

O/929/21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3093954

IN THE NAME OF SCOTTISH SEAFOOD INVESTMENTS LIMITED

FOR THE FOLLOWING TRADE MARK

TRUE NORTH

IN CLASS 29

AND

AN APPLICATION FOR REVOCATION THEREOF

UNDER NO. 503234

BY

COOKE AQUACULTURE SCOTLAND LIMITED

Background and pleadings

1. Scottish Seafood Investments Limited (“the proprietor”) is the registered proprietor of trade mark registration no. 3093954 for the mark:

TRUE NORTH

2. The trade mark was filed on 12 February 2015 and registered on 10 July 2015. It is registered in respect of the following goods:

Class 29: Salmon; salmon products; fresh salmon (not live); prepared salmon; smoked Scottish salmon; preserved salmon; prepared meals consisting principally of salmon; snack foods consisting primarily of salmon; chilled foods consisting predominantly of salmon; frozen salmon; dried Salmon; farmed salmon; smoked salmon; smoked salmon products; hot smoked salmon; prepared meals consisting principally of smoked salmon; snack foods consisting primarily of smoked salmon; chilled foods consisting predominantly of smoked salmon; fish and shellfish; fresh fish and shell fish (not live); prepared fish and shellfish; smoked fish; preserved fish; prepared meals consisting principally of fish and/or shellfish; snack foods consisting primarily of fish and/or shellfish; chilled foods consisting predominantly of fish and/or shellfish; frozen fish and/or shellfish; dried fish and/or shellfish; farmed fish and/or shell fish.

3. Cooke Aquaculture Scotland Limited (“the applicant”) filed a notice of revocation on 17 July 2020, seeking full revocation of the trade mark registration. The application for revocation is based on Section 46(1)(a) of the 1994 Trade Marks Act (“the Act”) on the basis of non-use in the five years following registration. The date of revocation sought is 11 July 2020.
4. The proprietor has defended its registration, claiming use of the mark on all of the goods covered under the mark, during the relevant period.

5. Both parties submitted evidence and written submissions, and the proprietor filed submissions in lieu of a hearing, all of which will be summarised to the extent that it is considered necessary. Neither party requested a hearing and so this decision is taken following a careful perusal of the papers.
6. The applicant has been represented by Lincoln IP. The proprietor has been represented by Murgitroyd & Company Limited.

Evidence

7. The proprietor submitted evidence to support the claim that it has used the registered mark during the relevant period and on the relevant goods. The evidence includes information that is subject to a confidentiality order. The proprietor's evidence comprises the following:
 8. A witness statement of Colin Craig Anderson, Director and Chairperson of Loch Fyne Oysters, which he states is a wholly owned subsidiary of the proprietor Scottish Seafood Investments Limited. Mr Anderson's witness statement is accompanied by exhibits CCA1 – CCA6. Confidentiality has been granted in respect of paragraphs 13, 14, 15, 17, 21, 22, 23 and 28 of Mr Anderson's witness statement and exhibit CCA6.
 9. In his witness statement, Mr Anderson provides the following information:
 10. Mr Anderson's company is the sales arm of the proprietor and he has been a Director of it since 2014 and Chairperson since 2016. Mr Anderson states that he has also been the Chief Executive Officer of The Scottish Salmon Company Limited which, prior to its sale in 2019, owned 25% of his company (Loch Fyne Oysters). He asserts that The Scottish Salmon Company Limited worked closely with his company and that his company purchases approximately £6 million of seafood a year from The Scottish Salmon Company Limited. He adds that the proprietor in this matter, Scottish Seafood Investments Limited, gave permission to The Scottish Salmon Company Limited to use the trade mark TRUE NORTH along with some of its other brands.

11. Mr Anderson states that his company coined the mark TRUE NORTH in 2015 and in the same year commissioned a Glasgow based design company to create a logo to be used with the words TRUE NORTH.

12. Exhibit CCA1 comprises a brand review document/presentation with proposed plans for the TRUE NORTH product launch. The document cover page includes the text 'Brand Review March 2016' as a footer.

13. I note that the cover page of this document and the following pages all contain a figurative logo which looks like this:



14. I also note that page 5 of this document is headed: "The 'True North' Opportunity". Page 6 is headed 'TRUE NORTH salmon'.

15. Page 7 is headed 'True North Packaging – Fresh' and provides the following image of packaging:



And the following image:



16. Further images showing products for sale are provided on pages 8 and 9 of the same document. These products are smoked or fresh sea loch salmon. The words 'True North Packaging – Smoked' are displayed as a heading on page 8 and the words 'True North Branding and Collateral' are displayed as a heading on page 10.

17. Page 11 of the document provided under CCA1 provides a timeline for product development and launch. This shows that limited sales and distribution was scheduled for Nov-Dec 2017; launch of True North fresh and smoked (salmon) was scheduled for the final quarter of 2018 and a UK/International launch was scheduled for 2019.
18. Exhibit CCA2 comprises a photograph of TRUE NORTH product packaging that Mr Anderson asserts was available for sale through his company's deli from 2015 onwards, up to the present date and subject to the Covid-19 pandemic interruptions. This photograph appears to show the same or a very similar logo mark to that provided under CCA1. Exhibit CCA2 is not dated.
19. Exhibit CCA3 comprises a photograph of TRUE NORTH branded smoked salmon on the shelves of Mr Anderson's company deli. The photograph was taken at the company deli on 21 December 2015 and is as follows:



20. Exhibit CCA4 comprises a menu from the Loch Fyne Deli at Clachan Farm. Mr Anderson states that the second option under the heading of main courses is "True North Lightly Smoked, Roasted Smoked Salmon/Bisque/Roasted Red Pepper/Chorizo" priced £19. In fact, the menu shows under 'Mains' the option of 'True North Lightly Smoked Salmon / Butter Bean and Roasted Red pepper / Smoked Pancetta, priced at £18. This exhibit is undated.

21. Exhibit CCA5 comprises a till receipt from Mr Anderson's Loch Fyne Oyster Bar, which Mr Anderson contends is dated 22 July 2016 and shows sales in the restaurant of "True North Lightly Smoked, Roasted Smoked Salmon/Bisque/Roasted Red Pepper/Chorizo". He states that the till receipt corresponds to the menu entry shown in CCA4. In fact, the till receipt appears to be dated 22 October 2016 and the circled item on the receipt is 'Roasted Salmon / Bisque' priced at £19. There is no mention of True North and this item does not appear on the menu provided under CCA4. Much of the receipt is impossible to make out.
22. Mr Anderson asserts that his company's sales of products through the deli at Clachan Farm and restaurant sales from the same address amount to approximately £2 million in revenue on average every year from 2016 to 2019. He states that the figures are lower in 2020 because of closures due to the Covid-19 pandemic, however the combined revenue in 2020 is £1.2 million.
23. He further states that sales of TRUE NORTH smoked salmon through his company deli in 2015 and through the restaurant in 2016, 2017, 2018 and 2019 are provided in the witness statement of Mr Cameron Matthew Brown, which has also been provided by the proprietor as evidence in this matter.
24. Mr Anderson states that his company has been in negotiation with UK supermarkets to provide TRUE NORTH products, in particular he refers to TRUE NORTH smoked salmon.
25. Exhibit CCA6 is confidential and contains information relating to negotiations with a UK supermarket chain to provide Loch Fyne products, although there is some limited mention of the TRUE NORTH brand as it pertains to smoked salmon products. The presentation document is dated August 2019.
26. Mr Anderson submits that the pandemic has been quite damaging for his company and as a result the financial figures covering that period have been significantly affected. In this regard I note that the Covid-19 pandemic began to take effect in the UK to the degree that it may have affected business such as restaurants, bars, hotels and other undertakings that provide food to customers, in March/April 2020 when the UK first went into lockdown.

27. Mr Anderson also states that his company has spent significant time and resources in promoting the TRUE NORTH mark amongst the UK trade.
28. The proprietor's evidence also includes a witness statement of Mr Cameron Matthew Brown and accompanying exhibits CMB1 and CMB2. In his witness statement dated 7 February 2021, Mr Brown provides the following information:
29. Mr Brown is the managing director of Loch Fyne Oysters Limited and has been since February 2015. He states that Loch Fyne Oysters Limited is a wholly owned subsidiary of the proprietor in this matter, Scottish Seafood Investments Limited.
30. Mr Brown states that he is aware that his company sold smoked salmon products branded with the TRUE NORTH trade mark for a period of several months from the end of 2015 into 2016. He suggests that these sales would have amounted to an income of around £3,400. He states that this sales run was not repeated because discussions had commenced with a UK supermarket which involved an offer of exclusive use of the brand name.
31. Mr Brown states that his company featured the TRUE NORTH brand on the menu of its restaurant 'The Loch Fyne Oyster Bar and Restaurant' on several occasions from 2016, notably on a product called 'True North Lightly Smoked Roasted Salmon'. He adds that the witness statement of Mr Anderson and exhibits CCA4 and CCA5 provide further detail of this activity.
32. Exhibit CMB1 comprises a menu from Mr Brown's company's restaurant which he contends dates from winter 2017. Exhibit CMB2 comprises a menu from the same restaurant which appears to date from late 2017. Mr Brown asserts that his company's restaurant has used the mark TRUE NORTH on its menus on a seasonal basis from 2016 to the present date. The use has therefore been continuous, he states. Both exhibits show that under the 'Mains' heading, the restaurant offers 'True North Lightly Smoked Salmon Fillet' priced at £20. The menus however are both undated.
33. Mr Brown states that he has spoken to the head chef and general manager of the restaurant who have assured him that the TRUE NORTH branded meals were very popular, second only to fish and chips. He estimates that as an example, in August,

the peak month for the restaurant, they would expect to serve 10-15 TRUE NORTH branded meals per day or 70-100 meals a week. Mr Brown claims that such trade would amount to a retail value of approximately £7,000 a month. He estimates that between 2016 and 2019 this would have resulted in sales of between £50k and £60k (he doesn't explicitly attribute these larger figures to TRUE NORTH branded meals in his statement, but it is reasonable for me to conclude that these figures relate to sales of salmon under the mark when taking into account the contents of the preceding paragraph as a whole).

Legislation

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

“(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) 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.”

35. 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.”

36. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon

in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

37. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

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

Silberquelle at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

Genuine Use

38. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹ I have summarised the proprietor’s evidence in chief above.

39. On 28 June 2021 the applicant submitted lengthy and detailed submissions rebutting the evidence and witness statements of the proprietor. I have read all of the information provided and will briefly summarise the applicant’s claims here:

40. The applicant dismisses the evidence provided by the proprietor and states that it does not show or demonstrate genuine use of the trade mark in issue for the goods in question. The applicant states that the evidence is materially deficient and of no evidential value because no meaningful data or evidence has been provided showing actual use of the mark TRUE NORTH on the goods and in particular no accurate sales or advertising figures have been submitted.

41. It also claims that the evidence showing use of the mark is scant and insufficient to show genuine use across the UK or in a significant part of the UK. Sales appear to have been made in only one shop in rural North West Scotland which the applicant

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

claims to be too insignificant to constitute genuine use. No transactional evidence, such as dated invoices or purchase orders, clearly showing sales of goods have been provided. It asserts that use of the mark on the menus of one restaurant in North West Scotland is too insignificant to constitute genuine use and is considered to be unsubstantiated anyway. It also states that no proper reason for non-use has been given by the proprietor and claims by the proprietor that preparations have been made to commence use are scant and there is nothing to explain why actual use has not commenced. It states that no evidence has been provided by the proprietor establishing consent for use of the mark to Scottish Seafood Industries Limited or Loch Fyne Oysters Limited, and no information providing formal consent, or a license is in evidence.

42. The applicant notes that the sales information provided in Mr Brown's witness statement of 7 February 2021 suggests that sales of TRUE NORTH branded goods were tiny and took place over a very short period of time. It adds that these sales took place in a very small, very provincial part of Scotland, from and within one single outlet. It asserts that this level of sales from one shop in Scotland, is insufficient to create or preserve an outlet for consumer food products (salmon/fish fillets) in the UK, which has a population of more than 66 million people.
43. The applicant states that paragraph 6 of Mr Brown's witness statement confirms that the initial very small sales run from the end of 2015 into early 2016, was not repeated. It asserts that this small sales run of between 100 and 200 units, over a period of one or two months is nothing more than token, minimal or notional use. It adds that this use is too insignificant to constitute genuine use for the purpose of creating a market share in the UK.
44. Turning to the use of the mark on menus from a restaurant, as set out in exhibit CMB1, the applicant states that this use does not constitute genuine use as the words TRUE NORTH are not highlighted in any way and are presented in the same size and font as the rest of the words on the menu and there are no uses of the ® or TM identifiers to assist in distinguishing the words from the rest of the menu, or indicating that the words should be perceived as a trade mark. The applicant notes the same issues with the evidence provided under exhibit CMB2. It also states that neither of the menus

provided are dated. Whilst the proprietor claims that both date from late/winter 2017, there is nothing to support this claim.

45. The applicant states that the sales figures provided in paragraphs 13-15 of Mr Brown's witness statement are uncorroborated and based on guesswork, and as such their accuracy cannot be verified.
46. Turning to the witness statement and evidence of Mr Anderson, the applicant states that no evidence has been provided that establishes the relationship between the proprietor and Mr Anderson's company The Scottish Salmon Company Limited. It adds that Mr Anderson's company operates from one premises at Clachan Farm, Cairndow, which is a small village in Argyll & Bute, in North West Scotland.
47. The applicant goes on to dismiss much of Mr Anderson's evidence as unfounded, undated or insufficient to establish genuine use. The applicant asserts that the proprietor's claim that the Covid-19 Pandemic impacted its business significantly is flawed. The applicant claims that the proprietor had four years and eight months to commence use of the trade mark before the pandemic struck. It adds that sales of the goods in issue (salmon and fish) continued relatively normally throughout the pandemic, with retail establishments that stock such goods being deemed "essential services".
48. The applicant also notes that Mr Anderson has claimed that his company spent significant time and resources promoting the TRUE NORTH brand. It states that this claim is unsupported by the evidence and that no advertising or market research appears to have been carried out by the proprietor.
49. The applicant also provided a witness statement of Karen Veitch, dated 28 June 2021. Ms Veitch is a trade mark attorney working for Lincoln IP who represent the applicant in this matter.
50. In her witness statement Ms Veitch states that goods such as salmon and smoked salmon are widely sold throughout supermarkets and grocery stores and are not high value or rare/exclusive goods but are consumed in large quantities by the UK public.

51. Her witness statement is accompanied by exhibits KV1, KV2 and KV3. Ms Veitch states that Exhibit KV1 comprises a number of screenshots that show that smoked salmon and salmon fillets are widely available through major retailers at a reasonable price. Exhibit KV2 comprises an extract from a Public Health England report published in November 2020 which shows that volumes of food and drink purchased for consumption in the home during the pandemic actually increased from the equivalent time period in 2019. Exhibit KV3 comprises a screenshot showing the online shop from which members of the public may purchase goods sold by Loch Fyne Oysters Limited. Ms Veitch states that none of the products available from the shop are branded with the TRUE NORTH trade mark and adds that all of the smoked salmon for sale in the shop is branded LOCH FYNE.

52. In response to the applicant's submissions and evidence, the proprietor filed evidence in reply. This evidence comprises second witness statements from Mr Brown and Mr Anderson, and two further exhibits accompanying Mr Brown's witness statement, CMB3 and CMB4.

53. In his second witness statement, dated 29 August 2021, Mr Anderson states that in addition to the evidence he has provided previously, he is also aware that during the pandemic a number of smokehouses have been closed. He lists five in total. I take this information to be intended to support the claims of the proprietor as to the significant effect that the Covid-19 pandemic has had on the relevant industry and the geographical area in which the proprietor is based.

54. In his second witness statement, dated 26 August 2021, Mr Brown provides the following information:

55. Under Exhibit CMB3, a menu from the Loch Fyne restaurant and deli apparently dating from the summer of 2015, which shows 'TRUE NORTH Lightly Smoked Salmon' appearing as a main meal on the menu, priced at £18.

56. Under Exhibit CMB4, till summaries for June 2016. Mr Brown states that the till summary in combination with the menu under CMB3 shows that in June 2016, 269 'TRUE NORTH Lightly Smoked Salmon' main meals were ordered by customers of the company's Oyster Bar.

57. In reference to the evidence and submissions of the applicant, Mr Brown states that, whilst food sales from supermarkets may have done well during the pandemic, his company sells much of its smoked salmon to the hospitality sector including airlines and hotels.
58. Within his witness statement, Mr Brown also provides a table of financial figures as an illustration of the impact that the pandemic has had on his company's turnover in 2019 and 2020. The table provides overall turnover figures only, and there is no breakdown into sales or into sales of specific brands.
59. Having made a careful assessment of the evidence from both parties, I refer back to the findings in *Walton* in respect of genuine and actual use of a trade mark. In particular that 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. The use must be more than merely token. All of the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including the nature of the goods or services and the characteristics of the market concerned. 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, and there is no *de minimis* rule.
60. Turning firstly to the evidence provided by Ms Veitch on behalf of the applicant, I note that it appears to be the case that in fact Exhibit KV1 provides the information supposedly set down in Exhibit KV3. Information from the Loch Fyne online shop is presented and shows many seafood and fish related products under the Loch Fyne brand. I note that the final page of KV1 does display the 'TRUE NORTH' logo. I consider it likely to be the case, as established in Mr Brown's witness statement, that a lack of use of the TRUE NORTH branding on the Loch Fyne shop products has been due, in some part, to negotiations between the proprietor and a UK supermarket chain, to which exclusive rights to the TRUE NORTH brand has been offered.

61. The report provided under KV2 is noted, however I take from that report the comment regarding the reason behind the increase in sales volumes of food and drink between November 2019 and November 2020. On page 5 of that report, it states: “This increase has largely been driven by an increase in volume per trip, whilst the number of trips has fallen...”.
62. Exhibit KV3 provides the information that Ms Veitch mentions under KV1, i.e. evidence of the wide availability of smoked salmon and salmon fillet products in UK retail outlets. This information simply shows that major supermarkets such as Sainsbury’s, Tesco, ASDA and Co-op all sell such products.
63. Within the evidence of the proprietor I note that the mark TRUE NORTH and the logo mark combining the words TRUE NORTH with a fish/salmon device element are used consistently in the document provided under exhibit CCA1 which is dated March 2016 and serves as a promotional/product development type presentational document. The applicant has stated that it is unclear who this document is intended for, or was presented to, however I find this to be somewhat irrelevant in this matter as it is clear that the document is not for internal use purposes. The document clearly shows use of the mark in issue and of a variant mark incorporating the mark in issue. It illustrates that in March 2016 the proprietor was quite serious in creating a business plan to develop and launch the TRUE NORTH brand. The timeline set out at the end of that document extends across the relevant period 2015-2020, and shows a determination on the part of the proprietor to create a successful brand and exploit the trade mark in the relevant field.
64. Regarding the use of a variant mark, incorporating the mark in issue with a fish/salmon device, I have considered carefully whether this use can be considered acceptable variant use of the mark TRUE NORTH. I find the matter to be finely balanced. The letter T of the word TRUE in the variant mark can be said to serve a dual purpose, as it also forms the tail of the fish device. It is also the case that the word NORTH is presented in a stylised manner, with the letter ‘O’ presented in a smaller font than the other letters in that word. On balance however, I conclude that the words TRUE NORTH are clearly present and obvious and I believe that the distinctive character of

the mark in issue is not affected to any significant degree by the use made of it within the variant mark.

65. Importantly, I note that the applicant has not challenged the variant use of the mark and has not argued that the mark has been used in a different format to that as registered. That being the case, I take into account not only the use shown of the plain words TRUE NORTH within the proprietor's evidence, but also the variant mark shown on packaging examples and within exhibit CCA1. The variant mark is also shown in a photograph provided under exhibit CCA3 dated December 2015, which shows the mark used on packaging of salmon in the proprietor's deli.
66. The applicant has made a number of claims regarding the insufficiency of the proprietor's evidence, which I have summarised previously. I have considered these arguments carefully and accept that there are a number of issues with the evidence that must be addressed.
67. The proprietor has not provided any sales invoices showing sales of TRUE NORTH products. It has however, provided evidence by way of restaurant menus and till summaries, showing that sales of TRUE NORTH products have taken place at least in 2015 and 2016. Exhibits CMB3 and CMB4 show that the proprietor's restaurant included a main meal called 'True North Lightly Smoked Salmon' on its menu in 2016. However, the claim of Mr Brown that the till summary from June 2016 shows sales of TRUE NORTH meals is not entirely correct. In fact, the brand name TRUE NORTH is not shown on the till summary, rather the till summary for June 2016 lists 'Lightly Smoked' under the list of main meals ordered for that month. There were 269 'Lightly Smoked' meals ordered, with a total value of £5102.55. Whilst the trade mark is not provided on the till summary, I note that no other main meal or starter containing the words 'Lightly Smoked' is listed on any of the menus that have been provided by the proprietor, other than the 'True North' branded products. I think it is reasonable therefore, to accept that the 269 'Lightly Smoked' meals sold in June 2016 are the 'True North Lightly Smoked Salmon' meals listed on the proprietor's menus.
68. The applicant has stated that there is no evidence establishing a relationship between the companies of Mr Anderson and Mr Brown with the proprietor company and no

evidence showing consent or a licence to use the mark TRUE NORTH by those companies. I agree that this is the case, however both Mr Anderson and Mr Brown have asserted in their sworn statements, that their companies are wholly owned subsidiaries of the proprietor and are entitled to use the mark in issue and I accept these statements at face value.

69. In *Einstein Trade Mark*, [2007] RPC 23, Mr Geoffrey Hobbs Q.C. as the Appointed Person found that use with the consent of the proprietor did not require the proprietor to have effective control of the use in question. He stated that:

“24. It is clear from [38] of the judgment in Case C-9/93 *IHT International* that the proprietor will be taken to have approved the quality of the relevant goods by allowing the person with whom he is “economically linked” to sell them under his trade mark. There is no requirement for participation (still less any particular degree of participation) in any process of quality control. It should, in my view, follow that the proprietor of a trade mark can claim protection defined by reference to use and also defeat an application for revocation on the ground of non-use by relying upon the fact that goods have been sold under his trade mark by a person (such as a licensee) with whom he is “economically linked” and can do so without showing that he has exercised control over the quality of the goods in question.

70. The applicant claims that no advertising or promotional activity has been shown in evidence, although Mr Anderson has claimed that significant time and resource was spent promoting the brand. It is the case that no evidence has been provided setting out how much has been spent on promoting the brand or the kinds of activities undertaken, however I note that CCA1 and CCA6 act as promotional material of a kind, inasmuch as they both serve to promote the TRUE NORTH brand to third parties, notably a large UK supermarket chain. Exhibit CCA1 is dated March 2016 and Exhibit CCA6 is dated August 2019. The timeline on page 11 of CCA1 sets out the promotion, development and launch of TRUE NORTH branded products across the relevant period and, whilst no evidence is given showing specific promotional activity in e.g. 2017, I believe that it can be inferred that the proprietor’s business proposals, laid out in CCA1 and CCA6, support the contention of the proprietor that activities intended to

promote and raise awareness of the brand were ongoing throughout the relevant period.

71. The applicant also states that the proprietor has used the mark TRUE NORTH only in one place, in the proprietor's deli and restaurant in North West Scotland. It asserts that this is insufficient use to establish genuine use in the UK. In this context I remind myself of the relevant case law outlined above. In particular, I note that: "Use of a 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".

72. It is also the case that, in determining whether there is real commercial exploitation of the mark, I must consider whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods in question; the nature of the goods; and the territorial extent of the use. In this regard I note that the proprietor is a local business linked directly to its surrounding environment, specifically Loch Fyne, in order to develop and grow its salmon and salmon-based products.

73. The proprietor has shown in evidence that the acceptable variant mark is used prominently on packaging and promotional material, on the goods and within the deli that has been found to have sold the relevant goods at least in 2015 and 2016. It has also shown that the plain word mark True North has been used on the menus in its restaurant, when offering meals to customers. It has claimed that the use on menus and sales of True North meals has been ongoing and continuous since 2016.

74. The applicant has stated that the use of the mark on the menus is flawed as the words 'True North' are presented in the same font and size as the other words on the menu and no TM identifiers are present, e.g. the ® symbol. It has also stated, correctly, that the menus provided in evidence are undated. I find that the use of the words on the menu do constitute trade mark use. I consider that the average consumer when faced with a menu that lists a main meal as 'True North Lightly Smoked Salmon' is likely to

appreciate that the 'True North' element of that meal name should be perceived as a brand name. The lack of an ® symbol does not, in my view detract from the likelihood that consumers will see 'True North' as the brand name attached to the product. Whilst the menus provided in evidence are undated, the proprietor has claimed that they are from 2017. I find that the till summary provided under exhibit CMB4 and the menu extract from exhibit CMB3 support the claim that True North meals were available at the proprietor's restaurant at least during 2016. That being the case, and seeing that these meals were clearly quite popular, generating more than £5,000 of sales in the month of June 2016 alone, I find it highly probable that the proprietor would, as it has claimed, continue to offer these products at its restaurant going forward. I find no reason to disbelieve the proprietor and its claim that it has offered True North meals in the restaurant seasonally, i.e. two or three times a year, during the relevant period. In this regard, the proprietor has stated that between 2016 and 2019 it estimates sales of approximately £50k - £60k.

75. Whilst the initial sales run of salmon products in the deli outlined in evidence does appear to be fairly small in size (the applicant refers to it as 'tiny'), I return to the relevant case law and the fact that there is no *de minimis* rule and I remind myself that an assessment of genuine use is a global assessment, that includes looking at the evidential picture as a whole, rather than whether each individual piece of evidence shows use by itself. The proprietor has shown sales of TRUE NORTH products in 2015 and 2016. This combined with the sales of True North meals in its restaurant, proven in evidence during 2016, and claimed to have been offered regularly between 2016 and 2019, is sufficient to establish genuine use. The fact that the proprietor operates in a small, rural part of Scotland does not, I find, alter the fact that evidence of genuine use has been provided.

76. I find there to have been real commercial exploitation of the mark on the market for the relevant goods in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods that bear the mark. With no *de minimis* rule, I can conclude that the proprietor has shown in evidence that the mark TRUE NORTH has been put to genuine use within the relevant period and on at least a part of the goods in issue.

77. I briefly turn to the issue of disruption of trade due to the Covid-19 pandemic. The proprietor has made submissions to the effect that the pandemic has had a significant impact on its ability to conduct business. In his second witness statement Mr Brown has provided financial figures that show the turnover of his company. It is clear that the turnover of Mr Brown's company dropped significantly from 2019 to 2020. I note for example, that the company turnover more than halved between March-May 2020 from the same period in 2019, going from almost £2.5 million to just over £1 million. However, in this regard, the applicant has rightly pointed out that in fact the period of disruption overlaps with the relevant period in this matter, for no more than 4 months. The majority of the relevant period was unaffected by the pandemic. I conclude that whilst clearly the pandemic has had an impact on Mr Brown's company in the first half of 2020, this is largely academic, as the majority of evidence to which I have attached significance and weight predates the pandemic entirely.

78. Having concluded that the evidence of the proprietor is sufficient to establish that the mark in issue has been used in trade during the relevant period, I must now consider the scope of that use and decide on what amounts to a fair specification.

Fair Specification

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

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

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

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

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

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

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

81. The proprietor’s evidence shows use of the mark in issue in respect of salmon, smoked salmon, and meals consisting primarily of the aforesaid. I do not think however, that the position in this matter is on all fours with the findings in *Pan World Brands*. The

proprietor has made clear throughout its evidence that the focus of the brand TRUE NORTH is on salmon and smoked salmon products. In this regard I find that a wider extrapolation to 'fish' for example, would be unduly generous. The proprietor has shown no evidence of any business activity or trade in other types of fish or in shellfish. The registration in issue covers a wide range of goods including 'fish' as a broad term and 'shellfish'. Taking note of the findings in *Mundipharma AG*, I have considered the issue of overly restrictive limitations to specifications and the possibility of subcategories within a broader or more general term. I conclude however that the proprietor has established itself in evidence as a provider of salmon products only. I consider that this is a market which in my understanding will likely be a specific, niche endeavour unlike e.g. trawler fishing, by which any manner of fish, shellfish and crab/lobster may be brought in within a single haul. Salmon fishing and farming is intended, I believe, to result in only a salmon-based end product and this is the key area of interest of the proprietor, highlighted notably in the presentation document provided under exhibit CCA1, in which no mention of any product other than salmon can be found.

82. Therefore, having considered the evidence in this matter carefully, and notwithstanding the fact that a salmon is a type of fish, I find that the proprietor has shown no evidence of use of the mark in respect of the following goods for which the mark is registered:

Fish and shellfish; fresh fish and shell fish (not live); prepared fish and shellfish; smoked fish; preserved fish; prepared meals consisting principally of fish and/or shellfish; snack foods consisting primarily of fish and/or shellfish; chilled foods consisting predominantly of fish and/or shellfish; frozen fish and/or shellfish; dried fish and/or shellfish; farmed fish and/or shell fish.

83. I conclude that a fair specification in this matter is:

Class 29: Salmon; salmon products; fresh salmon (not live); prepared salmon; smoked Scottish salmon; preserved salmon; prepared meals consisting principally of salmon; snack foods consisting primarily of salmon; chilled foods consisting predominantly of salmon; frozen salmon; dried Salmon; farmed salmon; smoked salmon; smoked salmon products; hot smoked salmon; prepared meals consisting

principally of smoked salmon; snack foods consisting primarily of smoked salmon; chilled foods consisting predominantly of smoked salmon.

Conclusion

84. The revocation action has succeeded in part. Registration No. 3093954 will remain on the register, but only for the goods set out above under paragraph 83.

85. As to the date from which the rights of the proprietor shall be deemed to have ceased in respect of those goods that are revoked, in line with section 46(6)(a), the above changes are effective from 11 July 2020.

Costs

86. As both parties have achieved some measure of success in this matter, I decline to make an award of costs. I direct that both parties should bear their own costs.

Dated this 21st day of December 2021

Andrew Feldon

For the Registrar

The Comptroller-General