O/0366/24

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3746909
IN THE NAME OF ATHENRY SPIRITS LIMITED

AND IN THE MATTER OF OPPOSITION
THERETO
UNDER NO. 436861
BY CAROLANN ELAINE CASSIDY

AND

IN THE MATTER OF UK REGISTRATION NO. 912929791
IN THE NAME OF CAROLANN ELAINE CASSIDY

AND THE APPLICATION FOR REVOCATION
THEREOF
UNDER NO. 504978
BY ATHENRY SPIRITS LIMITED

BACKGROUND AND PLEADINGS

1. There are two actions involved in these consolidated proceedings,[1] namely:

(i) one opposition brought by Carolann Elaine Cassidy ("CEC") against a trade mark application filed by Athenry Spirits Limited ("ASL"); and

(ii) one application for the revocation of a trade mark registration owned by CEC, brought by ASL.

(i) The opposition

2. On 24 January 2022, ASL applied to register "**ATHENRY**" as a trade mark in the United Kingdom. The application was accepted and was published for opposition purposes on 8 July 2022 in respect of the following goods:

Class 33: *Alcoholic beverages (except beers); distilled beverages; spirits [beverages]; vodka; whiskey; whisky; gin.*

3. The application is opposed by CEC. The opposition was filed on 10 October 2022, and is based upon section 5(1) and section 5(2)(a) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application under the 5(1) ground, and against some of the goods of the application under the 5(2)(a) ground. CEC relies upon the following comparable UK mark:

ATHENRY
UK trade mark registration number 912929791
Filing date: 2 June 2014
Registration date: 24 October 2014
Registered in Classes 21, 32, 33 and 39
Relying on some goods in Class 33 only, namely:
Alcoholic beverages (except beers); spirits (under the section 5(1) ground); and

[1] In a letter dated 11 January 2023, the Registry confirmed to the parties that having considered the nature of the claims in the individual cases, it considered it appropriate to consolidate the proceedings.

Spirits; gin (under the section 5(2)(a) ground).[2]

4. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, CEC's EU mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.[3]

5. CEC's mark qualifies as an earlier mark under section 6(1) of the Act, and is subject to the use provisions contained in section 6A of the Act. CEC submits that the competing marks are identical; it submits that the competing goods are identical under section 5(1), and highly similar under 5(2)(a) grounds, and as such, there is a very high likelihood that confusion will occur.

6. ASL filed a counterstatement in which it concedes that the marks are identical and that the goods in class 33 are either identical or highly similar. As such, ASL relies on CEC's non-use of the earlier mark, putting it to proof of use in relation to all the goods upon which CEC relies.

(ii) The application for revocation

7. On 14 June 2022, ASL filed an application seeking to revoke CEC's trade mark number 912929791, (as set out above under paragraph 3 of this decision) on the grounds of non-use of all the goods and services in classes 21, 32, 33 and 39, under sections 46(1)(a) and 46(1)(b) of the Act.

8. Under section 46(1)(a) of the Act, ASL claims non-use of all goods and services in the five-year period following the date on which the marks were registered, i.e. 25

[2] I note that while the opponent has made a statement of use in relation to the earlier mark, the term '*gin*' solus does not form part of the class 33 specification for which the earlier mark is registered, although it is considered to be encompassed by the broad term "*spirits*".
[3] See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

October 2014 to 24 October 2019, with an effective date of revocation of 25 October 2019.

9. Revocation is also sought under section 46(1)(b), where ASL claims non-use of all goods and services for the following periods:

- 23 January 2017 to 22 January 2022, with an effective date of revocation of 23 January 2022;
- 22 April 2017 to 21 April 2022, with an effective date of revocation 22 April 2022; and
- 14 June 2017 to 13 June 2022, with an effective date of revocation of 14 June 2022.

10. CEC filed a counterstatement defending the use of its mark in relation to all of its goods and services during the relevant periods for which non-use is claimed.

11. Both parties filed evidence and written submissions; neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

12. In these proceedings, ASL is represented by Keltie LLP, and CEC is represented by Ansons.

EVIDENCE AND SUBMISSIONS

13. ASL filed evidence in chief by way of a witness statement in the name of David Yeomans of Keltie LLP, being the appointed representatives of ASL. The witness statement is dated 15 May 2023 and is accompanied by three exhibits labelled DY1 to DY3.[4] On the same date, ASL filed written submissions; it also filed written submissions in lieu of a hearing, dated 19 September 2023.

[4] I note that as exhibits DY2 and DY3 were not originally paginated, they were amended to reflect this and resubmitted on 21 June 2023.

14. In relation to the application for revocation of its mark, CEC filed evidence in chief by way of a witness statement in the name of Kevin Gerrard Cassidy. The witness statement was filed on 28 November 2022, alongside two annexes, labelled KC1 to KC2. Mr Cassidy is the brother of CEC and is involved in the promotion of the goods under the contested mark. The main purpose of the evidence is to show genuine use of the mark during the relevant periods for which revocation is sought.

15. CEC also filed written submissions on 17 July 2023, alongside evidence in reply by way of a further seven witness statements in support of the registration.[5] These statements are in the names of Ann Cassidy, to which one further exhibit, being exhibit AC1, is attached; Carolann Elaine Cassidy; Charles Doherty; Eunan Ryan; Owen Mulligan; Stephen Cassidy; and Thomas Mitchell. The witness statements are each dated between 12 and 17 July 2023.

16. I have taken the evidence and submissions into account in reaching my decision and will refer to the relevant material throughout the decision.

DECISION

17. 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.

[5] I note that the written submissions mention the submissions of nine witness statements, including one in the name of Shane Braniff. However, the witness statement of Mr Braniff does not appear to have been filed, and as such, cannot be considered in this decision. Any references to Mr Braniff's witness statement in the written submissions will also be disregarded.

The Revocation

18. I will begin by assessing the application for revocation first as the outcome will have a direct impact upon the opposition: if the application for revocation succeeds in its entirety, the opposition to ASL's application will fall away.

Section 46

19. 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 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".

20. As the mark is a comparable mark, pursuant to paragraph 8 of Part 1, Schedule 2A of the Act, CEC may rely upon use of the mark in the EU for any parts of the relevant periods which fall prior to IP Completion Day, being 31 December 2020.

21. Section 100 of the Act states that:

"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".

22. The application for revocation was filed on 14 June 2022. As noted previously, the relevant period for assessing whether there has been genuine use of CEC's mark is 25 October 2014 to 24 October 2019 ("the first relevant period") under section 46(1)(a); and 23 January 2017 to 22 January 2022 ("the second relevant period"), 22 April 2017 to 21 April 2022 ("the third relevant period"), and 14 June 2017 to 13 June 2022 ("the fourth relevant period") under section 42(1)(b).

23. In view of the above dates, I will focus upon the second relevant period, given that a finding of genuine use during this period will be sufficient to avoid revocation of the mark under section 46(1)(b), and, by virtue of section 46(3), section 46(1)(a). Provided that such use is deemed to be genuine use, this will be the case even if the evidence in relation to the earlier period is deemed insufficient.

24. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

Evidence of use

25. In its notice of defence, CEC has claimed that use has been made of all of the goods and services for which the mark is registered. I must consider whether, or the extent to which, the evidence shows genuine use of the mark in relation to the goods and services covered under classes 21, 32, 33 and 39, being:

Class 21: *Dinnerware; glass (pressed); glassware etched by acid; crystal and glassware, namely beverage ware and decorative glassware; flasks; hip flasks; drinking flasks.*

Class 31: *Beers; ales; mineral and aerated waters and other non-alcoholic drinks; fruit juice drinks and fruit juices; syrups and other preparations.*

Class 33: *Alcoholic beverages (except beers); spirits; whisky; whisky liqueurs; cider; perry.*

Class 39: *Distribution services relating to alcoholic and non-alcoholic beverages.*

26. I note the following from CEC's evidence:

a) CEC originally produced gin under the mark "ATHENRY".[6]

b) From January 2019, ATHENRY gin was said to have been stocked for sale in a number of public houses within the United Kingdom. I note that Mr Kennedy states that the goods were provided to those establishments by CEC without charge, in order to promote the goods to create an interest in the products and create a marketplace. The locations of these public houses are listed as including Glasgow, Cookstown, Liverpool and Ardboe.[7] However, no evidence has been provided to illustrate how the goods were actually promoted, nor any evidence of sales of the goods generated by any such promotion.

c) CEC endeavoured to create a market for the gin and other spirits under the ATHENRY mark before situations outside its control, namely Brexit and the Covid 19 pandemic, hindered CEC's ability to grow its market share.[8]

[6] See paragraph 3 of Mr Kevin Cassidy's ("KC") witness statement.
[7] See the witness statement of KC, paragraphs 7 and 8.
[8] Ibid., at 10 - 14.

d) Mr Cassidy states that CEC secured agreements with approximately thirty hospitality venues to stock ATHENRY gin upon their re-opening following closures imposed by Covid-19 regulations.[9] I note that copies of these agreements have not been provided as part of the evidence. As such, the dates of when any such agreements came into force, or the quantities involved, are unknown, as is the location of the venues.

e) In 2021, North Western Distribution agreed to promote and distribute alcoholic beverages under the ATHENRY mark. The witness statement of Stephen Cassidy confirms that he set up North Western Distribution in 2021 primarily for the distribution of products under the "ATHENRY" mark.

f) Meetings with other potential distributors are said to have taken place in 2018, which were revisited in 2022 to create further avenues to market.[10] However, no evidence has been provided to substantiate this, and no further information has been given in regard to the outcome of these meetings.

27. Annex KC1 adduced alongside the witness statement of Mr Kevin Cassidy comprises a copy of two photographs showing bottles labelled as "ATHENRY GIN":

However, the above photographs bear no date to show when they were actually taken.

[9] Ibid., at 17.
[10] Ibid., at 19.

Assessment on genuine use

28. While gin would be encompassed by the broad terms "*Alcoholic beverages (except beers); spirits*", aside from incidental remarks in relation to whiskey and vodka,[11] and to 'other spirit offerings'[12] the evidence does not mention any use in relation to the remaining Class 33 goods at issue, and there has been no evidence of use by CEC in relation to any of the goods in classes 21 or 31, nor of the class 39 services, for which the mark is registered. While I note that the evidence mentions that North West Distribution Ltd. was set up by Stephen Cassidy primarily for the distribution of the products under the ATHENRY mark,[13] theoretically, CEC would be a customer of North West Distribution's class 39 services. The evidence does not establish that *Distribution services relating to alcoholic and non-alcoholic beverages* were ever provided under the mark, or to third parties. I will therefore now consider whether the use shown is sufficient to constitute genuine use of gin.

29. I note the additional witness statements of what are described in the written submissions as being from various members of the Cassidy family, and from owners of public houses and/or distilleries. CEC submits that these bear witness to the public and outward commercial activities made by the family to create a marketplace for alcoholic beverages.[14] While the witness statements of family members give background information leading to CEC's application and subsequent registration of the trade mark ATHENRY, I do not consider that they provide evidence of actual use of the mark.

30. In the witness statements of Charles Doherty, Eunan Ryan, Owen Mulligan and Thomas Mitchell, while they each refer to discussions held in 2018 and 2019 on the possibility of promoting and/or stocking CEC's goods in their various establishments, there is no evidence that any orders were ever placed. I further note that Eunan Ryan has stated that his business "**is ready to place an initial order** of 600 bottles (100

[11] See the witness statement of KC at paragraph 6; Also, the witness statements of Ann Cassidy and Eunan Ryan.
[12] Witness statement of KC at paragraph 10.
[13] See paragraph 6 of the witness statement of Stephen Cassidy.
[14] Paragraph 2 of CEC's written submissions dated 17 July 2023.

cases) of ATHENRY branded gin" (**my emphasis**). However, there is nothing to show that an initial order was ever placed. Furthermore, the statement is dated 15 July 2023 and thus falls outside the relevant period. I acknowledge that evidence dated subsequent to the relevant period can, in some circumstances, be relevant because it casts light backwards.[15] In this case, however, I do not consider that Mr Ryan's evidence shows genuine use of the goods at issue. Even if this were the case, it is obvious that any potential commencement or resumption of use comes much later than three months prior to the date of filing of the application for revocation. Neither is there anything to show that any agreements made between CEC and third parties to either stock or to promote and distribute alcoholic beverages under the ATHENRY mark were ever realised.

31. I disagree with CEC's submissions that the witness statements of Thomas Mitchell and Owen Mulligan indicate that (genuine) use was made of the mark in 2017.[16] Both Mr Mitchell and Mr Mulligan state they were each given 6 bottles of Athenry gin in 2018 to give to family, friends and customers. I note CEC's reference to paragraph 67 of the judgement of the General Court ("GC") in *Omnicare, Inc v OHIM*, Case T-289/09, which states that the fact that goods and services may be offered free of charge does not prevent genuine use from being shown.[17] However, the judgement goes on to say that:

> "68. However, in order to determine whether genuine use has been shown or not, it is necessary to assess whether, by such use of the mark, the undertaking seeks to create or maintain an outlet for those services in the European Union, as against the services of other undertakings. **That will not be the case if those services do not enter into competition with services offered on the market by other undertakings, that is to say if they are not – and are not intended to be – offered commercially**." (**My emphasis**)

32. I do not consider the above cited case, which relates to the provision of medical consultancy for medical practice and the distribution of literature and printed matter

[15] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).
[16] Paragraph 5 of CEC's written submissions dated 17 July 2023.
[17] See paragraph 7 of CEC's written submissions dated 17 July 2023.

for advertising use, to be on all fours with the case before me. To my mind, particularly in view of the very small amount of goods given to the respective parties, i.e. only six bottles each to two publicans based in Liverpool and Glasgow, the main purpose of the gifted goods by CEC appears to have been in order to solicit opinion of the goods prior to (mass) production, rather than with the intention of competing with the goods of other undertakings at that specific point in time. I find this regardless of any intentions by the publicans to potentially place future orders, if and when the goods became commercially available. There is no evidence to show how the gifted bottles of gin were actually promoted to potential consumers. No turnover or sales figures have been provided and there is no evidence to show that the goods have ever been offered for sale during the relevant period, nor any indication of any actual sales made.

33. As stipulated in the case law outlined under paragraph 24 of this decision, 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. No figures have been provided to show any kind of advertising spend during the relevant period in relation to the goods offered under the mark in the relevant territory. Neither has evidence of any focussed marketing at the target consumer been provided. While I note that several focus groups were held to obtain consumer feedback on the goods,[18] the evidence does not lead me to believe that preparations were sufficiently advanced that CEC was in a position to either market the goods and services or to secure customers thereof at this time, or at any time during the relevant period.

34. I acknowledge that, as per the principles outlined under paragraph 24 of this decision, use of the mark must be more than token, although that use need not always be quantitatively significant for it to be deemed genuine.[19] I also bear in mind that it is not for me to assess economic success or large-scale commercial use, and that there is no *de minimis* rule - even minimal use may qualify as genuine use if it is use warranted, in the economic sector concerned, to maintain or create market shares for

[18] See the witness statement of KC at Paragraph 9.
[19] *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

the relevant goods.[20] Conversely, even proven commercial use may not be sufficient for a finding of genuine use.[21]

35. The evidence is severely limited. The most that I can ascertain from the evidence is that the sign ATHENRY has been used on the label of a bottle of gin, as illustrated in the undated Annex KC1. There are no other examples provided within the evidence demonstrating use of the mark in relation to any of the goods and services for which the mark is registered.

36. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark" is not, therefore, genuine use. Where there is no use of the mark in respect of the goods and/or services as registered, it follows there has been no genuine use of the mark: *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13.[22]

37. Under question 8 of the form TM8(N), 'Counterstatement by the defendant', the form clearly states that "if a defence is based on "proper reasons for non-use" then this should be clearly set out in the counterstatement". Given the brevity of the counterstatement, I will re-produce it in full, as follows:

[20] *Naazneen Investments Ltd v OHIM*, Case T-250/13 at [49].
[21] At [115(8)].
[22] At [22].

It is denied that the mark ATHENRY has not been put to genuine use within the relevant territory within the period of five years following the date of completion of the registration process, and there are no propser reasons for non-use. While use has admittedly been limited, there has been a genuine and real effort to create a market place for the goods under the mark. Some issues had to be overcome when the UK voted to leave the European Union which delayed the progression of use.

The Applicant has claimed that use of the mark ATHENRY was been suspended for an uninterrupted period of five years in relation to the goods for which it is registered, and ther are no proper reasons for non-use, this is denied. While it is admitted that use has been limited, there has been a genuine and real effort to create a market place for the goods under the mark.

Again, some issues regarding import of goods into Great Britain had to be overcome when the UK voted to leave the European Union which delayed the progression of use. Additionally, from in March 2020, the Covid 19 Pandemic closed, and otherwise disrupted the trade channel by which the Registered Proprietor was bringing the to market. These situations were entirely outside of the Registered Proprietors control.

38. To my mind, although CEC admits to limited use of the mark, for which it has pleaded mitigating circumstances, it has not expressly pleaded non-use. Rather, it states that there has been genuine use of the mark. This is maintained in the conclusion of CEC's written submissions. Consequently, I must make my decision based on the evidence of actual use, or lack thereof, of the mark in relation to the goods and services which are subject to the application for revocation.

39. If marks which their owners are not using because of unfavourable economic conditions were allowed to remain registered indefinitely, UK and international trade would be stifled by such register cluttering. Justice Jacob (as he then was) stated, in *La Mer* [2002] E.T.M.R. 34 (paragraph 19):

> "There is an obvious strong public interest in unused trade marks not being retained on the registers of national trade mark offices. They simply clog up the register and constitute a pointless hazard or obstacle for later traders who are trying actually to trade with the same or similar marks. They are abandoned vessels in the shipping lanes of trade."

40. Having considered the evidence as a whole, in my view, it does not show that there has ever been any real commercial exploitation of the mark. Consequently, the evidence does not allow me to find that CEC has demonstrated genuine use on any

of the goods or services for which it is registered under the mark for which revocation is sought.

CONCLUSION

The revocation

41. In accordance with sections 46(1)(a) and 46(1)(b), CEC's registration is revoked in full for reasons of non-use, with effect from the earliest date requested, as follows:

UK00912929791 under CA504978 shall be revoked from 25 October 2019.

The opposition

42. As mentioned earlier in this decision, the effect of the mark being revoked means that it cannot be relied upon as an earlier mark in relation to the opposition brought by CEC, under OP436861, against ASL. As such, the grounds of opposition under section 5(1) and 5(2)(a) fall away. Subject to any successful appeal, application No. 3746909 filed by ASL may proceed to registration.

COSTS

43. In these consolidated proceedings, ASL has been successful in its application for revocation of the earlier mark, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016. Although I have read the witness statement of Mr Yeoman and the exhibited documents, this evidence was of no assistance in determining ASL's claim of non-use. As such, I make no award of costs for it.

44. I acknowledge that while the opposition against ASL has fallen away, ASL filed a form TM8 in defence of the opposition. However, in the counterstatement, ASL admits that the marks are identical and that the goods are either identical or highly similar and it states that its defence relies on CEC's non-use of the mark. I also note that its

written submissions were in relation to non-use of the earlier mark only. Consequently, I will not make a separate award of costs in regard to the opposition proceedings.

45. Taking all of the above into consideration, and applying the guidance in the TPN, I award ASL the sum of £1,000, which is calculated as follows:

Official fee (Application for revocation):	£200
Preparing the application for revocation and considering the counterstatement:	£200
Preparing written submissions, and considering the other side's submissions and evidence:	£600
Total:	**£1,000**

46. I therefore order CEC to pay ASL the sum of £1,000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 22nd day of April 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General