

O/0101/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003749701
BY THE ESTATE OF THE LATE SONIA BROWNELL ORWELL
TO REGISTER THE TRADE MARK:

1984

IN CLASSES 18, 21, 25, 28 AND 45

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600002379
BY MISS JOAN MARY TAYLOR

AND

IN THE MATTER OF UK TRADE MARK REGISTRATION NO. UK00003102740
IN THE NAME OF MISS JOAN MARY TAYLOR
FOR THE TRADE MARK:



IN CLASS 25

AND

THE APPLICATION FOR REVOCATION THEREOF
UNDER NO. 504889
BY THE ESTATE OF THE LATE SONIA BROWNELL ORWELL

BACKGROUND AND PLEADINGS

1. On 6 March 2018, The Estate of the Late Sonia Brownell Orwell (“the Estate”) applied to register the trade mark shown on the cover page of this decision in the European Union. The Estate subsequently applied for the same mark in the UK on 30 June 2021. In accordance with Article 59 of the Withdrawal Agreement between the UK and the European Union, by filing an application for the same mark in the UK within nine months of the end of the transition period, the Estate’s mark is deemed to have the same filing date as the EU mark. Therefore, the deemed filing date of the application in these proceedings is 6 March 2018.

2. The application was published for opposition purposes on the 4 March 2022, and the Estate seeks registration for the following goods and services:

Class 18 Leather and imitations of leather; luggage; trunks and travelling bags; tote bags; rucksacks; umbrellas and parasols; backpacks; walking sticks; briefcases; wallets; purses; bags; parts and fittings for all of the above goods.

Class 21 Household and kitchen utensils and containers; Cookware and tableware; small domestic utensils and containers; cosmetic and toilet utensils; combs and sponges; lunch boxes; cups; crockery; bowls; cutlery trays; wash bags; cosmetic bags; oven gloves; oven mitts; travel cups and mugs; mugs; plates; paper plates; paper cups; dishes; saucers; glasses; tankards; money boxes; decorative plates; ornaments, namely, statues, figurines, plaques and works of art, made of materials such as porcelain, terra-cotta or glass; plaques, statues and figurines; articles made of ceramics, glassware, porcelain and earthenware; parts and fittings for all of the above goods.

Class 25 Clothing, footwear, headgear; underwear, outerwear, suits; coats, gloves, shirts, t-shirts, jumpers, belts, tops, pyjamas, gowns, beachwear, socks, hats, scarves, ties, caps; parts and fittings for all the above goods.

Class 28 Games, toys and playthings; decorations for Christmas trees; electronic games; board games; costume masks; playing cards; action figures; figurines; electrical and video amusement apparatus and instruments; peripheral devices for use with home video game machines; amusement apparatus for use with a television monitor or some other form of display apparatus; jigsaws; card games; gymnastic and sporting articles not included in other classes; amusement apparatus adapted for use with television receivers; interactive games adapted for use with television receivers; parts and fittings for all of the above goods.

Class 45 Political consultancy services; provision of political and public affairs information; government relation services; research and information services relating to political and public affairs; political and public affairs communications; on-line social networking services; lobbying services; advisory, consultancy and information services for all of the above services.

3. The application was opposed by Miss Joan Mary Taylor (“Miss Taylor”) on 26 May 2022. The opposition is based upon section 5(1) of the Trade Marks Act 1994 (“the Act”) and Miss Taylor relies on the following trade mark:



UK registration no. UK00003102740

Filing date 7 April 2015.

Registration date 24 July 2015.

Relying upon all goods for which the earlier mark is registered, namely:

Class 25 Clothing.

4. Miss Taylor claims that the marks are identical, and that all of the goods and services applied for by the Estate are identical to the goods registered under Miss Taylor's earlier registration.

5. The Estate admits that "the Mark is substantively similar to the Earlier Mark" but denies that the good and services are identical.

6. On 20 May 2022, the Estate sought revocation of Miss Taylor's mark on the grounds of non-use. Under section 46(1)(a) of the Act, the Estate claims non-use in the five year period following the date on which the mark was registered, i.e. 25 July 2015 to 24 July 2020, claiming an effective date of revocation of 25 July 2020.

7. On 22 August 2022, Miss Taylor filed a counterstatement defending her registration for all the goods for which it is registered, on the basis that it has been used throughout the relevant period.

8. On 22 December 2022, the Tribunal wrote to the parties informing them of the consolidation of the revocation action no. 504889 and the opposition no. 600002379.

9. Miss Taylor is unrepresented and the Estate is represented by Sipara Limited. Miss Taylor filed evidence alongside her Form TM8(N), and a witness statement with exhibits during the evidence rounds. Neither party requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

11. Miss Taylor filed evidence in the form of a witness statement of Miss Joan Mary Taylor dated 23 February 2023. Miss Taylor is the owner of the TUTU Urban Boutique, a company which claims it has been using the 1984 trade mark. Miss Taylor's statement was accompanied by 7 exhibits (JMT1-JMT7).

12. Whilst I do not propose to summarise the evidence and submissions here, I have taken them into consideration and will refer to them below where necessary.

DECISION

The Revocation

13. 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) [...]

(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 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 is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

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

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

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

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

14. 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.**” (My emphasis)

15. 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 Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, 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].”

16. I remind myself that the relevant period within which use of the mark has been challenged is the five year period of 25 July 2015 to 24 July 2020.

17. I therefore note the following from Miss Taylor’s evidence:

a) In her witness statement, Miss Taylor claims that the “1984 branded product includes, but [is] not limited to, hats, scarves, trousers, jogging bottoms, jeans, camisoles, long and short coats of various types, leather, multi-fabric and faux-fur, dresses, skirts, various knitwear, ponchos, leather, wool and multi-fabric gloves, shirts, blouses and T-shirts”.

b) **Exhibit JMT5** contains evidence of “sales of 1984 branded product and collections between 2016 and 2020” in the form of data sheets. Miss Taylor states that in early 2016 the “1984 branded product was being sold as part of our French Clothing range. It was then decided that all of our collections supplied from France would entirely be sold as my 1984 branded collection”. I note that this is confirmed by the following data sheet from 2017:

TUTU URBAN BOUTIQUE One Exchange Arcade Nottingham NG1 2DD Tel: 0115 947 0189 e-mail: tutu.urbanboutique@aol.co.uk									
FINAL SELL THROUGH DATA SHEETS Autumn/Winter 2016									
DATE	SHEET: 1 OF 4	MANUFACTURER							
Period: to 20th February 2017	Ex-Collection	Made in Italy	ZO	French Jewellery	French Clothing	Parisi	Cash-Co		
Sales Revenue to 18th January	31533 00	31900 00	9677 00	3387 00		2605 00	1192 00		
15.02.17 - 21.02.17	1895 00	475 00	158 00	0 00		0 00	72 00		
22.02.17 - 28.02.17	1837 00	746 00	79 00	89 00		0 00	426 00		
29.02.17 - 04.03.17	1547 00	783 00	119 00	0 00		0 00	63 00		
05.03.17 - 11.03.17	879 00	980 00	0 00	404 00		0 00	0 00		
12.03.17 - 18.03.17	995 00	932 00	69 00	227 00		0 00	0 00		
19.03.17 - 25.03.17	528 00	338 00	0 00	0 00		0 00	0 00		
Gross Sales Rev (incl VAT) GSR	39299 00	33405 00	8302 00	4176 00		0 00	5766 00		
Net Sales Revenue (incl VAT) NSR		27838 00	6752 00	3480 00		0 00	2221 00		4805 00
Purchase Cost (incl VAT) PC		7305 00	2338 00	955 00		0 00	3504 00		2232 00
PC Balance: PCB (-) / NBK (+) PCB		20533 00	4633 00	2579 00		0 00	1157 00		2673 00
Potential Sales Revenue (incl VAT) PSR (= purchase cost + margin)		40623 00	9671 00	8179 00		0 00	3236 00		8250 00
Margin (to nearest 0.05%)	N/A	5.55	4.55	9.05	0	3.00	3.00		
Sell Through % required (to achieve overall profitability)	N/A	55 = 33.6%	55 = 38.6%	55 = 19.4%		55 = 58.5%	55 = 58.5%		55 = 58.5%
		65 = 38.3%	65 = 44.3%	65 = 22.4%		65 = 67.5%	65 = 67.5%		65 = 67.5%
		PU = 41.4%	PU = 50.2%	PU = 25.4		PU = 76.5%	PU = 76.5%		PU = 76.5%
Sell Through (-) GSR/PSR x 100%	N/A	82.2%	83.8%	51.5%	0%	82.9%	89.5%		

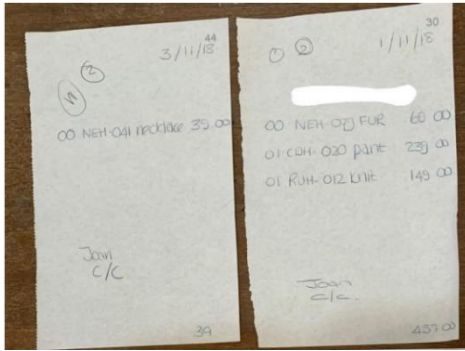
c) I therefore note the following sales figures from **exhibit JMT5**:

Period	Season	Collection name	Gross Sales Rev (with VAT)
To 3 rd September 2016	Spring/Summer 2016	French clothing	£6,059
To 25 th February 2017	Autumn/Winter 2016	1984	£6,047
To 2 nd September 2017	Spring/Summer 2017	1984	£672
To 21 st January 2018	Autumn/Winter 2017- week 03	1984	£3,763
To 2 nd September 2018	Spring/Summer 2018- week 35	1984	£5,505
To 3 rd February 2019	Autumn/Winter 2018- week 05	1984	£11,858
To 25 th August 2019	Spring/Summer 2019- week 34	1984	£7,153
To 19 th January 2020	Autumn/Winter 2019- week 04	1984	£3,155

d) The above turnover figures also correlates with the figures provided by Miss Taylor in her witness statement. The revenue above also totals £44,212, however, this includes VAT. Therefore, minus 20% of the revenue, Miss Taylor made (approximately) £36,843 from “1984” sales.

e) In **exhibit JMT5**, Miss Taylor states that by early 2020, she and her business was affected by Covid-19, and then by the subsequent lockdowns, and therefore no “Sell Through Data” was produced for the years 2020 and 2021.

f) The above turnover figures are supported by evidence contained in **exhibit JMT4**. In this exhibit, Miss Taylor explains that since the Autumn/Winter 2015 they have used a three letter product code, using letters alphabetically as the suffix. For example, Miss Taylor states that the “H” suffix was used for the Spring/Summer of 2018 as well as the Autumn/Winter 2018 season. This is evidenced by the following 2 customer receipts (dated 1st and 3rd November 2018) attached to Miss Taylor’s counterstatement, and a data sheet which confirms the 2018 product code for the 1984 products was “NEH” (using the H suffix):



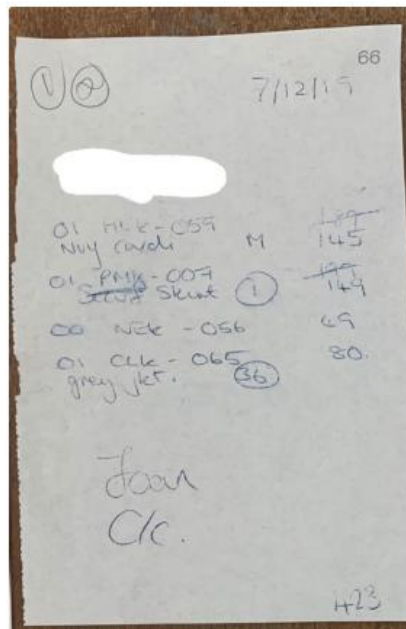
TUTU URBAN BOUTIQUE
 One Exchange Arcade Nottingham NG1 2DD Tel: 0115 941 5376
 e-mail: tutu.urbanboutique@aol.com

SELL THROUGH & PURCHASE COST DATA - AW 2018
WEEK 44: Ending Sunday 4th November 2018

Supplier/Product	Purchase Cost (excluding VAT)	Potential Sales Revenue (including VAT)	Margin	Weekly Sales Revenue (including VAT)
Ex Collection				
Made in Italy (MIH)				
Bright Choice (ZOH)				
1984 (NEH)	3150	15056		462

g) The data sheet above also indicates that for week 44, ending Sunday 4th November 2018, the weekly sales revenue for 1984 goods was £462. I note that it is unclear whether this figure is factored into the above gross sales for “Autumn/Winter 2018- week 05” contained within the above table at 17(c).

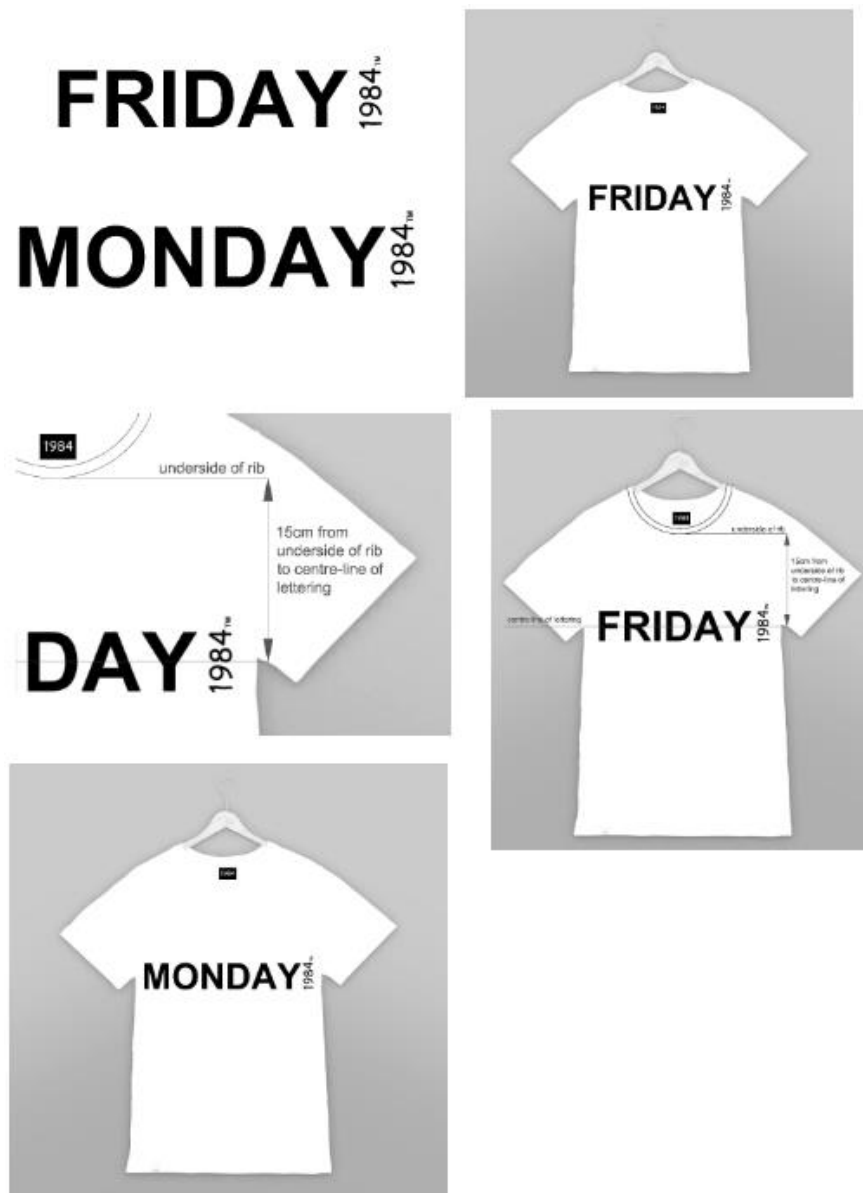
h) In **exhibit JMT4**, Miss Taylor also explains that the letters J and K were used as suffixes for the 2019 seasons. This is supported by the receipt evidence below, which were attached to Miss Taylor’s counterstatement which “shows the sale of a 1984 product, coded NEK, for £49 on 7 December 2019”:



i) All of the data sheets exhibited in **JMT5** which shows sales for the 1984 collection list a Nottingham address for Miss Taylor’s TUTU Boutique. In **exhibit JMT6**, Miss Taylor states that “I do not sell my collections online” and therefore

I consider that all of the above sales were made from Miss Taylor’s Nottingham store only.

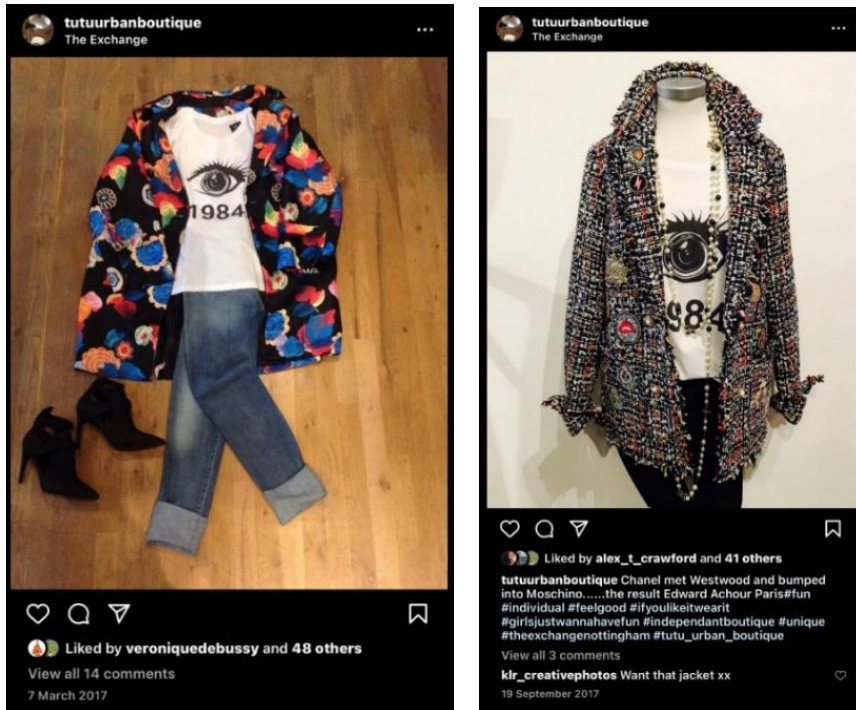
- j) Also attached to the counterstatement is email evidence showing that an order (albeit no product amount is noted) was placed on 22 February 2017 with Garment Printing for 1984 Monday and Friday T-shirts. I note that specifically in an email between Garment Printing and Miss Taylor’s “in-house graphic designer” Orion Design, it says, “I have attached the logo in a jpeg format @300 dpi as provided for the 1984 T-shirt you printed for TUTU Urban Boutique last week”, and the attachment is shown as follows:



- k) The above email evidence is also contained in **exhibit JMT2**.
- l) I note that the above evidence does show a neck hem label which appears to use Miss Taylors "1984" mark. "1984" is also presented vertically on the front of the t-shirts at the end of the day (either MONDAY or FRIDAY), which appears to feature a small "TM" next to it which is intended to signal trade mark status. However, it is unclear whether the "TM" would be understood as pertaining just to the "1984" element or to "MONDAY1984"/"FRIDAY1984" as a whole. Moreover, there is no evidence of how the goods actually looked once they had been ordered, for example, I have no photographic evidence of the t-shirts being sold in Miss Taylor's store after the above order had arrived.
- m) The above t-shirt design order evidence is supported by **exhibit JMT1** which contains two invoices from "garmentprinting". Miss Taylor states that these orders were placed for the printing of the above 1984 T-shirts. The invoice dated 14 February 2017 contains an order of 20 (10 white size medium and 10 white size large) which amounts to £159.60. The invoice dated 15 May 2017 contains an order of 23 (10 white size medium and 13 white size large) which amounts to £174.36.
- n) Ms Taylor also states that **exhibit JMT3** contains a document showing an order placed for the printing of 1984 swing tags, and invoices for these were issued in August and September 2016. She therefore states that it "clearly demonstrates that 1984 branded product was being purchased and sold in my shop TUTU Urban Boutique in 2016". However, I note that the only evidence contained in this exhibit is the following:



- o) Lastly, **exhibit JMT7** contains the two following screenshots from Instagram dated March and September 2017:



- p) The screenshot above on the right-hand side does not clearly show Miss Taylor's mark being used on the t-shirt as it is obscured by the jacket and necklace accessories. It is noted that the screenshot above on the left-hand side does clearly show "1984" presented on the t-shirt, which has a swing tag, but I am unable to determine what is written on it because it is obscured by the t-shirt material. It is also noted that both posts have less than 50 likes.

Form of the mark

18. It is well established in case law that the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark, taken as a whole or in conjunction with that other mark (whether or not that other mark is also registered).

19. However, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the

origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of the Act.¹

20. 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 *hyphen 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

¹ See for instance the Court of Justice of the European Union (“CJEU”) in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, particularly at paragraphs 31-35.

it is supposed 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”.

21. Miss Taylor’s mark as registered is:

1984

22. The evidence I have outlined above includes instances of the following variants:

1) 1984

2) **MONDAY** 1984™

3) **FRIDAY** 1984™

4)



23. Variant 1 is the number “1984”. I note that this number fully appears in Miss Taylor’s registered mark, though here it is presented in the colour white, in a standard typeface, on a black background. I consider that the distinctive character of Miss Taylor’s mark lies in the number “1984” and therefore the different presentation of this element does not alter the distinctive character of the mark, nor does it prevent Miss Taylor’s mark from continuing to indicate origin. Variant 1 is therefore acceptable use of Miss Taylor’s mark.

24. Variant 2 is used on the front of a t-shirt illustration, and consists of the word “MONDAY” presented in a black capitalised standard typeface, with the number “1984” presented separately and vertically at the end of it. As noted above, the distinctive character of Miss Taylor’s mark lies in the number “1984” and therefore the different presentation of this element, in black on a white background, and even its running vertically does not alter the distinctive character of the mark. I also note that at the top right-hand corner of the “1984” element are the letters “TM”, which are intended to signal that “1984” is a trade mark. It is possible that a consumer would see the “TM” (if they notice it at all) as relating to the whole text- “MONDAY 1984”- but since the letters TM have the same alignment as the four numbers, the “1984” component may be seen as a separate brand element. I also note the neck hem label in the order illustration of the t-shirts shows pretty much the mark as registered, with no reference to “MONDAY”. I am, therefore, prepared to accept that the “1984” element of variant 2 continues to indicate origin and is acceptable use of Miss Taylor’s mark.

25. Variant 3 is similar to variant 2, with the word “FRIDAY” being used instead of “MONDAY”. The same considerations apply as in paragraph 24 above, and I am prepared to accept variant 3 as use of Miss Taylor’s mark.

26. Variant 4 consists of an eye device (with the iris being a camera lens), and the “1984” element presented underneath, in a black standard typeface. As noted above, the distinctive character of Miss Taylor’s mark lies in the number “1984” and the different presentation of this element (in black on a white background) would not alter the distinctive character. I also note that as both elements are clearly separate, the “1984” element would be able to continue to indicate origin. However, the swing tag on this garment is not clearly displayed (as it is obscured by the t-shirt material), there

is no neck hem label, and in this instance, the letters “TM” are not used to help indicate that the “1984” element is a mark denoting origin of the goods. Whilst it is not imperative that marks be presented with the letters “TM”, it is noted in this instance as a factor which may have helped, because it is more likely that the average consumer would see the “1984” element purely as the design or decoration being used on the front of a t-shirt. I therefore consider that variant 4 is not acceptable use of Miss Taylor’s earlier mark.

Assessment of genuine use

27. As (with reservations) I have found the evidence to show acceptable variant uses, I will now consider the global assessment of genuine use. The assessment is made by looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.² As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

28. As noted above, the onus is also on Miss Taylor to provide sufficiently solid evidence to counter the application that she has not used the mark within the contested five year period.³ In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Daniel Alexander Q.C. (as he was then) 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,**

² *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

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

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". (My emphasis).

29. Whilst I have not been provided with any market share figures, I have been provided with turnover figures for the years 2016 to 2019, which in total amounts to £44,638 (which includes the £426 turnover referred to in paragraph 17(g)). Considering this number is accumulated over a five year period, and that 20% of it appears to be attributable to value added tax, I consider that it is low, especially as it is in relation to clothing goods, which is a large market within the UK. I also bear in mind that Miss Taylor does not sell online, and therefore all of these sales pertain to her Nottingham store only (and thus the sales are not geographically spread).

30. In the appeal case *Jumpman* BL O/222/16, Mr Daniel Alexander QC, as the Appointed Person, upheld the registrar's decision to reject the sale of 55k pairs of training shoes through one shop in Bulgaria over 16 months as insufficient to show genuine use of the EU trade mark in the European Union within the relevant 5 year period. In Miss Taylor's case, whilst the sales have been made in one store located in the UK, which is of course geographically smaller than the EU, the turnover made over a longer period of time (5 years) is much lower.

31. There are significant deficiencies in the minimal evidence filed by Miss Taylor, such that it is insufficient to establish a real commercial exploitation of the mark in the sector. For example, the above turnover figures, which are supported by data sheets for 2016 to 2020, shows sales for the "1984 collection", however, this is not broken down into product type. Consequently, I have no way of knowing what proportion of these sales relate to the goods in issue; this is particularly important given that Miss Taylor is relying upon "clothing" as a whole, which is a very broad category. Indeed, Miss Taylor states that sales under the mark have been made in respect of "hats,

scarves, trousers, jogging bottoms, jeans, camisoles, long and short coats of various types, leather, multi-fabric and faux-fur, dresses, skirts, various knitwear, ponchos, leather, wool and multi-fabric gloves, shirts, blouses and T-shirts"- but the corroborating evidence appears to relate only to t-shirts. The evidence indicates that 43 t-shirts were ordered in 2017 using the "1984" mark, but I have not been provided with any supporting evidence that these goods were sold during the relevant period. There is barely any evidence of the mark used on the real-life goods themselves; whilst there is an image of a real t-shirt at **JMT7**, as noted in paragraph 26 above, this does not amount to genuine use of Miss Taylor's mark. Moreover, I have not been provided with any evidence detailing how many units of goods (broken down into product type) have been sold by Miss Taylor, nor have I been provided with a pricing list for its clothing goods, which is all plainly information which should have been available and relatively easy to provide.

32. The three hand-written customer receipts dated November 2018 and December 2019 exhibited to support the above sales figures also raises issues. Firstly, the 2019 invoice shows the sale of "NEK- 056" for £49, but Miss Taylor provides no submissions or further evidence to clarify what this product is. Secondly, one of the 2018 invoices is for the sale of "NEH-041- necklace", which as noted by the Estate, falls within class 14, and therefore does not fall within the specification being relied upon. Lastly, the second 2018 invoice shows the sale of "NEH-079 FUR" for £69. The Estate submits that there is no explanation of what this product is and there is no evidence provided to show the product under the item code. Whilst I note that multiple goods could be made from "fur", based upon the claims made in Miss Taylor's witness statement contained in paragraph 17(a) above, this sale could have been in relation to a faux-fur coat. However, I do not have any supporting evidence of if and how Miss Taylor's mark would have been used on this product.⁴

33. In cases where there is a low volume of sales, other factors can support and establish genuine use. For example in *Industria de Diseño Textil, SA (Inditex) v EUIPO*, T-467/20, EU:T:2021:842, the GC held that representative invoices showing

⁴ The swing tag evidence only pertains to the year 2016. Miss Taylor did not clarify or file further evidence as to whether the same swing tags were also used on their products from 2017 to 2020.

sales of pasta in Italy totalling something over €40,000 were sufficient to show genuine use in the EU, when taken together with marketing material and evidence of regular use over the relevant period. This included two catalogues in electronic form, two promotional documents listing the various activities of the party, samples of packaging and advertisements, 25 invoices addressed to companies over a 5 year period and 5 invoices dated over a 4 year period relating to its participation in a trade fair.

34. However, in the present case, I have been provided with no advertising figures, and the only evidence of Miss Taylor's advertising is two Instagram screenshots, both of which are from 2017. The Estate submits that there is no evidence of any sales of this t-shirt, nor is there a price on the posts and that "the comments indicate that it is the jackets which are the pieces which are being promoted, the t-shirt may not be for sale and could just have been used as part of the "dressing" of the other product(s)". Regardless, the Instagram evidence pertains to t-shirts using variant 4, which is not acceptable use of Miss Taylor's earlier mark and therefore cannot be considered.

35. Therefore, taking the evidence as a whole into account, I consider that it fails to show real commercial exploitation of the mark to create or maintain a share of the UK market for Miss Taylor's class 25 "clothing" goods.

Conclusion for the Revocation

36. The application for revocation on the grounds of non-use therefore succeeds under section 46(1)(b). The UK00003102740 registration will be revoked in respect of all goods for which it is registered. When the registration of a trade mark is revoked, its proprietor's rights cease from the date of the application for revocation, or from an earlier date if the registrar is satisfied that the grounds for revocation existed at that earlier date. The Form TM26(N) prompts (at Q1) an applicant for revocation to state the date from which it requests revocation to take effect, noting that the first possible effective date is the day following the end of the five year period of non-use.

37. In the present case, the requested date for revocation is **25 July 2020**, and in view of my conclusions on the insufficiency of the evidence of use, I find that the contested mark registration may be revoked from that date.

The Opposition

38. As explained in paragraph 1 of this decision, the deemed filing date of the Estate's mark is 6 March 2018. This date is two years before the date from which Miss Taylor's UK00003102740 registration is revoked.

39. Consequently, as Miss Taylor's mark was operative and valid on 6 March 2018, it can still be relied upon in the opposition proceedings.

Section 5(1)

40. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

41. The earlier mark had not completed its registration process more than five years before the relevant date (the priority date of the Estate's mark- the deemed filing date). Accordingly, the use provisions at section 6A of the Act do not apply. Miss Taylor may rely on her goods as registered – i.e. “clothing” whether or not she has been able to show use of the mark in respect of those goods.

Identity of the marks

42. It is a prerequisite of section 5(1) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

43. The Estate's word mark consists of the number "1984", written in a standard black font. Miss Taylor's earlier mark consists of the number "1984", written in a standard white font presented on a black square background.

44. If the Estate's mark were to be put on a black background, in order for the user to see it, it would have to be presented in a different colour, including the colour white (which is covered by fair use of word marks). On this basis, I therefore consider that, based on the case law above, the parties' marks are identical.

Comparison of goods and services

45. It is a well-established principle of case law that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.⁵ In essence, if goods or services fall within the ambit of terms within the competing specification, they are considered to be identical.

46. Another well-established principle from case law is that "trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. Nevertheless the principle should not be taken too far. [...] Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question".⁶

Class 25

47. "Clothing" appears identically in both specifications.

48. The Estate's "underwear", "outerwear", "suits", "coats", "gloves", "shirts", "t-shirts", "jumpers", "tops", "pyjamas", "gowns", "beachwear", "socks" and "scarves" fall within

⁵ *Gérard Meric v OHIM*, Case T- 133/05, the General Court, at paragraph 29.

⁶ *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was).

the broader category of “clothing” in Miss Taylor’s specification. The goods are identical on the principle outlined in *Meric*.

49. However, the Estate’s remaining terms are not identical to Miss Taylor’s “clothing” for the following reasons:

Footwear.

50. Footwear covers different types of shoes which are to be worn on the user’s feet, and clothing are items or garments which are worn to cover the user’s body. They are therefore worn in such a different way that the method of use, nature and purpose of the goods differ. The goods are, therefore, clearly not identical.

Headgear; hats; caps.

51. The above goods are worn on a user’s head with the purpose of keeping it warm, or shielding the user’s eyes and face from the sun, whereas the core meaning of “clothing” refers to items or garments worn to cover a user’s body. While the head is part of the human body, in the context of clothing oneself, the head is typically considered different from the rest of the body. In my view, it would not be “straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question” to construe “clothing” as not being identical to “headgear”, “hats” and “caps” nor vice versa. It is not common parlance to refer to hats or caps as clothing; they would be considered as headgear. There are differences in nature, purpose and method of use and I therefore find that they are not identical goods.

Belts; ties.

52. I note that belts are used hold up garments, such as a pair of trousers or a skirt, and ties are a piece of material, which is placed under a shirt collar and paired with a suit. I note that belts and ties can also be worn purely for fashionable purposes. Although belts and ties may be said to be worn on the user’s body, I consider that they are clothing accessories and therefore not identical to “clothing”. I also consider that to include clothing accessories in the term “clothing” would be a liberal interpretation

which would broaden the term too widely, making it “fuzzy and imprecise”. This is especially the case as clothing accessories (which includes ties and belts) and clothing are different in nature and purpose, and the goods are to be worn in such a different way that I do not consider that they overlap in method of use. Consequently, I do not consider “belts” and “ties” to be identical to “clothing”.

Parts and fittings for all the above goods.

53. As set out in *Les Éditions Albert René v OHIM*,⁷ it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods.

54. In this instance, I do not consider that parts of clothing are identical to clothing itself because the respective goods include differences in use, user, and nature. There would tend to be different trade channels as the applicant’s parts of clothing would normally be purchased wholesale to be used in the production of the finished article, which would then be on sale to the general public. Taking the above into account, the goods are clearly not identical.

Class 18, 21, 28 and 45

55. It is obvious that the Estate’s leather and bag goods in class 18, household and kitchenware in class 21, toys and games in class 28 and political services in class 45 are not identical to Miss Taylor’s class 25 clothing.

Conclusion for the Opposition

56. It is a prerequisite of section 5(1) that the goods be identical. Therefore, the opposition based upon section 5(1) partially succeeds for the following goods:

Class 25 Clothing; underwear, outerwear, suits; coats, gloves, shirts, t-shirts, jumpers, tops, pyjamas, gowns, beachwear, socks, scarves.

⁷ Case T-336/03

57. I have found that the remaining goods and services are not identical. Consequently, the application can proceed to registration in respect of the following goods and services, for which the opposition based upon section 5(1) has been unsuccessful:

Class 18 Leather and imitations of leather; luggage; trunks and travelling bags; tote bags; rucksacks; umbrellas and parasols; backpacks; walking sticks; briefcases; wallets; purses; bags; parts and fittings for all of the above goods.

Class 21 Household and kitchen utensils and containers; Cookware and tableware; small domestic utensils and containers; cosmetic and toilet utensils; combs and sponges; lunch boxes; cups; crockery; bowls; cutlery trays; wash bags; cosmetic bags; oven gloves; oven mitts; travel cups and mugs; mugs; plates; paper plates; paper cups; dishes; saucers; glasses; tankards; money boxes; decorative plates; ornaments, namely, statues, figurines, plaques and works of art, made of materials such as porcelain, terra-cotta or glass; plaques, statues and figurines; articles made of ceramics, glassware, porcelain and earthenware; parts and fittings for all of the above goods.

Class 25 Footwear, headgear; belts, hats, ties, caps; parts and fittings for all the above goods.

Class 28 Games, toys and playthings; decorations for Christmas trees; electronic games; board games; costume masks; playing cards; action figures; figurines; electrical and video amusement apparatus and instruments; peripheral devices for use with home video game machines; amusement apparatus for use with a television monitor or some other form of display apparatus; jigsaws; card games; gymnastic and sporting articles not included in other classes; amusement apparatus adapted for use with television receivers; interactive games adapted for use with television receivers; parts and fittings for all of the above goods.

Class 45 Political consultancy services; provision of political and public affairs information; government relation services; research and information services relating to political and public affairs; political and public affairs communications; on-line social networking services; lobbying services; advisory, consultancy and information services for all of the above services.

COSTS

58. In these consolidated proceedings, the Estate has enjoyed a greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.

59. I also note that on 14 September 2023, the Estate requested a CMC after the Registry admitted Miss Taylor's late submissions in lieu into the proceedings. In the post CMC letter dated 17 October 2023, the Hearing Officer upheld and directed that Miss Taylor's submissions in lieu be admitted. I note that no prejudice was suffered by the Estate by admitting the late submissions and therefore, in this instance, I will not be awarding any costs in regard to their attendance of the CMC.

60. Taking all of the above into account, in the circumstances, I award the Estate the sum of **£600** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£150
Preparing and filling submissions in lieu	£250
Official fee for filing Revocation	£200
Total	£600.

61. I therefore order Miss Joan Mary Taylor to pay The Estate of the Late Sonia Brownell Orwell the sum of £600. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 12th day of February 2024

L FAYTER

For the Registrar