

O-965-22

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. WO1067696

IN THE NAME OF ASLAN TİCARET DAYANIKLI TÜKETİM MALLARI LİMİTED  
ŞİRKETİ IN RESPECT OF THE TRADE MARKS

***W.BESTECKHAUS***  
***SCHAFER***

IN CLASSES 8, 11 & 21

AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO. 504240

AND

THE APPLICATION FOR THE REVOCATION THEREOF

UNDER NO. 504241

By HATEX AS GmbH & Co. KG

## BACKGROUND AND PLEADINGS

1. International Registration (“IR”) No. 1067696 stands in the name of ASLAN TİCARET DAYANIKLI TÜKETİM MALLARI LİMİTED ŞİRKETİ (“Aslan”). The IR, as shown on the cover page of this decision, was registered by Aslan on 11 June 2010. On the same date, Aslan designated the UK as a territory in which it sought to protect the IR. The IR achieved protection on 16 September 2011. The goods as registered are as follows:

Class 8: Goods such as forks, spoons, knives including those made of precious metals: knives, forks, spoons, non-electric cheese and egg slicing tools, pizza cutters, peeling tools for vegetables and fruits; cutting weapons and side arms: swords, short swords, daggers, short curved daggers, harpoons (lances); hand operated tools for personal use: electric and non-electric shaving cases, razor blades, razors, electric depilatory implements, scissors, nail clippers.

Class 11: Lighting apparatus: lamps, bulbs, flashlights, chandeliers, lamp glasses, lighting and signaling lamps (bulbs), headlamps, stopping lamps for vehicles, apparatus for heating and steam production installations: boilers for stoves, central heating and natural gas installations as part of heating installation, steam boilers, exchangers, burners, apartment heating apparatus, water heaters used also as apartment heating installations, water heaters, radiators, heat pumps, electrical water boilers, sun energy collectors and devices; solid, liquid and gas fuel and electric stoves, cook stoves; climatization and air-conditioning devices: air conditioners, fans (air blowers), ventilators, air conditioners including those for vehicles; air disinfecting and cleaning instruments and apparatus for places and parts and accessories thereof; cooling apparatus: refrigerators, deep-freezers, ice boxes, ice machines and devices; electric and gas apparatus, machines and devices used for cooking and boiling: sandwich grilling machines, toasters, deep fryers, grills, barbecue grills, ovens, stoves, popcorn machines, autoclaves, coffee and tea machines, water boilers (kettles) and parts thereof; shower tubs, bidets, bath tubs, shower cubicles, urinals, toilet seats, toilet bowls, sinks, wash-hand basins (parts of sanitary installations), parts and fittings for the aforementioned; taps for water

and gas installations, thermostatic valves as parts of heating installation, cocks for automatic watering installations, shower handles and hoses, pipes as parts of sanitary installation; watering machines for agricultural purposes; water softening apparatus, water purifying apparatus, water purifying installations, sewage purifying installations; electric hair dryers, hand drying apparatus, skin moisturizing devices, solarium devices; electrical coverlets and electrical quilts not for medical purposes, heating pillows, electrical or non-electrical foot heaters, hot water bottles; lighters used in kitchen, lighters as parts of heating and cooking apparatus; industrial type ovens; industrial type drying installations; industrial type cooling installations, cooling towers; incandescent burners, acetylene burners and generators; pasteurisers and sterilizers; laundry dryers; cupola furnaces; filters for apparatus used at home, filters as parts of industrial equipment included in this class; barbecue charcoal grills, barbecue grills.

Class 21: Small non-electrical hand-operated devices for household and kitchen use: mixers, blenders, coffee and spice mills, fruit and vegetable presses, grinders and breakers; plates; cleaning necessities (non-electric): brushes (except for painting brushes), brushes for cleaning purposes, materials used for brush making, sponges, steel wool, cleaning wool, cleaning and wiping cloths made of textile, dish-washing gloves, non-electric polishing apparatus, carpet beaters and sweepers, carpet brooms, mops; pads for cleaning purposes; toothbrushes, electrical toothbrushes, dental floss, shaving brushes, hair brushes, combs; household and kitchen articles, table plates made of glass, porcelain, ceramic, common metals, plastic, synthetic substances and other materials: buckets, garbage bins, pots, plates, paper plates and glasses, trays, coffee pots, colanders, serving ladles, spatulas, wash bowls, bowls, egg cups, cake moulds, decanters, food storing containers, glass and pot coasters; flower pots, soap dishes, soap dispensers, paper towel dispensers, toilet paper holders, baby bathtubs, ice trays and ice buckets; heat insulated containers, water bottles, ready picnic baskets (filled with plates), cups given during sports competitions, bread containers, bread baskets, bread-cutting boards (including boards made of synthetic substances); non-electric cooking and heating materials: cookers, heaters, grids, grills, metal cooking skewers; ironing boards,

ironing board covers, clothes racks (for drying), cages for pets, toilet cases, feed and water troughs, bird baths, rings for birds; decorative articles made of glass, porcelain, ceramic, clay: knick-knacks, statues, works of art; bottles, jars, demijohns; porcelain door stops and handles; mousetraps, insect traps, fly catchers, perfume burners (burners giving off scents when lit), perfuming pans, perfume sprays and vaporizers (atomizers); non-electric appliances for cosmetic purposes, non-electric devices for removing make-up, powder puffs, boxes for toilet articles; heads for water sprinklers, watering sprinklers, garden watering sprinklers, bottle openers, shoe horns; toothpicks, plant and animal raising areas used in the household (terrariums).

2. On 12 October 2021, HATEX AS GmbH & Co. KG ("Hatex") filed an application for invalidation against all of the above goods under section 5(2)(b) and an application for revocation under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (the Act). The application for invalidation under section 5(2)(b) is on the basis of the following mark and goods.

**UK909024481**

Mark: Besteckhaus Schäfer

Filing date: 29 March 2010

Registration date: 14 September 2010

For the following goods:

Class 8: Hand tools and implements (hand-operated) for household and kitchen purposes, included in class 8, cutlery; side arms; razors.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and sanitary purposes, in particular grills (kitchen appliances), grills (with rotisserie spits), toasters, coffee machines (electric), water heating apparatus, cooking equipment (electric), included in class 11.

Class 21: Household or kitchen utensils and containers, in particular cooking pot sets, cooking apparatus, non-electric, grills, grill stands, insulated containers, insulated containers for beverages, glassware, porcelain and earthenware, included in class 21.

3. In the statement of grounds Hatex claims that the earlier mark is identical to the later mark apart from the inclusion of the letter W at the beginning which it states will likely go unnoticed by the average consumer. It further adds that the stylisation of the later mark is minimal and does not differentiate the marks. Hatex argues that the marks are highly similar visually, aurally and conceptually. It adds that the goods are identical or highly similar.

4. In response, Aslan denied that there was a likelihood of confusion between the marks. It put forward the position that its own mark is stylised and does not contain an umlaut. It argues that as a whole, the marks look, sound and are conceptually different.

5. In the application for revocation, Hatex claims that Aslan's mark was not put to genuine use within five years of the completion date of the registration procedure (section 46(1)(a)) and, under section 46(1)(b), that use has been suspended for an uninterrupted period of five years between 12 October 2016 and 11 October 2021. Aslan stated within its counterstatement that genuine use has been made by it or with its consent in the UK during the relevant five year period.

6. Both parties provided evidence in these proceedings. Hatex filed submissions and no hearing was requested so this decision is taken following a careful perusal of the papers before me.

7. Aslan is represented by Swindell & Pearson Ltd and Hatex is represented by Wilson Gunn.

8. Hatex's above-mentioned trade mark is an earlier mark, in accordance with Section 6 of the Act. The earlier mark is subject to proof of use requirements as it has been registered for five years or more before the filing date of the proprietor's mark, as per

section 6A of the Act. Aslan has requested that Hatex provides proof of use for its mark.

9. 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **Evidence**

10. Hatex's evidence consists of a witness statement by Burhan Asan, who is the CEO of Hatex, together with seven accompanying exhibits. The main purpose of the evidence is to demonstrate the use that has been made of the earlier mark.

11. Aslan's evidence consists of two witness statements. The first is by Tuncay Aslan who has been the director of Aslan since 7 February 1995. His statement is accompanied by one exhibit. The main purpose of the evidence is to rebut assertions of non-use made by Hatex.

12. The second witness statement is from Yesim Kutyu who has been a director of SEDA GIDA MADDELERI SAN since 12 November 1997. He states that his company buys goods from Aslan and exports them to the UK and sells them on to a UK company called Sema Foods Limited. The main purpose is again to rebut assertions of non-use made by Hatex.

13. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

## **DECISION**

### **The Invalidation**

#### **Section 5(2)(b)**

14. Section 5(2) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. The relevant legislation is as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) 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.

(2D) [...].

(2DA) [...].

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...].

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

15. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### **Proof of Use**

16. I will begin by assessing whether there has been genuine use of the earlier mark.

17. Section 100 of the Act states that:

“100. 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.”

18. Pursuant to section 47(2B) of the Act, there are usually two relevant periods for assessing whether genuine use has been made of the earlier mark. The first is the 5 year period prior to the filing date of the TM26 form by Hatex, so this will be 12 October 2016 to 11 October 2021. The second is the 5 year period prior to the filing of the later trade mark. However, section 47(2B) provides that this does not apply if, at the time of application for the contested mark, the five year period during which the earlier mark should have been put to genuine use has not expired. That is the case here, as the registration procedure for the earlier mark ended after the application date of the earlier mark. I therefore have only one period of use to consider.

19. Hatex’s mark is a UK comparable mark and therefore the practice set out in Tribunal Practice Notice (“TPN”) 2/2020 applies. This states that where use and reputation fall to be considered at any time before IP Completion Day (31 December 2020), I am to take into account use in the EU of the corresponding EU Trade Mark (“EUTM”) or International Registration designating the EU (“IR(EU)”) until IP Completion Day.<sup>1</sup>

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Bundervsvereinigung 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 Marken BV v Hagelkruis Beheer BV*

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<sup>1</sup> Paragraph 4

[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].”

## Evidence

21. Hatex provides (undated) screenshots from their website in Exhibit BH1 which explains the background to the company as being founded in 1999 and the origin of the ‘Schäfer’ part of the name coming from a farmer who had given the founder some wool for his textile company. The page refers to the ‘Schäfer’ brand throughout as exemplified below:

The SCHÄFER claim: nothing but  
beautiful things for those who enjoy  
cooking and moments  
of enjoyment.

Today, SCHÄFER is the main brand of the Hatex Group and fulfills the most important customer requirements: innovation, first-class quality and an optimal price-performance ratio.

22. The website screenshots also shows some examples of goods, some of which bear the ‘Besteckhaus Schäfer’ mark in a stylised manner such as this cutlery set:



23. Other items shown on the website include cooking pots, crockery sets and storage containers. The majority of the branding over the website screenshots refers to the Hatex Group.

24. This version of the mark (albeit in different colours) is used throughout the 2020 product catalogue in Exhibit BH2, an example of which is as follows:



25. This variation is also found in the photographs of goods within stores throughout the EU, although specific details such as dates and places of sale are not mentioned.<sup>2</sup>

26. Hatex provided sales figures in Exhibit BH BH6 and BH7. The figures are broken down into various headings and I have extracted the information under the heading using the mark 'Besteckhaus Schäfer' as follows:

2016: 4 million Euros

2017: 6 million Euros

2018: 5 million Euros

2019: 6 million Euros

2020: 6 million Euros

27. The tables further separate the figures into types of goods. The types of goods listed are as follows: eating utensils, ovens, toaster, coffee maker, samoware, electric kettle, egg stove, cooking pots, frying pans and fresh food tins.

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<sup>2</sup> Exhibit BH4

28. Hatex also provided sample invoices in Exhibit BH3. Although the invoices are in German, I have been able to extract the following information from them (the amounts are calculated using the item numbers provided in Mr Asan's witness statement):

| Date       | Purchaser                    | Country                | Amount(€)–<br>Besteckhaus<br>Schäfer goods only |
|------------|------------------------------|------------------------|-------------------------------------------------|
| 23/4/2021  | IM Trading                   | Germany                | 1650.00                                         |
| 17/8/2020  | POCO<br>Einrichtungsmärkte   | Germany                | 6238.96                                         |
| 17/2/2021  | POCO<br>Einrichtungsmärkte   | Germany                | 25,595.74                                       |
| 3/12/2020  | POCO                         | Germany                | 11,998.00                                       |
| 17/8/2020  | Preisrenner                  | Hamburg,<br>Germany    | 109.98                                          |
| 29/7/2020  | Jawoll Vertriebs             | Stadthagen,<br>Germany | 219.96                                          |
| 31/10/2019 | City Shop                    | Datteln,<br>Germany    | 0                                               |
| 23/11/2020 | NPS North Packets<br>Systems | Hannover,<br>Germany   | 1319.76                                         |
| 16/12/2020 | Guner Semih                  | Austria                | 936.00                                          |
| 5/6/2020   | Kubeysi Aktas                | Belgium                | 109.98                                          |
| 13/10/2020 | Herzstein GmH                | Austria                | 329.98                                          |
| 28/11/2020 | Gokuzum Gultekin             | Belgium                | 239.96                                          |
| 3/4/2019   | Evin Market SAS              | France                 | 53.98                                           |
| 4/6/2019   | Adem Yanik                   | Germany                | 0                                               |
| 13/9/2019  | Burak Guner                  | Austria                | 0                                               |
| 5/2/2020   | Eliran SAFIEV                | Austria                | 53.88                                           |
| 5/2/2020   | Solarema Trading             | Belgium                | 0                                               |

29. Whilst I acknowledge the spread of the invoices over the 2 year period and in four different countries within the EU, Mr Asan confirmed that the only items within these

invoices that were 'Besteckhaus Schäfer' products were those with the item numbers: 10923 and 11647 through to 11659. From the catalogue in Exhibit BH2, I am able to see that the numbers 11647 through to 11659 correlates with cutlery sets, as an example, here is item number 11647:



I cannot however, see a corresponding good for item number 10923. The invoices themselves are headed with the Hatex Group logo or:



30. I have not been provided with figures for marketing and advertising expenditure nor market share.

## Analysis

31. After reviewing the evidence, I can see no use of the mark as registered; however, I note that the mark is a word mark and as such, it may also be used in a range of standard fonts and colours, as well as in upper and lower case.

32. Most of the evidence uses a variation of the mark as shown in paragraph 24 above. I therefore need to consider whether this is an acceptable variant form of the word mark. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the

use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

33. I consider that in the mark as registered, the average consumer would see the words as either invented or as unknown foreign words. They might be able to identify that they are German, but unless they speak this language the words would have no meaning. This would make the words equally distinctive and both would contribute to the overall impression of the mark.

34. Considering the mark as presented in this manner:



I find that the differences of the colours it is presented in would not make a material difference to the overall distinctiveness and indeed would be covered by the mark being registered as a word mark. However, as presented above, the word ‘SCHÄFER’ is presented in a much larger and bolder font than ‘Besteckhaus’. I would consider it to be more than double the size of the former word. The ‘Besteckhaus’ as well as being much smaller in size, is also in a cursive font which is more difficult to read easily compared to the bold capitals that ‘Schäfer’ is presented in. I therefore consider that for this representation of the mark, for the average non-German speaking consumer who cannot assign meanings to these words, the significant size differences between the words and ability to easily read the larger word would mean that the dominant element of this mark is ‘Schäfer’ and the overall impression of this variant therefore differs from the overall impression of the mark as registered. This shift of perception of the dominant element of the mark I believe is supported in the evidence by the references made to ‘the Schäfer brand’ or ‘the Schäfer claim’ from the website

screenshots in Exhibit BH1. I therefore find that this is not an acceptable variant form of the registered mark.

35. For references to 'Schäfer', the main difference between the mark as registered and these is the removal of the first word 'Besteckhaus'. This removal is not one of extraneous or non-distinctive elements. Given I have found the distinctive character to be within the mark as a whole, it must follow that the removal of one of those elements would indeed alter the distinctive character and therefore, this is not an acceptable variant of the mark. I also note within the tables of sales figures in Exhibit BH6, that not only is 'Schäfer' used in addition to the mark as registered but also the following are featured in the tables: Kochtopfhaus Schäfer, Elektronik Schäfer, Schäfer Home & More and Porzellanhaus Schäfer. Given all of these feature the removal of a distinctive element and the addition of further elements, I find that these are also not acceptable variants.

36. Given I can find no use within the evidence of the mark as registered or in the form of an acceptable variant mark, I cannot say that the mark has been sufficiently exploited commercially in the course of trade in order to create or maintain a market for the goods at issue in the EU during the relevant period. The invalidation under section 5(2)(b) therefore fails in its entirety. I will now go on to consider the revocation proceedings.

## **The Revocation**

### **Sections 46(1)(a) and 46(1)(b)**

37. Section 46 of the Act states:

"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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also 4 registered in the name of the proprietor), 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 in 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 existing at an earlier date, that date”.

38. Section 100 is again relevant as well as the case law summarised in *Walton International Ltd & Anor v Verweij Fashion BV*.

39. I note the two periods of use requested by Hatex. The first is the five years following the date of completion of registration. This would be from 11 June 2010 to 10 June 2015. The second five year period is 12 October 2016 to 11 October 2021.

## **Evidence**

40. The evidence provided by Tuncan Aslan mainly comprises of invoices to Seda Gida. Unfortunately, the information from those invoices is limited as they are in Turkish and no translations have been provided. I also consider that these invoices are still to the company within Turkey and not sales made in the UK.

41. There are also invoices to ‘Rimport Ltd’ and I am able to decipher some of the goods within these invoices. The date range of these invoices is between May 2015 to April 2021. The address for Rimport Ltd does appear to be in the UK. I have extracted the relevant information from these invoices below:

- Invoice dated 10/4/2013. Items: Cookware set, deep pot, pot for aubergines, 61 pcs glassware set, electrical tea urn, teapot set, coffeepot set, 7 pcs cookware set, cutlery set, 31 pcs glassware set, bone dinnerware, steel cookware set, porcelain dinnerware set, pressure cooker cake plate spare parts, catalogues, 85 pcs bone dinnerware set, spice set, fork spoon knife,

cookware set, dowry set, pressure cooker, pans, stewpot, cookware set, cake plate. Total Value: £2,810.19. Quantities between 1 and 6

- Invoice dated 13/2/2013. Items: Dinnerware set, breakfast set, dowry set, cutlery set, tea urn, plate spare parts. Total Value: £2313.88.

- Invoice dated 11/12/2012 to Bilkay Ltd in London. Items: Nonstick cookware, fork spoon & knife set, dinnerware, pressure cooker, knife block, pot, frying pan, glassware set, breakfast set, 9 piece storage box, tea set, stewpot, pots, dowry set, teapot. Total Value: £3,804.70.

All the above invoices are shown with customs declaration paperwork.

42. Yesim Kutyu does provide sales figures under the W.Besteckhaus Schafer mark as follows:

In 2015 turnover was at least £ 12.210,28 we sold at least 782 units and our advertising and marketing spend was at least £ \_\_\_\_\_.

In 2016 turnover was at least £ 20.339,70 we sold at least 2763 units and our advertising and marketing spend was at least £ \_\_\_\_\_.

In 2017 turnover was at least £ 36.179,12 we sold at least 1241 units and our advertising and marketing spend was at least £ \_\_\_\_\_.

In 2018 turnover was at least £ 5.023,78 we sold at least 334 units and our advertising and marketing spend was at least £ \_\_\_\_\_.

In 2019 turnover was at least £ 5.650 we sold at least 317 units and our advertising and marketing spend was at least £ \_\_\_\_\_.

In 2020 turnover was at least £ 10.958,87 we sold at least 650 units and our advertising and marketing spend was at least £ \_\_\_\_\_.

In 2021 turnover was at least £ 747,84 we sold at least 87 units and our advertising and marketing spend was at least £ \_\_\_\_\_.

43. Yesim Kutyu also provides invoices and customs declarations however, I cannot see any reference to the 'W.Besteckhaus Schafer' mark on these invoices nor any goods related to them.

## Analysis

44. As highlighted by section 46(1)(a) above, genuine use of the mark has to be shown “by the proprietor or with his consent”.

45. I note that the proprietor of the mark is Aslan; however, as per the witness statements of Tuncay Aslan and Yesim Kuytu, it is confirmed that one of Aslan’s largest customers is ‘SEDA GIDA MADDELERİ SAN’ (‘Seda Gida’) and that this company exports the goods to the UK and sells them to a UK company called Sema Foods Limited. Tuncay Aslan does state within his witness statement that this is carried out with Aslan’s consent.

46. Once again, I have no evidence showing use of the mark as it is registered. The only variation I have found within the evidence is located on the invoices in Exhibit 1 of Tuncan Aslan’s evidence as shown below:



47. There is no indication from the evidence as to how the marks in question might have appeared to the consumers. Further, there is nothing confirming that the goods listed (even if they are covered by the IR) within the invoices were put on the market in the UK. Even if I were to find that the goods listed were relevant goods found on the market in the UK, I do not find the above marks to be acceptable variants to the mark as registered. The same reasoning set out in the invalidation decision above (paragraphs 34 & 35) will apply equally to these variations as well.

48. The evidence provided by Yesim Kuytu is of limited assistance. The invoices are from Seda Gida to Sema Foods which is consistent with the distribution arrangement described in his witness statement. However, there is no reference to the mark or the goods sold under the mark whatsoever and a lot of the evidence again has not been

translated. It is not clear how, or even if, the mark would have been seen by the UK consumer.

49. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, 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.”

50. The onus is on the proprietor to provide sufficiently solid evidence to counter the application.<sup>3</sup> I cannot see anything from the evidence which suggests that the UK consumer would have had sight of the mark. This, together with no use of the mark as registered or use of an acceptable variant means that I consider the evidence fails to show real commercial use of the mark in relation to the goods in Aslan’s specification.

## **Conclusion**

51. The application for invalidity under section 5(2)(b) fails in its entirety.

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<sup>3</sup> See *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14)

52. The application for revocation under sections 46(1)(a) and (b) succeeds and the effective date of revocation of the designation is 17 September 2016.

### **Costs**

53. The guidance for awards of costs are set out in TPN 2/2016.

54. On reviewing the matters at hand, I consider that as the invalidation has failed and the revocation succeeded the fairest basis to deal with costs is for each party to bear their own in this matter.

55. I therefore make no award of costs in this matter.

**Dated this 7th day of November 2022**

**L Nicholas**  
**For the Registrar**