegetables; malt.

46. In her skeleton argument, Miss McFarland stated:

"18. The proprietor recognised that expressly in relation to certain goods covered by the said registration there had not been any direct use within the relevant periods of time, however, the proprietor has a complete and absolute defence in relation to the following goods directly on and in respect of which the said mark has been used, within the relevant periods, namely:

Class 29
Preserves, as tomato puree, tomato juice for cooking; edible oils; preserved, cooked, frozen vegetables.

Class 30
Rice; flour and cereal preparations, bread; vinegar, sauces (condiments); sauces for pasta."

19. [The various counterstatements] makes the proprietor's pleaded case clear and plain...

20. Whilst it is accepted by the proprietor that the evidence submitted in respect of this particular (word mark) does not demonstrate express use in respect of each and every identifiable good covered by the said (word only) registration, we submit that there is overwhelming evidence of use of goods of a sufficient nature, to demonstrate satisfactory use to rebut the allegations contained in the App's application.

21. Further and in any event it is clear that in many instances, the coverage of a mark is for a core class of goods and also it properly and legitimately extends beyond to cover goods (and/or services) in respect of which the proprietor may have a genuine interest and/or may be perceived by the relevant public as having such an interest and/or in respect of which it is clear there may be a connection or association in the course of trade...

22. And/or, further and in the alternative, if and to the extent that the learned hearing officer should consider that there has been sufficiently proven non-use of certain goods, then any order should be commensurately limited in scope and effect, and in this regard we respectfully remind the hearing officer that in reply to an official request from the IPO,

> the proprietor has already filed an official letter setting out its fall back position in relation to the LE DELIZIE ZARA mark...The said fall-back position...in respect of a limited range of goods in classes 29, 30 and 31. We refer to the said fall-back letter for completeness but we particularly submit that the position expressed in the fall back letter is a further and alternative proposal and is submitted without prejudice to the proprietor's other submissions and/or evidence and its more generally pleaded case."

47. At the hearing, Miss McFarland clarified the basis of the proprietor's defence. As I understood it, her argument was that as paragraph 1 of the amended counterstatement contained a denial in respect of "any of the goods covered by the registered trade mark", this denial was, to use her word, "overarching" and referred to all of the goods in the registration. She explained that the list of goods contained in the second amended counterstatement of 22 April 2014 (and by inference the two versions that preceded it) represented only those goods upon which the proprietor had "directly" used its LE DELIZIE ZARA trade mark.

48. Whilst I understand Miss McFarland's argument, I don't agree with it. The wording of box 7 of the Form TM8 reads: "Please specify the goods and/or services of the registration for which you are submitting this notice of defence." In view of this wording, it is incumbent, in my view, on a proprietor when defending against an attack based upon non-use, to identify in box 7 of the Form TM8 all of the goods and services in the registration upon which it is claimed the registration should be maintained. If, following the compilation of evidence, it emerges that the basis of the defence needs to be modified then leave to amend should be sought at the earliest opportunity. As one can see from the chronology reproduced above, that is what happened in these proceedings. Although the initial defence was filed on 7 June 2013, following the compilation of the proprietor's evidence in chief, it was restricted on 13 August 2013 (by the deletion of "meat extracts" from class 29 and "fresh, dried, frozen, deep frozen, ready to use (semi cooked) pasta" from class 30). Not surprisingly, in my view, the applicant reacted to the basis of the initial defence and its subsequent amendment, concluding in its submissions that the registration must be revoked, in relation to all of the undefended goods, from the earliest date sought. Although the applicant did not react to the proprietor's request to either broaden its defence (by the addition of rice and vinegar to class 30) or to the so-called fall-back specifications contained in the proprietor's letter of 27 June 2014, that cannot, in my view, be construed, as Miss McFarland suggested, as a concession on the part of the applicant.

49. How then should I proceed in light of the above? To begin with, there appears to be no dispute that the proprietor is not defending the revocation in respect of the goods in classes 32 and 33. In addition, and notwithstanding the inclusion of class 31 in the fall back specification, I note that in all the versions of its counterstatement, paragraph 4 has read:

> "The registered proprietor asks that the application for revocation be rejected in so far as the goods of classes 29 and 30 covered by the registration for the registered trade mark..."

In those circumstances, the proprietor is not, in my view, entitled to broaden the basis of its defence in respect of the goods in class 31. That leaves classes 29 and 30 to consider. At the hearing, Miss McFarland indicated that if I was against her in relation to her primary argument

(which I am), then I should consider the registration in respect of the list of goods included in the second amended counterstatement of 22 April 2014. In view of the conclusions I have reached above, the proprietor is, in my view, only entitled to defend the registration in respect of the goods specifically itemised in the second amended counterstatement i.e.

> "Class 29 - Preserves, as tomato puree, tomato juice for cooking; edible oils; preserved, cooked, frozen vegetables.
>
> Class 30 - Rice; flour and cereal preparations; bread; vinegar, sauces (condiments); sauces for pasta."

50. The registration will, as a consequence, be revoked from 19 March 2010 under section 46(1)(a) of the Act in respect of (at least) the following goods:

> Class 29 - Meat, fish, poultry, game, meat extracts; salamis, hams, mortadella, sausages; pickles; preserved meat, preserved fish; eggs, milk and milk by-products; dried vegetables; preserved, dried, cooked, frozen fruits; jellies, jams, marmalades, compotes.
>
> Class 30 - Fresh, dried, frozen, deep-frozen, ready to use (semi-cooked) pasta; coffee, tea, cocoa, sugar, tapioca, sago, coffee substitutes; pastries and confectionery, ice-creams; honey, treacle; yeast, salt, mustard, spices.
>
> Class 31 - Agricultural and horticultural products; fresh fruits and vegetables, malt.
>
> Class 32 - Beers; mineral and carbonated waters, non-alcoholic drinks, fruit drinks and fruit juices; syrups and preparations for making drinks.
>
> Class 33 - Wines, sparkling wines, draught wines, spirits, liqueurs

The authorities on genuine use

51. In *Stichting BDO v BDO Unibank, Inc.,* [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

> "51. Genuine use. In *Pasticceria e Confetteria Sant Ambreoeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):
>
> (1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]–[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question".* The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

52. In considering the proprietor's evidence, it is a matter of viewing the picture as a whole, including whether individual exhibits corroborate each other. In Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, in relation to the need to get a sense from the overall

picture of the evidence, notwithstanding that individual pieces may not, of themselves, be compelling, the General Court ("GC") stated:

> "53 In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (COLORIS, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07 P Ferrero Deutschland v OHIM, not published in the ECR, paragraph 36)."

53. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. Observed in Matsushita Electric Industrial Co. V. Comptroller- General of Patents [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:
>
> > [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.
>
> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

54. I will also, as urged upon me by Miss McFarland both in her skeleton argument and at the hearing, bear in mind the comments of Birss J in *Thomas Pink Ltd v Victoria's Secrets UK*

Limited [2014] EWHC 2631 Ch. However, before, I come to the substantive issues, there are a number of general points upon which, I think, I should comment.

Use with consent

55. Although the applicant does not appear to take a point in this respect, for the avoidance of doubt, I shall comment upon this issue very briefly. The evidence indicates that the trade marks at issue in these proceedings were previously owned by Zara, were subsequently assigned to the proprietor in 2010 and at the same time the proprietor and Zara entered into a Trade Mark Licence Contract. This Contract granted to Zara an exclusive licence to use the trade marks in relation to "products relating to the food and food processing sector and, in particular, to dried pasta for human consumption"; the statement of Mr Storaro confirms the relationship between the parties. As a consequence of the above, I am satisfied that Zara's use is with the proprietor's consent.

The evidence of Mr Bragagnolo and that of Zara's customers

56. Although the applicant argues that as Mr Bragagnolo is "not an independent or third person" his claims should be treated as "having very little weight", that comment was made in the period allowed for the applicant to file evidence and/or submissions. Following that period, the proprietor has filed further evidence from Mr Bragagnolo as well as statements from four of its customers. However, even if it had not, as Mr Bragagnolo has been involved in the activities of Zara since 1980 (i.e. during all the relevant periods of non-use under consideration) and has been Chairman of the Board of Directors since 1997, he is clearly extremely well placed to provide statements on the proprietor's behalf. Applying the guidance provided in Tribunal Practice Notice (TPN 5/2007) entitled "Procedure for parties to challenge evidence filed in inter partes trade mark disputes", as the evidence of Mr Bragagnolo and the proprietor's customers is not incredible, and as the applicant has neither sought leave to file evidence to contradict this evidence nor sought to call any of these individuals for cross examination, I intend to give their evidence considerable weight, although I will not, as indicated in the TPN, assess this evidence "uncritically."

57. I need to consider whether the evidence shows use of the trade marks in the form in which they are registered or, alternatively, of acceptable variants of them. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under section 46(2) of the Act as follows:

> "33. …. The first question [in a case of this kind] 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 trade 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."

See also *Remus Trade Mark* – BL O/061/08 (Appointed Person) & *OAO Alfa-Bank v Alpha Bank A.E.* - 2011 EWHC 2021 (Ch) and *Orient Express Trade Mark* - BL O/299/08 (Appointed Person). Although these cases were decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, they remain sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered but as part of a composite mark.

The UK trade mark

58. For the sake of convenience, the trade mark as registered and some examples of the manner in which it has been used are:

Trade mark (as registered)	Examples of the trade mark (as used)
	  

59. In her skeleton argument, Miss McFarland states:

> "44. PASTA ZARA Logo depicts a roundel shape or frame inside which is a picture of a young woman clad in a white shirt with skirt and white kerchief type headgear, she is smiling, and holding a large sheaf of corn, wheat or some other crop – lying diagonally across her body and up high above her right shoulder. The words "pasta" (in lower case) and "ZARA" (in upper case) appear centralised and lower than the young woman, and are shown in what appears to be a standard style of font (ie; not a "fancy" font) overlaid on top of an elliptical type of elongate shape. All of these same features appear in the mark as used, with the exception of the shape of the "frame" inside which the young woman's picture is shown. In use, the frame shape is oblong. However, this is the only really discernible visual difference and we submit that it is a minor distinction and one which does not material affect the distinctive nature of the mark in use."

60. This answers the first question posed in *Nirvana*. As to sub question (a) of question two, in my view, the distinctive character of the trade mark as registered lies in the combination of a device of a woman holding a sheaf of an indeterminate crop, the crop lying diagonally across her body and extending beyond her right shoulder, set against a rural background and accompanied by the words pasta (presented in lower case), ZARA (presented in upper case) both in normal typeface, enclosed in what Miss McFarland describes (and which I am happy to adopt) as "an elliptical type of elongate shape" which appears below the device of the woman in a central position; in my view, the circular "frame" (as Miss McFarland describes it), does not contribute to the trade marks distinctive character. Turning to sub-question (b) of question two, although the device of the woman has, it appears, been "modernised", she still holds a sheaf of crop in the same orientation, is often presented against a rural background, is still accompanied

by the words pasta and Zara presented in the same typeface and in the same "elliptical elongate shape" and the position of these words and shape relative to the device of the woman have remained constant. Having reached those conclusions, it will come as no surprise that I consider the answer to sub-question (c) to question two, to be no, i.e. the differences between the trade marks used and the trade mark registered do not alter the distinctive character of the proprietor's trade mark as registered, and, as a consequence, is use upon which the proprietor is entitled to rely.

The IR

Trade mark as registered	Trade mark as used
LE DELIZIE ZARA	  

61. In its submissions, the applicant argues that the evidence filed only illustrates use in a highly stylised form and in combination with a distinctive device element. At the hearing, Miss McFarland confirmed that, in addition to oral use, the images shown above are those upon which the proprietor relies. In *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

Castellblanch SA v OHIM, Champagne Louis Roederer SA [2006] ETMR 61 (GC) is an acceptable example of a registered trade mark being used in conjunction with another mark.

62. In view of the conclusions reached in both *Colloseum* and *Castellblanch*, it is clear that even though the words LE DELIZIE ZARA has, more often than not, be used together with the same device of a woman mentioned above, that does not mean that the proprietor cannot rely upon such use. That being the case, I must now, once again, revert to the *Nirvana* criteria to reach a conclusion on the second of the applicant's submissions i.e. the evidence only shows use of these words in a highly stylised format.

63. The answer to the first question posed in *Nirvana* is shown above. As to sub question (a) of question two, in my view, the distinctive character of the trade mark as registered lies in the combination of the words LE DELIZIE ZARA as a whole rather than in any individual element within the trade mark. As to sub-question (b) of question two, the trade mark as used contains these same words in the same order but with the word "le" presented in lower case, the word "Delizie" presented in title case and the word "ZARA", as per the registered trade mark, presented in upper case. However, the words "le Delizie" are presented in a cursive script in which the letter "D" of the word "Delizie" is enlarged, presented with additional flourishes and is much larger than the words which accompany it, particularly the word "ZARA" which is presented in a much smaller typeface. As to sub-question (c) of question two, I have not found this an easy decision to reach. The consumer in the United Kingdom is, in my view, unlikely to be familiar with the meaning of the Italian words LE DELIZIE (which, at the hearing, Miss

McFarland suggested means “the delicious/delightful”). The word ZARA is, however, more likely to be known to them because as Miss McFarland pointed out in her skeleton argument:

> “13...Zara” is a popular girl’s forename, and is particularly well known in the UK as it is the given name to the daughter of the Princess Royal, who is herself a well-known figure and an equestrian Olympian.”

In view of this, I think it highly likely that, notwithstanding its size in relation to the other elements in the trade mark, that the consumer will register the presence of the word ZARA in the trade mark as used and, as a consequence, the distinctive character of the trade mark as used will, in my view, lie in its totality rather than, for example, in the words “le Delizie” which are the most dominant elements within it. In addition, and as Miss McFarland argued at the hearing, as the trade mark as used is, irrespective of its presentation, most likely to be referred to by the average consumer as a LE DELIZIE ZARA trade mark, that is another factor which, in my view, points to the same conclusion. As a consequence of those findings, the proprietor is, in my view, entitled to rely upon the use it has made of its LE DELIZIE ZARA trade mark in these proceedings.

64. Having concluded that the proprietor may rely upon the form in which its trade marks have been used, I must now consider the nature of the trade the proprietor conducts. In her skeleton argument, Miss McFarland stated (in relation to the UK trade mark):

> “28...It can be seen that although there is evidence given from and predominantly in relation to “business to business” transactions and supplies of product on a wholesale basis, there is also evidence of promotion to members of the public...and the social media, but also via its sponsorship activities...and attendance at high profile exhibitions and events and also via retail stores...”

65. In *Laboratoire de la Mer Trade Mark* [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

> “31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in Ansul and La Mer, to the rather slender facts found by Dr Trott.”
>
> 32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of consumers and end users of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantative and qualitatitive test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.
>
> 33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are

sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on that market. That was sufficient use for it to be genuine use on the market and in that market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users."

Neuberger L.J. (as he then was) stated that:

"48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be "genuine", the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be "consistent with the essential function of a trademark" as explained in [36] and [37] of the judgment in Ansul, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler."

66. From the above, it is clear that sales of goods by a foreign manufacturer to importers in the United Kingdom may qualify as genuine use. In addition, I also note that in Mr Urso's statement, he states, inter alia, that goods are sold by his company under the trade marks via "[his] delicatessen", which I take to mean to the public at large. As the nature of the proprietor's trade is clearly acceptable, I now need to determine whether the trade marks have been genuinely used, upon what goods, and if so, what constitutes fair specifications.

Approach to the proprietor's evidence

67. Although the revocation actions are based upon sections 46(1)(a) and (b) of the Act, if the proprietor has made genuine use of its trade marks within the period specified in section 46(1)(b) i.e. 14 December 2007 to 13 December 2012 (i.e. the "relevant period") that will be sufficient to save the registrations from revocation. As a consequence, it is that period upon which I intend to focus. Whilst Mr Bragagnolo has provided turnover figures for goods sold under the UK trade mark, no such figures were, it appeared to me, provided for the IR. At the hearing, Miss McFarland confirmed that was the case and suggested that such figures may not have been available to Mr Bragagnolo himself; I will return to the IR below. For the sake of convenience, I will, as before, try and comment only once upon the more general factors which emerge from the proprietor's evidence, promotion of the trade marks for example.

The UK trade mark

68. Insofar as the UK trade mark is concerned, the evidence indicates that the proprietor or its predecessors in title have used the trade mark in the United Kingdom "since at least August 1996" and that between 2008 and 2012, the proprietor's turnover under this trade mark amounted to some €394,000. The evidence includes a list of nine undertakings in the United Kingdom with which the proprietor has done business during this period, together with, inter alia, a wide range of invoices from its own records many of which fall within the relevant period. Witness statements and a range of invoices from their own records (many of which also fall within the relevant period), have also been provided by four of the proprietor's customers in the United Kingdom, with the witnesses confirming that they either are a customer of the proprietor i.e. since 2010 (Taste of Sicily), 2004 (Il Piccolinos Ltd), 2002 (Food Network Limited) or were a customer, between 2005 and 2008, (Moore Ingredients Ltd). These customers state that they have sold goods bearing one or other (or both) of the registered trade marks and explain what goods they have purchased from the proprietor (I will return to this point in a moment) and what they do with the goods they have purchased i.e. "subsequently sold to canneries and manufacturers of salads and ready meals" (Moore Ingredients Ltd), "via our delicatessen..." (Il Piccolinos) and "sold on to manufacturers of salads and ready meals" (Food Network Limited). Finally, the evidence indicates that the proprietor promotes its products via its website, at trade fairs and exhibitions (at which copies of the proprietor's company profile is distributed), by sponsorship of a women's cycling team and by means of social media.

69. Returning now to the goods upon which the trade mark has been used, in its submissions the applicant appears to accept that if their other points (regarding the form in which the trade mark is used) are rejected (which they have been) the evidence shows use on: "pasta", "flour",

"polenta" and "cous cous" "and they suggest what they consider to be a fair specification based upon the proprietor's use on these goods (a point to which I will return later). As I mentioned above, the proprietor has filed, inter alia, a range of invoices (exhibits FB11 and FB13 to Mr Bragagnolo's first statement) as well as those attached to the statements of the proprietor's customers as exhibits CD1, SM1, DU1 and PM1) the majority of which fall within the relevant period. Taking the evidence as a whole, the goods upon which the trade mark has been shown to have been used appear to me to be as follows: various types of pasta, gnocchi, wheat flour, polenta, cous-cous, rice and breadsticks.

70. Although the proprietor has not provided a breakdown of its turnover in relation to the individual categories of goods mentioned above, a review of the invoices, not surprisingly perhaps, suggests that the bulk of the sales have been in relation to various pasta products; that said, the other products mentioned appear in a number of the invoices provided. In addition, Mr Bragagnolo points out that the evidence only relates to "some of [Zara's] UK customers" and further, as both Mr Bragagnolo and the proprietor's customers point out, the invoices provided are only "a selection". Considering the evidence as a totality, I have no doubt that during the relevant period the proprietor has used its UK trade made to guarantee the identity of the origin of its goods from those of other undertakings engaged in the same area of trade. Keeping in mind the nature of the goods at issue, including their low cost, the scale and frequency of the proprietor's use is, in my view, more than sufficient to constitute genuine use.

The IR

71. Turning now to the IR, Mr Bragagnolo states that goods have been sold under the trade mark in the United Kingdom "since at least 2007 and probably earlier." He provides, inter alia, a range of invoices from the proprietor to a number of its customers (primarily Il Piccolinos) the majority of which are within the relevant period. As I have no comprehensive turnover figures upon which to rely, it has been necessary for me to review the various invoices provided by the proprietor and its customers to get a sense of the scale of the use of the IR in the relevant period. Given the wording of the statements of two of the proprietor's customers i.e. Moore Ingredients Ltd and Food Network Limited, which suggests they only purchased goods sold under the UK trade mark, I have focused my attention on the invoices which relate to Il Piccolino's and Taste of Sicily.

72. I remind myself that, by reference to exhibit FB4, Mr Bragagnolo stated that the full range of products sold under the registered trade mark are "rice, condiments namely oil and vinegar, breadsticks, and various pasta sauces..." and that in his first witness statement he describes the goods sold under the trade mark in the following terms:

> "...preserves, as tomato puree, tomato juice for cooking, **all of these being in the form of sauces**; edible oils; preserved, dried, cooked, frozen vegetables **being in the form of sauces**; flour and cereal preparations including rice ("riso") and bread sticks ("grissini"), bread, **sauces in the form of condiments** and various pasta sauces ("sughi")" (my emphasis).

73. In their submissions, the applicant appears to accept that if their other points (regarding the form in which the trade mark is used) are rejected (which, once again, they have been) the evidence shows use on “rice”, “risotto”, “olive oil”, “breadsticks”, “tomato sauces for cooking”, “pesto” and “balsamic vinegar” and suggest what they consider to be a fair specification based upon the proprietor’s use on these goods.

74. Having reviewed the evidence at exhibits FB5 and FB6 to Mr Bragagnolo’s second statement and the invoices provided by Messrs. Diforti and Urso (some of which are outside the relevant period and some of which are duplicative), I am satisfied that the proprietor has used its LE DELIZIE ZARA trade mark during the relevant period in relation to: three different types of rice (i.e. carnaro, risotto and Arborio), extra virgin olive oil, balsamic vinegar, breadsticks and a range of pasta sauces. In addition, having reviewed the exhibits mentioned above, it appears to me that in the period 21 January 2008 to 14 August 2012, the proprietor sold in the order of €10k of these goods to these two customers in the United Kingdom. Although this quantum of sales is, given the size of the market in the United Kingdom for such goods, low, it does only represent sales to two customers and is, as both Mr Bragagnolo and the proprietor’s customers point out, only a “selection” of invoices**.** Whilst there is no suggestion that the proprietor’s use is anything other than to maintain a market for the goods at issue, it is also clear from the decision in *Reber* that “not every proven commercial use may automatically be deemed to be genuine use of the trade mark in question.” However, bearing in mind the applicant’s stated position and having considered, once again, the nature of the goods at issue, their low cost and the frequency of the proprietor’s use during the relevant period, and keeping in mind that the evidence provided only represents a snapshot of sales made under the trade mark during the relevant period, I am satisfied that the proprietor’s use of its LE DELIZIE ZARA trade mark has been genuine.

What constitutes a fair specification?

75. Mr Justice Arnold (as he now is) in his judgments as the Appointed Person in *Nirvana Trade Mark BL* O-262-06 and *Extreme Trade Mark BL* O-161-07 comprehensively examined the case law in this area. His conclusion in *Nirvana* was that:

> “(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].
>
> (2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].
>
> (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].
>
> (4) In arriving at a fair specification, the tribunal should strike a balance

between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

76. The GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 ("*Aladin*") held that:

"43. Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44. With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-

divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

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

"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."

The UK trade mark

78. The UK trade mark is registered for:

Alimentary pasta; cereal and cereal preparations; prepared meals, snacks; farinaceous foodstuffs; prepared meals consisting wholly or substantially wholly of pasta; all included in Class 30.

79. Earlier in this decision I concluded that the proprietor had used its trade mark upon various types of pasta, gnocchi, wheat flour, polenta, cous-cous, rice and breadsticks. In reaching a conclusion on what constitutes a fair specification, I will also keep in mind that the applicant argues that a fair specification would be:

Alimentary pasta; farinaceous foodstuffs, namely couscous, polenta and flour; prepared meals consisting wholly or substantially wholly of pasta; all included in Class 30.

80. There can be little doubt that the proprietor has made genuine use of its trade mark in relation to "alimentary pasta" or "prepared meals consisting wholly or substantially wholly of pasta" (indeed the applicant accepts as much). However, the proprietor has not, in my view, demonstrated use on "cereal and cereal and cereal preparations" at large, "prepared meals" or "snacks" at large, which are all very broad terms which encompass a wide range of disparate goods. It has, however, made use of its trade mark in relation to "breadsticks" which is, in my view, a sub-set of snacks. Finally, although the term "farinaceous foodstuffs" is a relatively wide one, as the proprietor has used its trade mark on a wide range of farinaceous foodstuffs i.e. pasta, gnocchi, polenta, cous-cous, wheat flour and rice, it is, in my view, entitled to retain this phrase in its specification. As a consequence, a fair specification which reflects the use the proprietor has made of its trade mark is:

Alimentary pasta; breadsticks; farinaceous foodstuffs; prepared meals consisting wholly or substantially wholly of pasta; all included in Class 30.

Conclusion in relation to the UK trade mark

81. The trade mark will, as a consequence of the above conclusions, **be revoked with effect from 14 November 1997 under section 46(1)(a) of the Act and the specification as currently registered will be replaced by:**

Alimentary pasta; breadsticks; farinaceous foodstuffs; prepared meals consisting wholly or substantially wholly of pasta; all included in Class 30.

The IR

82. Earlier I concluded that the proprietor is only allowed to defend the registration in respect of:

Class 29 - Preserves, as tomato puree, tomato juice for cooking; edible oils; preserved, cooked, frozen vegetables.

Class 30 - Rice; flour and cereal preparations; bread; vinegar, sauces (condiments); sauces for pasta",

83. I remind myself that I have further concluded that the proprietor has used its trade mark in relation to: three different types of rice, extra virgin olive oil, balsamic vinegar, breadsticks and a range of pasta sauces. In reaching a conclusion on what constitutes a fair specification, I will also keep in mind that the applicant argues that a fair specification would be:

Class 29 – Tomato juice for cooking; edible oils.

Class 30 – Breadsticks; vinegar; sauces for pasta.

84. Insofar as class 29 is concerned, whilst the proprietor has used its trade mark on goods which appear to include tomato puree, tomato juice for cooking and preserved, cooked and frozen vegetables, as Mr Bragagnolo points out in his witness statement, all of these goods are provided "in the form of sauces". As that is how, in my view, they will be perceived by the average consumer i.e. as sauces rather than individual items the proprietor is not entitled to retain theses descriptions of the goods at large (but see below in relation to pasta sauces). As to the term "edible oils", the evidence shows that the trade mark has been used upon extra virgin olive oil, which falls within the term "edible oils". However, the term edible oils is a wide one that would include a wide range of edible oils such as coconut, corn, rapeseed, olive and sunflower oil to name but a few. I have little doubt that the average consumer would describe the goods upon which the proprietor has used its trade mark made as olive oil (rather than oil or extra virgin olive oil). As olive oil is, in my view, an independent sub-category of edible oils, it represents a fair specification in relation to those goods.

85. Turning to class 30, the trade mark has been used upon rice, balsamic vinegar, breadsticks and a range of pasta sauces. Use upon these goods falls, in my view, a long way short of justifying allowing the proprietor to retain the broad specification mentioned above. In my view, the average consumer would describe the goods upon which use has been made as "rice", "breadsticks" (which are, in my view, a sub-category of bread at large), "balsamic vinegar" (which by analogy with the conclusion I reached in respect of olive oil is a sub-category of vinegar at large), and pasta sauces (which are, in my view, a sub-category of sauces (condiments)" at large. As a consequence, fair specifications which reflect the use the proprietor has made of its LE DELIZIE ZARA trade mark are:

> Class 29 – Olive oil.
>
> Class 30, Rice, breadsticks, balsamic vinegar, sauces for pasta.

Conclusion in relation to the IR

86. The IR will, as a consequence of the above conclusions, **be revoked with effect from 19 March 2010 under section 46(1)(a) of the Act in respect of the following goods**:

> **Class 29** - Meat, fish, poultry, game, meat extracts; salamis, hams, mortadella, sausages; preserves, as tomato puree, tomato juice for cooking; pickles; preserved meat, preserved fish; edible oils; eggs, milk and milk by-products; preserved, dried, cooked, frozen fruits and vegetables; jellies, jams, marmalades, compotes.
>
> **Class 30** - Fresh, dried, frozen, deep-frozen, ready to use (semi-cooked) pasta; coffee, tea, cocoa, sugar, tapioca, sago, coffee substitutes; flour and cereal preparations, bread, pastries and confectionery, ice-creams; honey, treacle; yeast, salt, mustard, vinegar, sauces (condiments); spices;
>
> **Class 31** - Agricultural and horticultural products; fresh fruits and vegetables, malt.

Class 32 -Beers; mineral and carbonated waters, non-alcoholic drinks, fruit drinks and fruit juices; syrups and preparations for making drinks.

Class 33 - Wines, sparkling wines, draught wines, spirits, liqueurs,

and the specification as currently registered will be replaced by:

Class 29 – Olive oil.

Class 30, Rice, breadsticks, balsamic vinegar, sauces for pasta.

Costs

87. At the hearing, Miss McFarland urged me to adopt a pragmatic approach (particularly in relation to the proprietor's fall-back specification) and agreed that costs should follow the event and be on the official scale. In her skeleton argued she stated:

> "4. At the time of the preparation of this skeleton of argument [15 September 2014] it is not known which counsel will appear for the App instructed by Baker & Mckenzie LLP solicitors and trade mark attorneys."

88. In an official letter dated 9 May 2014, the Tribunal allowed the parties until 6 June 2014 to indicate if they wished to be heard or until 20 June 2014 to file written submissions in lieu of attendance at a hearing. In a letter dated 6 June 2014, Marks & Clerk LLP indicated that the proprietor wished to be heard; in an official letter of 16 June 2014, the Tribunal indicated that the hearing would be held by video conference link on 5 August 2014 (although in the event the hearing had to be rearranged); the parties were allowed 14 days to indicate who would be representing them at the hearing. In a letter to the Tribunal dated 30 June 2014, Baker & McKenzie wrote to the Tribunal indicating:

> "..we do not consider the facts of this case to be sufficiently complex to justify attendance at the hearing and the associated costs."

89. At the hearing, Miss McFarland pointed out that this letter had not been copied to the proprietor (a claim which appears, from the copy of the letter on the official file, to be correct). She appeared to further suggest that as the state of the law in relation to revocation was well established and that had this letter been copied to the proprietor, it too may have chosen to rely upon written submissions rather than incurring the costs of attending a hearing; this was, she felt, a matter I ought to bear in mind when awarding costs. However, whilst it appears that Baker & Mckenzie's letter of 30 June 2014 was not copied to the proprietor, the fact remains that the proprietor sought a hearing in its letter of 6 June 2014 (i.e. before the applicant's views on this issue was known) and was advised of the date of the hearing in the official letter of 16 June 2014. The fact that the applicant's letter was not, it appears, copied to the proprietor does not, in my view, negate the fact that the proprietor had itself already elected to attend a hearing. As a consequence, this is not a factor that will play any part in my assessment of costs.

90. The position in relation to the UK trade mark is, in my view, more or less, a “score draw”; as a consequence, I do not intend to make any award in this regard. However, as the applicant has been substantially successful in its request to revoke the IR, it is, in my view, entitled to a contribution towards it costs in that regard. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side’s statement (including the amended statements):	£300
Considering the proprietor’s evidence:	£500
Filing written submissions:	£300
Application fee:	£200
Total:	**£1300**

91. I order Ffauf S.A to pay to Industria De Diseno Textil S.A the sum of **£1300**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of November 2014

C J BOWEN
For the Registrar
the Comptroller-General