

O/542/17

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 2191277

COVERING A SERIES OF THREE TRADE MARKS

IN THE NAME OF DP BRANDCO LIMITED

AND

APPLICATION 501351 BY STV INTERNATIONAL LIMITED

FOR THE REVOCATION OF THE TRADE MARKS

ON GROUNDS OF NON-USE

Background and pleadings

1. On 27th September 2016, STV International Limited (“the applicant”) filed an application to revoke the series of three trade marks registered under No. 2191277 on grounds of non-use.

2. The contested marks consist of the words SLUGAWAY, SLUG AWAY & SLUG-AWAY. The registered proprietor of the trade marks is DP Brandco Limited (“the proprietor”). The registration procedure was completed on 29th October 1999. The marks are registered in respect of the following goods:

Class 1: Chemicals used in agriculture, horticulture and forestry; manures; fertilisers; foliage feed and leaf treatment products.

Class 5: Algicides; parasiticides; biocides; fungicides; germicides; insecticides; pesticides; weed killing preparations and substances; herbicides; larvicides; molluscicides; preparations for destroying vermin; veterinary preparations and substances; animal health products and preparations.

3. The applicant seeks revocation of the trade marks under section 46(1)(a) and/or (b) of the Trade Marks Act 1994.

4. Revocation is sought under section 46(1)(a) as a result of alleged non-use of the marks during the 5 year time period immediately following the date of completion of the registration procedure, namely 30th October 1999 to 29th October 2004. On this basis the applicant requests revocation of the marks with effect from 30th October 2004.

5. Alternatively, revocation is sought under section 46(1)(b) as a result of alleged non-use of the marks in the 5 year period 5th September 2011 to 4th September 2016. On this basis the applicant requests revocation of the marks with effect from 5th September 2016.

6. The proprietor filed a counterstatement on 2nd December 2016 denying the grounds for revocation. I note, in particular, the following points:

- The trade marks were registered in the name of Doff Portland Limited.
- The proprietor acquired Doff Portland in December 2012, in part because of its trade mark portfolio, including the marks at issue.
- The proprietor had a specific intention to develop and market goods under the SLUGAWAY mark.
- The trade marks were assigned to the proprietor on 3rd December 2012.
- Although the proprietor believes that the SLUGAWAY mark was used in the 5 year period immediately following the completion of the registration procedure, it has no records of any such use.
- The proprietor is the largest supplier of slug killer and control products in both the UK agriculture and home and garden marketplaces.
- A related company, 151 Products Limited, already manufactured and sold slug repellents, pesticides, slug traps and slug tape, and these are being re-branded and repackaged under the mark. Additionally, the proprietor has developed an organic slug and bug repellent for sale and distribution under the mark.
- The proprietor developed a marketing campaign in 2016 and planned to launch the SLUGAWAY products in spring 2017.
- The proprietor has been in discussion with customers about the planned launch.
- There has therefore been genuine use of the mark since early 2016.
- This was before the proprietor became aware of the applicant's intention to seek revocation.
- The use meets the requirements of s.46(1) of the Act and/or s.46(3).

7. Both sides seek an award of costs.

Representation

8. The applicant is represented by Reddie & Grose LLP, trade mark attorneys. The proprietor is represented by Hilton Law, solicitors. A hearing took place on 12th October 2017 at which Mr Andrew Norris appeared as counsel for the applicant and Mr Rupert Beloff appeared as counsel for the proprietor.

The evidence

9. The proprietor's evidence consists of a witness statement dated 7th February 2017 by Richard Shonn, a director of the company, and a witness statement dated 19th June 2017 by Mark Hilton of Hilton Law. Mr Shonn's evidence covers, inter alia, the proprietor's use of the SLUGAWAY mark. Mr Hilton's statement is mostly argument and responses to the applicant's evidence described in the following paragraph.

10. The applicant's evidence consists of a witness statement dated 13th April 2017 by Catherine Nursaw, who is a trade mark attorney with Reddie & Grose. Ms Nursaw's statement provides information from Companies House showing that the proprietor and 151 Products Limited are members of the same group of companies (which does not appear to have been in dispute). She also provides the results of searches of the proprietor's website on 6th April 2017 which showed that:

- 151 Products Limited acquired the original proprietor of the marks at issue in December 2012.
- Although the proprietor's website showed that it markets slug control products under other marks, there was no use of the contested marks.

11. Ms Nursaw and Mr Hilton are legal representatives without first-hand knowledge of the proprietor's business. Consequently, the principal evidence of use of the contested marks comes from Mr Shonn. I now turn to that evidence.

12. Mr Shonn states that the proprietor was incorporated in late 2012 "*specifically to acquire Doff Portland's portfolio of registered trade marks, with the specific intention*

of marketing, distributing and selling a range of products under (amongst others) the SLUGAWAY mark.” Mr Shonn confirms that 151 Products Limited already manufactured and sold slug repellents, pesticides, slug traps and slug tape. He explains that the intention was that these would be re-branded and repackaged under the SLUGAWAY mark. Mr Shonn says that this has in fact happened. Additionally, the proprietor has developed an organic slug and bug repellent for sale and distribution under the mark.

13. Mr Shonn states that the applicant’s representatives wrote to the proprietor on 20th September 2016 inviting it to surrender the registered marks or face revocation proceedings. The proprietor’s legal representative responded on 26th September rejecting the offer and these proceedings were launched the next day.

14. According to Mr Shonn, the applicant is a competitor of the proprietor. In his view, the application is an attempt to frustrate and disrupt the proprietor’s business, to put it to cost and cause potential financial loss. This is because the SLUGAWAY product range *“has now been launched”* and, if the application is successful, the proprietor would have to re-brand and re-launch the products. In this connection, Mr Shonn says that the proprietor had *“already invested significantly in the Slugaway brand and product range.”* He accuses the applicant and/or its representatives of behaviour that is *“unprofessional”, “arrogant and aggressive”* and complains of *“sharp practice and unreasonable conduct”* and *“mischief making.”* He goes so far as accusing the applicant of *“seeking to effectively steal the Mark.”*

15. Returning to the use of the contested trade marks, Mr Shonn states that:

- The proprietor has no evidence of use of the marks in the 5 year period following registration.
- The proprietor’s non-ownership of the marks during this period is a proper reason for non-use.
- Having developed an organic slug and bug repellent, the proprietor intended to launch a new product range under the SLUGAWAY mark in 2017.

- Preparations for the launch of products under the SLUGAWAY brand started in February, and *“the SLUGAWAY brand was presented to a number of customers from early to mid-2016.”*
- The original designs for the SLUGAWAY product range were prepared in January and February 2016.¹ These were for SLUGAWAY mini pellets, slug tapes and copper tape.
- *“These products were presented from mid-2016 to various customers, with a view to the product range being launched for retail distribution for the 2017 season.”*
- The SLUGAWAY product range can be seen in a photograph (which he exhibits) and this shows the products being displayed in mid-2016.²
- The SLUGAWAY mark has been displayed at a trade show (he does not say which one).
- A selection of ‘quote sheets’ were *“presented to our customers earlier in 2016, following presentations to a selection of our customers in May and June 2016 of various product ranges distributed by us – including the SLUGAWAY range.”*³
- All commercially sensitive information has been redacted from the copies of ‘quote sheets’ in evidence *“for obvious reasons.”*
- A purchase order dated 23rd August 2016 was sent to 151 Products limited for the supply of 2 SLUG AWAY products.⁴ I note that the quantity and cost information has been redacted, but the delivery date is shown as 5th April 2017.
- Two purchase orders dated 25th August 2016 were placed by 151 Products limited with its suppliers for delivery of “Doffs Slugs Away” and Slug Away copper tape.⁵ I note that the quantity and cost information has again been redacted, as has the identity and location of the suppliers. The delivery dates remain visible. These are 28th March 2017 and 3rd April 2017, respectively.

¹ See exhibit RS1, pages 5-8

² See exhibit RS1 at page 9

³ See exhibit RS1 pages 10-21

⁴ See exhibit RS1 page 22

⁵ See exhibit RS1 pages 23 and 24

16. Mr Shonn concludes that the above mentioned documents are a “sample” of the documentation available to the proprietor and show that a product range under the SLUGAWAY mark “was in the design and development stage since early 2016, in the sales and supply stage since mid-2016 and is coming onto the market very shortly, in early 2017.” At the time of his statement in February 2017, Mr Shonn anticipated that the SLUGAWAY product range “would be widely available by spring 2017.”

The law

17. Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c).....
.....

(d).....

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

18. Section 100 is also relevant, which 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 case law

19. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*,⁶ Arnold J. said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaf” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria”

⁶ [2016] EWHC 52

(Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

20. In *Awareness Limited v Plymouth City Council*,⁷ Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

Assessment

21. There is no evidence of use of the marks during the first five year period of alleged non-use. The proprietor’s suggestion that it has a proper reason for non-use during this period because it was not the proprietor of the marks at the time is manifestly misconceived. Quite rightly, this point was not run at the hearing. However, section 46(3) provides that a trade mark shall not be revoked under sections 46(1)(a) or (b) where use of the mark is “*commenced or resumed after the expiry of the five year period and before the application for revocation is made.*” Therefore, if the proprietor has shown genuine use of the marks during the more recent 5 year period of alleged non-use, it will not matter that no use has been shown during the earlier period. I therefore turn to the question of genuine use in the period 5th September 2011 to 4th September 2016 (“the relevant period”).

⁷ Case BL O/236/13

22. The evidence shows that the proprietor acquired the marks in 2012. However, preparations to use the SLUGAWAY mark seem to have commenced only in 2016. There is no evidence of any sales of goods under the contested marks during the relevant period.

23. The proprietor's internal preparations to use the mark(s) do not count as genuine use for the reasons given by the CJEU in *Ansul*.⁸ Further, as 151 Products limited is a company in the same group of companies as the proprietor, use of SLUG AWAY on the purchase order sent to 151 Products Limited is also internal use. This leaves use of the SLUGAWAY mark:

- during presentations to customers during 2016;
- at a trade fair;
- on two purchase orders dated 25th August 2016 placed by 151 Products Limited with its suppliers for delivery of "Doffs Slugs Away" and Slug Away copper tape; and
- on products shown on a display stand as captured in a photograph.

24. So far as the use in presentations to customers is concerned, the proprietor relies on the narrative evidence of Mr Shonn that "*the SLUGAWAY brand was presented to a number of customers from early to mid-2016*". A selection of 'quote sheets' are presented in support of this claim.

25. Mr Shonn has not identified the number of customers who were shown the SLUGAWAY products, or identified those customers, or where they were located. The timing of these presentations is also vague. This makes it difficult to evaluate the significance of Mr Shonn's evidence and assess whether it shows that the proprietor was really commercially exploiting the SLUGAWAY mark during the relevant period. The vagueness in Mr Shonn's narrative evidence might have been compensated for by the documents exhibited to his statement. However, the 'quote sheets' in

⁸ At paragraph 37 of the judgment.

evidence are not dated (except for a hand written date of 28th June 2016 on the first page).⁹ Further, they are heavily redacted so as to obscure:

- the brands used for products apparently already on the market;
- all information relating to SLUGAWAY products (except for pictures of three of the products) including product descriptions and recommended retail prices;
- other material towards the top of some of the pages where headings might naturally appear.

26. Mr Shonn says that this is commercially sensitive information which has been redacted from the copies of the 'quote sheets' in evidence "*for obvious reasons.*" However, it is not obvious to me why the proprietor has redacted the information described in the bullet points in the previous paragraph. If there was a proper commercial reason for the level of redaction applied to these documents then the proper course would have been for the proprietor to apply for a confidentiality order under Rule 59 of the Trade Mark Rules 2008. In suitable cases such an order may even be extended to the other party to the proceedings (other than its legal advisors) by means of a direction under Rule 62. No request was made for a confidentiality order. As things stand, I cannot tell how many customers were shown the SLUGAWAY mark during the relevant period, who those customers were, or where they were located, or exactly what they were shown. It follows that I cannot assess whether this was a genuine effort to create a UK market for goods under the mark during the relevant period.

27. Mr Shonn's evidence as to the use of the SLUGAWAY mark at a trade show is equally vague. Again there is no information which even identifies the trade show or when or where it was held. This information cannot possibly have been commercially confidential. Yet it was not provided.

28. The purchase orders placed by 151 Products Limited with two suppliers for SLUG AWAY and DOFF SLUGS AWAY products show that goods were ordered

⁹ See RS1, page 10

under those marks in late August 2016, but the quantity of goods and the identities of the suppliers have again been redacted. In any event, this is not use of the mark in order to create a market for the goods, i.e. use in advertising, but use of the mark for the purpose of creating the goods to be marketed. And at least one of the suppliers was based outside the UK.

29. The photograph of a display stand showing three SLUGAWAY products (among others) is undated. However, Mr Shonn's evidence is that it shows the product range being displayed in "mid-2016." As Mr Shonn mentions the trade show later in the same paragraph of his statement, counsel for the proprietor invited me to infer that the photograph showed the proprietor's SLUGAWAY products on display at the (unnamed) trade show. I am not prepared to draw that inference. If that is where the photograph was taken it would have been easy enough for Mr Shonn to say so. He did not.

30. The proprietor appears to have decided to file only a "sample" of the relevant documentation available to it. The proprietor's apparently dismissive attitude to the application appears to have been fuelled by a deep sense of indignation and resentment that the applicant had made the application for revocation. However, anyone can make an application under s.46(1) of the Act. The applicant was as entitled as anyone else to do so. By adopting the course it did in circumstances where it was only able to show (at best) scant use of SLUGAWAY, the proprietor ran the risk that this tribunal would reject its evidence as insufficiently solid. Taking the proprietor's evidence as a whole, I find that it is not solid enough to establish any use of the SLUGAWAY mark in the UK during the relevant period in relation to products *"which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns."*

31. If I am wrong about this, then the most the evidence can possibly show is that SLUGAWAY was shown to some (presumably) trade customers in mid-2016 in relation to goods which were intended to be marketed in the future. According to the purchase orders in evidence from late August 2016, products bearing the mark were due to be delivered to the proprietor's sister company in late March/early April 2017.

This would explain why Ms Nursaw found no such products for sale on the proprietor's website on 6th April 2017. The timing indicates that any presentations to potential customers in mid-2016, which included the SLUGAWAY mark, were not in relation to SLUGAWAY products that were "about to be marketed" in the normal sense of those words.

32. In *Healey Sports Cars Switzerland Limited v Jensen Cars Limited*,¹⁰ Mr Henry Carr Q.C. sitting as a Deputy Judge of the High Court stated that:

"26. I agree with the Hearing Officer that the question of whether goods are "about to be marketed" is to be decided in the context of the economic sector concerned, and that some goods will take longer to develop than others. I also agree that the press release and website, which were published a few days before expiry of the five year period and enabled no more than initial interest in a future development to be registered, did not show that the goods were about to be marketed."

I see nothing about the nature of the slug control products which would make it natural for there to be an unusually long lead time between the marketing and availability for sale of such products. Indeed, Mr Shonn's evidence is that some of the SLUGAWAY products were going to be re-branded versions of existing products already available from 151 Products Limited.

33. I note that one of the few pieces of unredacted information on the 'quote sheets' in evidence is the product codes. However, there are no sales codes listed against the SLUGAWAY products, just the letters TBC ("to be confirmed"). This suggests that the proprietor was not marketing the products with a view to taking firm orders for them in 2016. Indeed, Mr Shonn does not claim that any orders were taken.

¹⁰ [2014] EWHC 24 (Pat)

34. It is clear that events subsequent to the relevant period are admissible as evidence to corroborate genuine use during that period. In the *La Mer*¹¹ case the CJEU stated that:

“...while the Directive makes the classification of use of the trade mark as genuine use consequential only on consideration of the circumstances which pertain in respect of the relevant period and which predate the filing of the application for revocation, it does not preclude, in assessing the genuineness of use during the relevant period, account being taken, where appropriate, of any circumstances subsequent to that filing. It is for the national court to determine whether such circumstances confirm that the use of the mark during the relevant period was genuine or whether, conversely, they reflect an intention on the part of the proprietor to defeat that claim.”

35. In this connection, I find it significant that Mr Shonn’s evidence in February 2017 was that the SLUGAWAY product range “*has now been launched*”, “*is coming onto the market very shortly, in early 2017*” and “*would be widely available by spring 2017.*” The use of present and future tenses indicates that Mr Shonn was not using the word ‘launched’ to mean ‘on the market’. The evidence filed on behalf of the applicant in early April 2017 drew attention to the fact that the SLUGAWAY product was still not listed on slug control section of the proprietor’s website. Despite this, the proprietor’s reply evidence in June 2017 came from Mr Hilton, the proprietor’s legal representative, rather than from Mr Shonn or someone else at the proprietor’s business. Not surprisingly, therefore, the proprietor’s reply evidence still did not show that SLUGAWAY products were actually on sale in the UK.

36. As the proprietor has not shown that (external) use of SLUGAWAY has commenced, it follows that it is unnecessary to deal with the proprietor’s reliance on section 46(3) of the Act on the basis that commercial use of SLUGAWAY commenced after the end of the relevant period. In any event, as I pointed out to counsel for the proprietor at the hearing, s.46(3) is only applicable where:

¹¹ Laboratories Goemar SA's Trade Marks, CJEU, Case C-259/02, paragraph 33.

“use.... is commenced or resumed after the expiry of the five year period and before the application for revocation is made.” (emphasis added)

37. The relevant period ended on 4th September 2016 and the application for revocation was filed on 27th September 2016. There is no suggestion that use of the marks commenced between these dates. Therefore, even if use of SLUGAWAY commenced in 2017, neither that fact, nor the fact that preparations to commence use of the mark started in 2016, are relevant to the application of section 46(3).

38. I conclude that:

- (1) The proprietor’s evidence is not sufficiently solid to show that the SLUGAWAY mark was used in the UK during the relevant period.
- (2) If there was any such use, it was not in relation to goods “*which are already marketed or which are about to be marketed.*”

Outcome

39. The registration of the contested marks will be revoked for non-use.

40. As the conditions for revocation appear to have existed at 30th October 2004, the registration will be revoked as of that date.

Costs

41. The application having succeeded, the applicant is entitled to a contribution towards its costs. I calculate these as follows.

£600 for filing the application for revocation and considering the counterstatement (including the official fee of £200);
£750 for considering the proprietor's evidence and responding to it;
£750 for attending the hearing and preparing a skeleton argument.

42. I order DP Brandco Limited to pay STV International Limited the sum of £2100 within 14 days of the end of the period allowed for appeal.

Dated this 26th day of October 2017

**Allan James
For the Registrar**