

O/0698/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION UK00003145398

IN THE NAME OF ROGER CHARLES GAWN

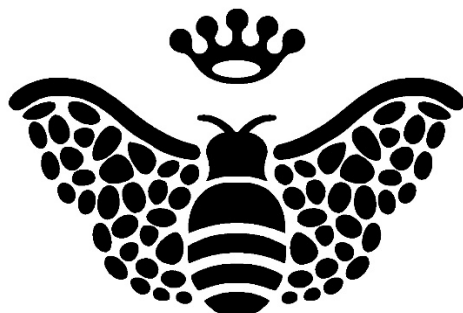
AND

APPLICATION 506487 BY BARROW HEPBURN & GALE LIMITED

TO REVOKE THE AFORESAID REGISTRATION

Background and Pleadings

1. UK00003145398 ('the Contested Mark') stands registered in the name of Roger Charles Gawn, the Registered Proprietor ('the RP'). The details of the registration are as follows:



Filing date: 20 January 2016

Entry in register: 15 April 2016

Registered for the following:

Class 14:

Jewellery; costume jewellery; decorative articles for personal use; cufflinks; tie pins; tie clips; tie bars; badges; shirt studs; stickpins; jewellery and metal accessories for personal use, all including precious metals, enamels, silk yarns, precious stones or miniature prints.

Class 24:

Fabrics, textiles and textile goods; natural and synthetic fabrics and textiles; silk fabrics; woven silk fabrics; woven mixed fabrics; silk/linen mixed fabrics; silk/cotton mixed fabrics; fabrics including metallic and technical yarns; fabrics for furnishing; fabrics for interior decoration; fabrics for clothing; fabrics for bridal wear; fabrics for neckwear, ties, cravats, scarves, pocket squares, bowties and cummerbunds

Class 25:

Clothing, footwear, headgear; ties; cravats; scarves; pocket squares; bowties; cummerbunds; silk clothing; silk ties, silk cravats, silk scarves, silk pocket squares, silk bowties, silk cummerbunds and silk neckties.

2. On 5 September 2023, the Cancellation Applicant ('the CA') applied to revoke the Contested Mark in accordance with sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 ('the Act'). The revocation notification date is 6 June 2023. Revocation is sought in respect of the specification in its entirety. The CA alleges that the RP has not put the Contested Mark to genuine use in the United Kingdom within the following five-year periods:
 - i) following the date of completion of the registration process, i.e. 16 April 2016 – 15 April 2021 ('the First Relevant Period'). The earliest possible date from which the Contested Mark may be revoked is 16 April 2021.
 - ii) 5 September 2018 – 4 September 2023 ('the Second Relevant Period'). The earliest possible date from which the Contested Mark may be revoked is 5 September 2023.
3. The RP filed a defence and counterstatement in which it denies the claim against it in its entirety. The RP states that it has made genuine use of its mark within both Relevant Periods. It further states that there have been two assignments recorded for the registration and that there has been genuine use by 'the Registrant and its predecessors in title'.
4. The CA is represented by BRANDED! TM Limited. The RP represents itself.¹ Both parties filed evidence and written submissions. A hearing was requested by the CA.

THE HEARING

¹ The RP was initially represented by Dummett Copp LLP. The firm informed the Registry by email, on 3 April 2025, that it no longer represented the RP. The RP subsequently confirmed by email, on 14 April 2025, that they were no longer professionally represented.

5. Only the CA attended the hearing; Ms Carin Burchell, of BRANDED! TM Limited, appearing on its behalf. Ms Burchell filed a Skeleton Argument in advance of the hearing.
6. The following decision has been made after careful consideration of the papers and written/oral submissions.

RELEVANCE OF EU LAW

7. 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.

Preliminary matters:

The recordal of the assignments *on the Register*

8. At this point, it is convenient to set out the chronology of the chain of ownership of the Contested Mark, and of the recordal of the assignments:

20 Jan 2016	Application for registration of Contested Mark filed by Silk Industries Limited.
24 Dec 2020	Effective date of assignment from Silk Industries Limited to Vanners Silk (1740) Ltd*
11 Feb 2022	Effective date of assignment from Vanners Silk (1740) Ltd to Roger Charles Gawn (RP)*
30 Nov 2023	*Notices of the two assignments filed with the Registry (RC000420540 and RC000420542, respectively).
6 Dec 2023	Recordal on the Register of the assignments of 24 December 2020 and 11 February 2022.

9. It is appropriate to comment on the discrepancy between the RP and the *party named as the RP* in the Form TM26(N)² filed. I note that the party against whom the revocation proceedings were instituted is stated to be ‘Silk Industries Limited’ (i.e. the party that filed the application for registration of the Contested Mark), rather than the RP. It is clear from the chronology set out above, that, at the time that the application for *revocation* was filed, on 5 September 2023, Silk Industries Limited was still recorded as the Registered Proprietor of the Contested Mark. This is because the two notices of assignment (whose effective dates preceded the CA instituting the instant revocation proceedings) were not filed with the Registry until 30 November 2023; the subsequent recordal of the assignments not completed until 6 December 2023. Neither the CA, nor the Registry, at the time of the CA filing its Form TM26(N), had any way of knowing that the RP was the assignee of the Contested Mark. However, ultimately, nothing turns on this discrepancy.

Related proceedings

10. I am aware that there is another set of proceedings between the parties which is currently pending: case number CA506488, concerning a revocation action against UK00003145398. For the avoidance of doubt, the two related cases have not been consolidated. This decision deals with CA506487 only. I will not be determining case CA506488.

EVIDENCE AND WRITTEN SUBMISSIONS

11. The RP’s evidence comes from Mr Roger Charles Gawn himself, by way of two Witness Statements, dated 8 February 2024 and 28 August 2024, respectively. There are fourteen exhibits: RG1 – RG14. The CA’s evidence comes from Ms Carin Burchell, of the CA’s legal representative firm. Ms Burchell’s Witness Statement is dated 20 May 2024, and is accompanied by five exhibits: CB1 – CB5. I have read all of the evidence and will refer to it to the extent necessary.

² Application to revoke a registration or a protected international trade mark (UK) for reasons of non-use.

DECISION

The relevant legislation

12. 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 existed at an earlier date, that date.'

13. Section 100 of the Act provides 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.'

The relevant case law

14. 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 Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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].’

My approach

15. As noted above, at [2], there are two relevant five-year periods within which non-use of the Contested Mark has been alleged. Should genuine use be proven in the most recent relevant period (i.e. the Second Relevant Period), the revocation action would, to the extent that use had been found, be defeated. I note that the Revocation notification date was 6 June 2023, three months before the action was filed on 5 September 2023. I remind myself of the proviso that, should commencement/resumption of use of the Contested Marks be shown to occur within the three months preceding institution of the revocation actions, if the RP is on notice, such use will be disregarded unless preparations for the commencement/resumption began before the RP became aware of the impending actions.³

The RP’s evidence

16. As a starting point, I consider it appropriate to address Mr Gawn’s evidence in so far as it explains the following:

- i. the sequence of ownership of the Contested Mark;
 - ii. the RP’s own relationship to the successive owners of the Contested Mark;
- and
- iii. the entities that have used/currently use the Contested Mark, as the case may be.⁴

³ Section 46(3) of the Act; Kerly’s Law of Trade Marks and Trade Names, 17th Ed., [12-095].

⁴ Witness Statement of R.C. Gawn, [1] – [6].

17. I set out the pertinent information thus:

Time period:	Owner of Contested Mark:	RP's relationship to owner of Contested Mark:	Entity using the Contested Mark:
20/01/2016 – 23/12/2020	Silk Industries Limited	Although Mr Gawn's narrative does not set this out, I note the following from other parts of the evidence: A Wayback print, dated 26 August 2018, states that the 'Vanners' brand is 'a division of Silk Industries Ltd.' ⁵ Further, a copy of an asset sale agreement in respect of Silk Industries Ltd (in administration) names the RP as the purchaser. ⁶	Presumed to be the owner at this time.
24/12/2020 – 10/02/2022	Vanners Silk (1740) Ltd [now named VICTOR 1010 LTD]	The RP was an officer and the Managing Director of Vanners Silk at this time. ⁷	Presumed to be the owner at this time.
11/02/2022 to date	Roger Charles Gawn (the RP). This is	N/A	Vanners International Limited, of which the RP is 'an Officer and

⁵ Exhibit RG4.

⁶ Exhibit RG13.

⁷ Witness Statement of R.C. Gawn, [3].

	supported by a redacted copy of a deed of assignment dated 11 February 2022. ⁸		Managing Director' is [at the time the RP's evidence was filed] using the mark under 'effective licence' from the RP. ⁹
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18. I note that 'My Company' has been defined in Mr Gawn's Witness Statement as a 'collective reference' to all of the corporate entities set out in the above table at [17]. 'My Company', therefore, refers to whichever entity, from time to time, has ownership of the Contested Mark, or consent to use the mark.¹⁰ To maintain consistency, my references in this decision to 'The Company' are to be taken to refer to the entities denoted by Mr Gawn's use of 'My Company'.

19. I note the following from the RP's evidence:

(a) Mr Gawn has given narrative evidence that the Contested Mark has been, and continues to be, used throughout the UK and that sales have been made from a physical store, on a wholesale basis, via online channels and by way of collaborations with other brands.¹¹ He states that there has been genuine use in respect of all goods within the registered specification, throughout the relevant time periods, and that the brand denoted by the Contested Mark (which he refers to as the 'Vanners' brand) enjoys particular renown for fabrics and textiles (particularly silk) as well as ties, scarves and cravats.¹² Mr Gawn states that the Contested Mark has been used in the following ways (enumerated as headings under which I have addressed/sign-posted the examples provided elsewhere in the evidence):¹³

i. On products and packaging:

⁸ Second Witness Statement of R.C. Gawn, [1]; Exhibit RG14.

⁹ Witness Statement of R.C. Gawn [2].

¹⁰ The matter of use with consent will be addressed later at [38].

¹¹ Witness Statement of R.C. Gawn, [9].

¹² As above, [10] – [11].

¹³ As above, [11].

In Exhibit RG3, there are three undated photographs, two of which appear to be of the same tie. The third photograph appears to be sets of men's braces, of various colours, presented in open boxes. Both the tie and the boxed braces bear the Contested Mark, along with the wording 'Vanners Silk Weavers' and either 'Woven in England by' or 'Handmade in England'. The photographs are of the mere goods, i.e. there is no detail by way of product description, pricing, availability or stockists. Without being able to place these particular photographed examples in time and place, it is, therefore, not clear whether these photographs are contemporaneous with the goods being held out for sale. Dated screenshots of online product listings, or photographs of the goods displayed in a physical shop for purchase, would have strengthened the RP's evidence.

ii. On sales invoices:

A selection of invoices has been provided at Exhibits RG3 and RG10, and these are addressed below at (g).

iii. On various marketing pieces:

Examples of marketing pieces are addressed below at (i).

iv. On the Company's website:

Examples are noted below at (e) and (f).

v. On the websites of various collaborators:

Exhibit RG7 includes, inter alia, undated screenshots from the websites of Marks and Spencer ('M&S'), Turnbull & Asser and Redmayne showing product listings for ties (and, in the Redmayne example, suspenders, too.). In two of the examples, a 'Copyright Notice' is dated 2024, which is after the Relevant Periods. It is, therefore, not possible to say when the product listings were first published. Although both the M&S and Redmayne listings do mention that the silk fabric is crafted by Vanners Silk, neither listing shows the Contested Mark anywhere on the page. The Turnbull & Asser example does, however, show the Contested Mark adjacent to a paragraph

praising the quality of the silk and noting the prestige attached to the brand. Two undated photographs show boxed suspenders (braces) and ties, respectively. Both products bear the Contested Mark on attached labelling, along with the brands of the collaborators: 'Albert Thurston' and 'Tomorrowland', respectively.

vi. On social media:

Instagram:

An undated screenshot of a page from the Instagram account of the 'Vanners' brand has been provided.¹⁴ Text in the 'header' of the document in which the screenshot has been inserted reads 'All internet sources access [sic] on 05/02/2024'. The text and images are extremely small, but I can see that one of the images is a photograph of the signage for the 'Vanners Mill Shop', an enlarged version of which is included in Exhibit RG1. As at the date when the source was accessed, there were 41 posts and 595 followers.

Other dated examples from The Company's Instagram account have been provided at Exhibit RG11. Screenshots of posts have been provided for the following dates: 1 July 2021, 10 June 2021, 4 June 2021, 17 June 2021, 8 July 2021, 9 December 2021 and 21 March 2018. The Contested Mark can be seen in just two of these examples: a photograph of the Vanners Mill Shop sign, showing 36 'likes' as at 10 June 2021; and a photograph of a festive shop display, showing 30 'likes' as at 9 December 2021.

X (formerly known as Twitter):

Five mentions of the Vanners brand have been provided by way of posts ('tweets') by members of X, for the following dates: 29 April 2016, 29 June 2018, 8 July 2021, 10 February 2020, 14 April 2018.¹⁵ Three of the 'tweets' are from individuals; the other two are from accounts named 'Baddeley Brothers' and 'FABRIC: Silk Road'. There is no detail as to how many people might have viewed the posts. It is, therefore, not possible to say whether UK

¹⁴ Exhibit RG3.

¹⁵ Exhibit RG11.

consumers have viewed them. The numbers of 'likes'/'comments' are in the single digit numbers. Only the example of 29 April 2016 shows the Contested Mark: on the labelling of a tie. I note that the words 'Sudbury' and 'Suffolk', being UK geographical locations, have been 'hash-tagged' (i.e. prefixed with the character '#') which indicates that the post was likely intended to be seen by persons who search for 'tweets' relating to those terms.

Facebook:

Screenshots of two posts, from the Facebook accounts of 'Fabric: Silk Road' and 'Sudbury Silk Festival', have been provided, dated 25 December 2020 and 14 August 2020, respectively.¹⁶ The former announces the purchase of 'Vanners' by the RP and features a photograph of a sign or plaque showing the Contested Mark. I note that the post has 40 'likes, 11 comments and has been 'shared' 11 times. The latter shows a photograph of woven silk accompanied by a comment attributing it to 'Vanners' and praising its quality. However, the Contested Mark is not shown. I note that there are 23 'likes' and 2 comments.

vii. On signage at the Company's premises:

Examples are noted below at (c).

viii. In various news articles:

A page within Exhibit RG3 appears to show screenshots of an article from The Telegraph newspaper. However, 11 pages/screenshots appear to have been compressed into one A4 sheet, arranged in a vertical sequence. Aside from being just about able to discern that the piece is from The Telegraph, the material is illegible due to its extremely small size. What I can see is that there are two photographs of a model wearing what appears to be a patterned housecoat/dressing gown, possibly in some sort of silk jacquard, with a white shirt and bow tie underneath. In two other photographs, I can see what appears to be a showroom or stockroom with bolts of fabric in rolls

¹⁶ Exhibit RG11.

stacked on shelves. Exhibit RG7 also includes articles from The Telegraph, which are similarly illegible.

(b) A table of figures, referred to by Mr Gawn as 'My Company's turnover', has been provided, which I reproduce here:¹⁷

Year ending 30 April:	Turnover (£):
2014	9,893,000
2015	9,829,000
2016	9,113,000
2017	7,941,000
2018	6,885,000
2019	6,229,000

The values are to the nearest £thousand. These figures have been corroborated by extracts from the accounts provided for Silk Industries Limited at Exhibit RG8. It is presumed that the values shown for each year relate to the period from 1 May of that year until 30 April the following year. Taking 2014 as an example, the 'year' runs from 1 May 2014 until 30 April 2015. Based on this presumption, the figures span the entire First Relevant Period. However, no figures have been included in the table to cover the portion of the Second Relevant Period between May 2020 and September 2023. Although the figures demonstrate a gradual decline, they remain significant even at their lowest point. The cumulative turnover figure as at 30 April 2020 was approximately £50,000,000, which is impressive. A breakdown of the figures by the goods sold would have been useful. Additionally, the RP has provided a copy of a 'Joint Administrator's progress report' in respect of Silk Industries Limited, for the period 9 November 2020 to 8 May 2021, which indicates that, despite The Company being in administration, sales had been generated in the sum of £288,029.30.¹⁸

¹⁷ Witness Statement of R.C. Gawn, [17].

¹⁸ Exhibit RG9.

(c) Exhibit RG1 comprises undated images of the Contested Mark, presented in the form as registered, in conjunction with the word 'Vanners'. Mr Gawn has stated that 'use has been ongoing since 1740, including on and around the historic building in which in which [The] Company's products were produced until recently'.¹⁹ The following examples are provided:

- shop signage:



- Gate signage on/outside the 'Vanners' premises:



- Labelling attached to what appears to be a garment in silk damask, possibly a tie or cravat:

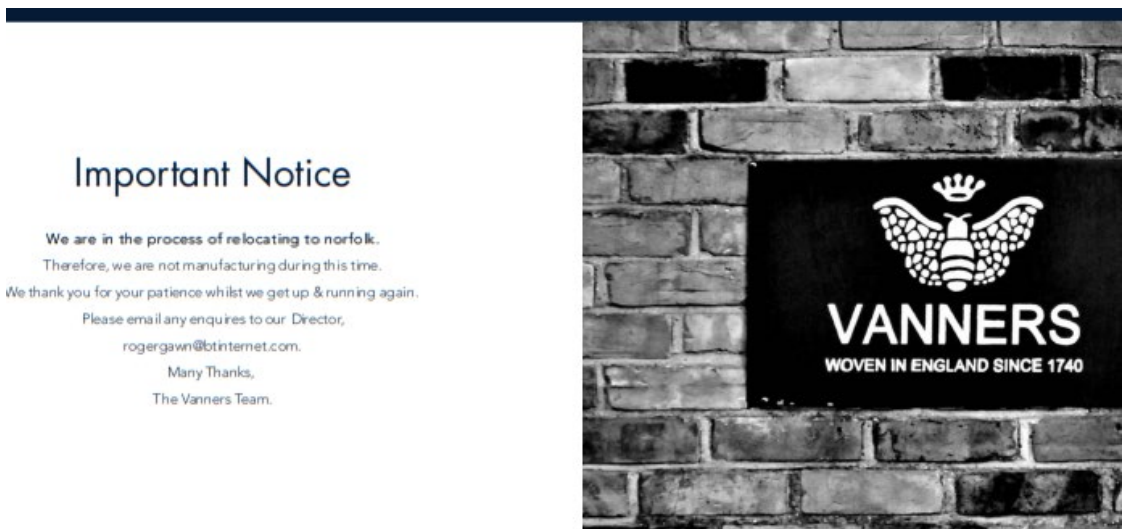
¹⁹ Witness Statement of R.C. Gawn, [17].



- On a fabric banner, though no detail has been provided as to its purpose or when and where it was displayed (if at all):



- On a screenshot of The Company's web page:



Although this final example is undated, I note that the date of the 'Copyright Notice' is 2024.

Undated photographs showing signage, bearing the Contested Mark, on and in the physical shop, 'Vanners Silk Weavers Mill Shop', have also been provided, including:²⁰

- A sign in the shop window showing its opening times, telephone contact details and website address;
- Signage within the shop setting out prices of the fabrics per metre;
- A 'banner' or trim above a display of rolls of fabric;
- A hanging sign with an arrow directing prospective customers to the shop entrance;
- Labelling attached to fabric swatches hanging on display.

(d) Mr Gawn has given narrative evidence that The Company's silks have been used to clothe Royals and celebrities, including Michelle Obama, and that they have been incorporated into military dress uniforms.²¹ He states that collections of 'historic silks' produced by The Company have been curated by the Science Museum Group, including an exhibition, in 2017, at Gainsborough House, titled 'Silk: From Spitalfields to Sudbury'.²² Exhibit RG2 is said to include 'select examples of this use'.²³ Three undated photographs show, respectively:

- A framed and mounted photograph of two women in formal dress, who I recognise as Camilla Parker Bowles and Michelle Obama;
- A framed and mounted photograph of three men, and a woman whom I recognise to be the British 'pop' singer 'Adele', all in formal dress;
- A page on which fabric swatches have been mounted and labelled by hand as relating to various regiments.

The Contested Mark is displayed beneath each of the framed photographs, and at the top of the page of fabric swatches. No further detail is provided as to the

²⁰ Exhibit RG5.

²¹ Witness Statement of R.C. Gawn, [8].

²² As above.

²³ As above.

purpose of the two photographs, where they are displayed or the extent to which (if any) they have been viewed by the relevant public in the UK. I note that the page of swatches has been marked by hand, in pen, as 'Page 1'. Whilst not explicitly clear, I consider that the page likely forms part of a book by way of some sort of archival repository, probably relating to the aforementioned 2017 exhibition in Mr Gawn's Witness Statement.²⁴

(e) 8 'Wayback prints'²⁵ of pages from The Company's website have been provided for the following dates: 4 June 2016, 17 August 2017, 6 October 2017 (2 examples), 1 April 2018, 17 May 2018, 7 August 2020 and 28 July 2020.²⁶ In all examples, the Contested Mark appears prominently at the top of the page, accompanied by the 'Vanners' brand name:



The overall layout and style of the website appears unchanged for the dates covered. The top toolbar features a 'brochure' option. The home page includes the following text:

'VANNERS SILK WEAVERS

Vanners Silk Weavers, Sudbury, England – weaving silk since 1740. As well as state-of-the-art jacquard and dobby weaving, Vanners has its own yarn dyeing & fabric finishing facilities'.

The examples from 2017 and 2018 feature a button/link to the 'VANNERS WEB STORE' and include the same list headed 'QUICKLINKS', which includes links for, inter alia:

²⁴ Witness Statement of R.C. Gawn, [8].

²⁵ Archived webpages obtained from the web archiving service, The Wayback Machine.

²⁶ Witness Statement of R.C. Gawn, [13]; Exhibit RG4.

- Mill Shop Opening Times
- Couture Silk
- Furnishing Silk
- Neckwear Silk
- Cufflinks

The example from 2016 features a button/link 'VANNERS ON INSTAGRAM'

The example from 2020 shows a section for 'NON-SURGICAL FACE MASKS'.

I note the following text:

'We are selling non-surgical silk masks, hand wash up to 30 degrees only, in packs of 2 @ £10 per pack. These can be purchased from our mill shop each Thursday 10-4pm.

I note that the following 'QUICKLINKS' are present in the 2020 example:

- Silk Face Masks
- Couture Silk
- Furnishing Silk
- Neckwear Silk
- Tie Making
- Cufflinks

By way of a general observation on the pages provided, I note that the 'Copyright Notices' in the footer of each example, show dates contemporaneous with the archived dates of the page. To my mind, this indicates that The Company has continued to maintain/update its business web pages over the years.

(f) Wayback prints, dated 26 August 2018, from The Company's website, of product listings for a number of 'accessories' have been provided.²⁷ The Contested Mark is placed prominently and in a large size at the end of the

²⁷ Exhibit RG4.

section. The webpage does not appear to have fully loaded all of the material. Consequently, many of the images for the products are not showing, although the hyperlinks denoting the goods remain. I note the following products held out for sale online:

'Fox' cufflinks; Onyx and gold lapel pin; Mother of pearl and rose gold lapel pin; Red silk and sterling silver bracelet; Grey stone herringbone sterling silver bracelet; Onyx sterling silver bracelet; Turquoise stone sterling silver bracelet.

The Turquoise stone sterling silver bracelet incorporates the image of the Contested Mark in silver form:



I also note the following text at the end of the page/section:

'Vanners is the jewel in England's silk weaving industry, manufacturing Jacquard silk fabrics since the 18th Century to supply the best brands and fashion houses around the world.

[...] We produce the highest quality Jacquard woven silk for accessories such as ties, bow ties and scarves and we also specialise in the finest interior furnishing fabrics and couture design, We wanted to showcase our exceptional designers [sic] skills to offer the best menswear accessories to complement our luxurious ties and we now have many menswear collections including scarves, cufflinks and socks'.

(g) All 24 invoices provided by the RP bear the Contested Mark clearly in the header.²⁸ Although the full customer addresses have been redacted, it is clear that the orders are placed by customers based in the UK. All sums due are expressed in £Sterling. It is convenient to set out the pertinent details by way of the following table:

Invoice date:	Goods ordered:	Location of customer:	Sum due (£Sterling):
23/2/2015	'71% Linen/29% Silk Jac Fancy KASBAH/BUFF'; 5.70 metres.	London, W1R	489.96
4/3/2015	15 metres of 'woven fabric of silk'	London, SW11	1,083.00
21/5/2015	'SS16 [redacted] 206.40 metres' likely indicates fabric of some sort	Scotland	6,811.20
14/7/2015	'SS16_MW_MAIN_FABRIC [redacted]'	London, SW1P	6,072.00
8/1/2016	8 types of fabric of various length	London, SE1	659.86
8/1/2016	8 types of fabric of various length	London, SE1	397.62
8/1/2016	10 types of fabric of various length	London, SE1	614.95
1/9/2016	5 multiple orders of ties in various colours/prints	Berkshire	643.20
29/9/2016	10 types of fabric of various length	Barnet, Hertfordshire	6,357.12
3/11/2016	2 types of silk, 18.2 and 3.4 metres, respectively	London, N1	8,764.19
21/11/2016	5 types of silk, 2 metres of each	London, NW5	676.80

²⁸ Exhibits RG3 (one invoice) and RG10 (23 invoices).

1/12/2016	17 multiple orders of ties	London, W1S	1,934.64
3/2/2020	6 types of fabric, in various lengths (most being approximately 10 metres)	London, W1K	1,896.40
5/2/2020	Over 7 metres each of two types of fabric: silk/linen/wool blend; and cotton/silk/linen blend	Suffolk	1,465.01
6/2/2020	7 lengths of silk fabric, in various colours, each over 25 metres in length.	Southend- on-sea, Essex	11,553.36
7/2/2020	7.8 metres of fabric of some sort	London Bridge	243.36
7/2/2020	34 'Wilton Lobster Hat' ties	Eton Windsor, Berkshire	762.84
10/2/2020	182 ties	London SW1P	4,876.87
19/8/2020	8 types of 'silk/wool blend' fabric, in fairly large amounts (several lengths being over 10 metres)	Suffolk	6,846.44
14/9/2021	4 multiple orders of ties in various patterns/colours	London, WC1A	1,789.27
14/12/2021	4 multiple orders of 'ST Bows' in various patterns/colours. It is presumed that these are bows of some sort, possibly bow ties.	London, WC2A	1,732.25
14/3/2022	39 multiple orders of fabric (in various patterns/colours) described as 'Ties'	London, WC2A	12,576.30

	Fabric/tipping to be made into ties’.		
21/3/2022	A quantity of woven silk fabric	London, WC2A	1,283.04
28/3/2022	6 multiple orders of fabric ‘bows’ in various patterns/colours.	London, WC2A	2,663.81

(h) Examples of product listings of ‘Vanners’ goods, held out for sale by third parties, have been provided, including: Etsy; Vero Fabrics; Haines and Ebay. It is not possible to ascertain the precise dates when the ‘Vanners’ goods were listed. I note that the RP has annotated this exhibit ‘All internet Sources accessed on 05/02/24’, which also post-dates the relevant periods. The listings for the RP’s goods identify them as ‘Vanners’ branded goods. None of the examples in this exhibit show the Contested Mark. However, Mr Gawn gives narrative evidence to address this by way of explaining that, where a textile is offered for sale to be used in a product, the Contested Mark would be presented on or alongside the fabric in question by way of a tag or ‘informative card’.²⁹ Whilst this is noted, this would unlikely be the case in respect of the listings on eBay and Etsy, which, in my view, as a matter of notorious fact, are online selling platforms rather than physical shops.

(i) Mr Gawn states that The Company ‘has been featured in numerous news articles, blog posts, reviews and other third party writings’.³⁰ Several examples have been provided in support of this statement, the pertinent details of which I present in the following table.³¹ (The examples on the second and third page of Exhibit RG12 are illegible due to their extremely small size and will not, therefore, be taken into account).

Date:	Publication/website:	Territory:	Contested Mark shown?
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²⁹ Witness Statement of R.C. Gawn, [15].

³⁰ As above, [26].

³¹ Exhibit RG12.

18/02/2020	Makeitbritish.co.uk	UK	No. The screenshot shows a sound file for a Podcast, titled '[episode] 107 – Silk Weaving in Suffolk – Laura Gore, Vanners', accompanied by the following text: 'Vanners is one of the oldest businesses
2/10/2021	SuffolkNews	UK	Yes – in a photograph of the 'Vanners' sign at the gate to The Company's premises. The article is titled 'Talks under way over the future of Vanners Silk factory buildings in Sudbury' and chronicles the purchase of The Company by the RP in December 2020, following The Company having been in administration.
3/10/2018	www.just-style.com	Unclear	No. An article titled 'Textile firm Vanners Silks harnesses data to improve efficiency' chronicles The Company's adoption of new technology to improve efficiency in the face of the rising costs of silk.
29/12/2020	Drapersonline.com	Unclear	Yes. The Contested Mark is shown on a close-up of what appears to be a tie label. An article titled 'Vanners bought out of administration' announces that the RP has

			bought The Company out of administration.
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The CA's evidence

20. Ms Burchell's evidence comprises:

(a) A copy of the Form AM10, 'Notice of administrator's progress report', in respect of Silk Industries Limited, dated 28 May 2021.³² An extract from this report has also been filed by the RP at Exhibit RG9.

(b) Copies of two news articles:³³

i. An article, dated 3 February 2022, from Suffolk News, titled: 'Vanners Silk factory in Sudbury repossessed by administrators as uncertainty over future of business continues';

and

ii. An article, dated 5 February 2022, from the East Anglian Daily Times, titled: 'Legal action could follow lock-out at Vanners in Sudbury'.

(c) A copy of a letter, dated 6 June 2023, from the CA's representative firm, BRANDED!, marked 'For the attention of the Administrators SILK INDUSTRIES LIMITED', enquiring as to whether the administrator was prepared to negotiate the sale of the contested registration.³⁴ At this point, it is appropriate to refer back to the chronology set out above at [8]. As at the date of this letter being drafted, the Registered Proprietor was Silk Industries Limited, because the recordal of the assignments of 24 December 2020 and 11 February 2022 had not, at that point, been entered on the Register. The Registry was not notified of the assignments until 30 Nov 2023; and the recordals were eventually made on 6 Dec 2023. Consequently, the CA would most likely have been unaware that Mr Gawn himself

³² Exhibit CEB1.

³³ Exhibit CEB2.

³⁴ Exhibit CEB3.

was the owner of the Contested Mark. In the light of this, the administrators of Silk Industries Limited would not have had any authority to make decisions regarding the Contested Mark, because, at that time, the registration had been assigned to the RP; it was no longer an asset owned by Silk Industries Limited.

(d) Copies of records from Companies House have been provided in respect of the following companies/individuals:

- Vanners Silks (Sales) Ltd
- Vanners Silks Ltd
- Portmanteaux Ltd
- Vanners (1740)
- Vanners International Ltd
- Roger Charles Gawn

On the entry for Vanners (1740), the following details have been underlined:

'Nature of business (SIC)

15120 – Manufacture of luggage, handbags and the like, saddlery and harness

45416 – Wholesale of textiles'

The fact that the previous company name was VANNERS SILK (SALES) LTD; and the fact that, on 7 September 2022, accounts for a dormant company were made up.

On the entry for Vanners International Ltd, the six instances of filing of accounts for a dormant company have been underlined.

Assessment of genuine use

21. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³⁵

22. In assessing the body of evidence available to me, I bear in mind the case of *Awareness Limited v Plymouth City Council*, Case BL O/236/13, in which Mr Daniel Alexander Q.C. (as he then was) 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.’

23. I also bear in mind the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person stated that:

‘21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed

³⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.’

24. At this point, it is appropriate to set out the CA’s central arguments on the matter of genuine use.³⁶ The CA has submitted that there has been no genuine use of the Contested Mark for the following reasons:

³⁶ CA’s written submissions of 20 May 2024, [1].

‘(a) the owner of the trade mark at the relevant time was unable to trade by reason of its dormancy;

Or

(b) there had not been a valid assignment of the trade mark registration to the current owner which would enable it to benefit from that use or invoke the trade mark’³⁷

25. It is further submitted, by way of a concession, that if neither (a) nor (b) is accepted by the Registry, then the CA claims that ‘the only use that has been evidenced as having been made of the mark is on ties and braces, and that all the remaining goods should be cancelled on the grounds of non-use’.³⁸ Ms Burchell, in her oral submissions, broadened the concession such that, should the Registry reject arguments (a) and (b), and find that genuine use has been made, then such use would only be in respect of ‘bolts of cloth; ties; braces; cufflinks’.

26. Ms Burchell’s Skeleton Argument also sought to raise a question mark over the meaning of ‘effective licence’, referred to in the RP’s defence. This is addressed below at [38].

27. I consider it appropriate to address the CA’s argument as to The Company’s competence to trade, first.

The ‘dormancy’ argument

28. Ms Burchell’s argument is, essentially, that Vanners International Ltd, which the RP claims is currently using the Contested Mark under ‘effective licence’ from the RP, has, according to Companies House, been a dormant company since at least 2019. I accept that, according to Companies House, Vanners International Ltd appears to have been dormant since at least 7 February 2019, when accounts for

³⁷ CA’s written submissions of 20 May 2024, [1].

³⁸ As above.

a dormant company were filed.³⁹ I invited Ms Burchell to direct me to any relevant authorities on the matter of whether the trading activities of a 'dormant' company (which is, perhaps, something of an oxymoron) can be considered in an assessment of genuine use in the context of trade mark law, however none was forthcoming. My view is that, without being directed to any particular statutory provision and/or legal principle on the matter of whether dormancy precludes a company from legally trading, it would be inappropriate for the Registrar to undertake its own research into this matter. The expectation is that any argument sought to be relied upon by a party is brought to the hearing fully developed; with its legal basis identified, and any relevant legal authorities cited in support. I am, therefore, unable to accept the argument that, to the extent that genuine use has been made out by Vanners International Ltd, such use should be discounted.

The argument on the validity of the assignments

29. I now consider the CA's argument as to the validity of the assignments. The CA, in its written submissions of 20 May 2024, challenged the validity of the two assignments of the Contested Mark on, respectively, 24 December 2020 and 11 February 2022; requesting that the RP produce copies of executed deeds of assignment to substantiate its claims.⁴⁰ The RP duly filed the following:⁴¹

A copy of a document, dated 24 December 2020, titled 'AGREEMENT FOR THE SALE OF ASSETS', in which Silk Industries Limited (in Administration), is named as the Seller (acting by its Administrators) and Vanners Silk (1740) Ltd is named as the Buyer. The deed is signed and witnessed.⁴²

and

³⁹ Exhibit CEB5.

⁴⁰ CA's written submissions of 20 May 2024, [3].

⁴¹ Exhibits RG13 and RG14.

⁴² Exhibit RG13.

A copy of a document, dated 11 February 2022, titled 'DEED OF TRADE MARK ASSIGNMENT', in which Vanners Silk (1740) Ltd is named as the Seller and the RP named as the Buyer. The deed is signed and witnessed. ⁴³

The relevant law on registration of assignments

30. Section 25 of the Act states:

'25 Registration of transactions affecting registered trade mark.

(1) On application being made to the registrar by—

(a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction, or

(b) any other person claiming to be affected by such a transaction,

the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions—

(a) an assignment of a registered trade mark or any right in it;

[...]

31. Rule 49 of the Trade Marks Rules 2008 ('the Rules') states:

**'Application to register or give notice of transaction; sections 25 & 27(3)
(Form TM16, TM24, TM50 & TM51)**

49.—(1) An application to register particulars of a transaction to which section 25 applies or to give notice to the registrar of particulars of a transaction to which section 27(3) applies shall be made—

⁴³ Exhibit RG14.

(a) relating to an assignment or transaction other than a transaction referred to in subparagraphs (b) to (d) below, on Form TM16;

[...]

(e) [...]

(2) An application under paragraph (1) shall—

(a) where the transaction is an assignment, be signed by or on behalf of the parties to the assignment;

(b) [...]

or be accompanied by such documentary evidence as suffices to establish the transaction.’

[My emphasis added]

32. The RP notified the Registry of the two assignments on 30 November 2023 (albeit quite some time after the effective dates of the assignments) by way of the necessary Forms TM16.⁴⁴ Where an application is filed to record the assignment, the information provided on the Form TM16 is taken at face value. As indicated by the wording that I have marked in underline above, the Rules do not stipulate that a deed of assignment be provided, although a party may elect to file such documentation. Following the CA’s challenge to the validity of the assignments, the RP duly provided copies of the executed deeds of assignment. In the instant proceedings, i.e. a revocation action, and not a rectification matter, the Registrar is not obliged to ‘look behind’ the Forms TM16 and/or deeds of assignment. In my view, the validity of the assignments is not in question.

⁴⁴ Application to record a change of ownership.

33. I now consider whether the totality of evidence is sufficient to demonstrate genuine use of the Contested Mark. The sales figures in respect of UK custom, all seven-figure sums, cover the portion of the Relevant Periods up until 30 April 2019, if my interpretation of 'Year ending 30 April' is correct.⁴⁵ I consider these sums to be significant. Additionally, the Administrator's report includes figures for sales generated between 9 November 2020 and 8 May 2021, during The Company's administration period, in the sum of approximately £288,000. The fact that The Company's sales revenue is greatly diminished is entirely to be expected for any business in administration. Nevertheless, I consider this sum to be a fairly noteworthy amount. The sales figures, therefore, span the entirety of the First Relevant Period. For the Second Relevant Period, the figures cover all but the final two years and four months-or-so, i.e. 5 September 2018 to 8 May 2021.

34. The sales figures are supported by a selection of invoices punctuating the portion of the Relevant Periods from 2016 up until 28 March 2022. No invoices have been provided for the portion of the Second Relevant Period 29 March 2022 to 5 September 2023, i.e. a period of approximately a year and five months. All twenty-four invoices bear the Contested Mark as registered, prominently in the header. The majority of the invoices are to a variety of purchasers in locations in the South of England, with a focus on locations in London. A large order of over 206 metres of fabric has been placed by a purchaser based in Scotland, although this predates the Relevant Periods. The majority of the invoices within the Relevant Periods are for bulk orders, from which I infer that the purchasers are likely professionals, including several retailers. The highest value order, dated 14 March 2022, is for 39 types of fabric described as 'fabric/tipping to be made into ties', in the sum of £12,576.30. I infer that this particular purchaser is likely a manufacturer/producer of ties. Many of the invoices show sums due in the four-figures. The lowest value order is for about £240.

35. Wayback prints for dates ranging between 4 June 2016 and 28 July 2020 from The Company's website display the Contested Mark prominently and consistently. Slight differences in the webpage, from time to time, in my view, indicate that the

⁴⁵ My paragraph [18(b)].

site has been updated/maintained over these years. For example, the items listed by way of 'quicklinks' show some variation between years. Furthermore, an example from 2020 chronicles The Company's supply of non-surgical masks, which is contemporaneous with the coronavirus pandemic. Reference in this particular example to the opening times of The Company's Mill shop, from which the masks were available for purchase, demonstrates selling activity under the Contested Mark in 2020.

36. Although many of the photographs of the Contested Mark being used by way of, inter alia, signage/trim outside or within The Company's premises (The Mill Shop), are undated, I have no reason to doubt that these examples are indicative of the manner in which the Contested Mark has been used during the Relevant Periods.

37. The evidence of the RP's goods being held out for sale by third parties is either undated or post-dates the Relevant Periods. Dated examples within the Relevant Periods would have further bolstered the RP's case.

A note on use with consent:

38. It is appropriate, at this point, to consider the matter of consent. Mr Burchell's submissions suggested that she was questioning: the RP's legal competence to consent to third party use of the Contested Mark; and the meaning of the claim that Vanners International Ltd was currently under 'effective licence'. However, she did not develop her submission beyond mere suggestion that these matters were open to question.

39. I note that in the case of *Einstein Trade Mark*, [2007],⁴⁶ Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person found that use with the consent of the proprietor did not require the proprietor to have effective control of the use in question. He stated that:

⁴⁶ RPC 23.

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

and

‘28. The legislative history of the Community rules relating to authorised use also supports the view that it is not quality control, but authorisation sufficient to ensure non-infringement which determines whether the use in question counts as use by the proprietor of the relevant trade mark. The evolution of the provisions now found in Arts 7(1) and 10(3) of the Directive and Arts 13(1) and 15(3) of the CTMR took place in stages, as summarised in Annex A to this decision. It was evidently accepted by the Community legislature that authorisation (consent) rather than quality control should result in the permitted use of a trade mark being attributed to the proprietor.

29. This subsequently became the governing principle in Art.5 of the Joint Recommendation Concerning Trademark Licenses adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organisation (WIPO) at the Thirty-Fifth Series of Meetings of the Assemblies of the Member States of WIPO (September 25 to October 3, 2000):

“Use of a mark by natural persons or legal entities other than the holder shall be deemed to constitute use by the holder himself if such use is made with the holder's consent.”

As noted in the Explanatory Notes to the proposal from the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (Document ref. SCT/5/4 June 8, 2000)

“5.03 The effect of Article 5 is that, whenever the question of use becomes relevant, any use of a mark by any person other than the holder must be deemed to be use of the mark by the holder, provided that such use is made with the consent of the holder. No other condition, such as control by the holder of the use of the mark, may be required by a Member State. Consequently, if, in the absence of use of the mark by the holder, a third party uses that mark with the consent of the holder, the mark cannot be invalidated on the ground of non-use. To this extent, Article 5 goes beyond Article 19.2 of the TRIPS Agreement.

5.04. However, Article 5 only deals with the specific question under what circumstances use by natural persons or legal entities other than the holder can be deemed as use by the holder. It does not address the validity of licensing agreements in general. Therefore, the ability of Contracting Parties to require quality control clauses in order for a licensing agreement to be valid remains unaffected.

5.05. Article 5 would apply independently of whether or not a licence exists or, if a licence exists, whether or not the licence is recorded. Hence, it is sufficient for the holder to consent to the use of his mark in order to benefit from such use whenever the question of use becomes relevant, i.e. in the context of a trademark acquiring distinctiveness or becoming well-known, or for the purpose of maintaining a trademark registration. In essence, any use of the mark by any third party to which the holder consents must be considered use by the holder.’

[my emphasis added]

40. It is clear from the above dicta that it is not necessary for the proprietor of a trade mark to formalise its consent to third party use of its mark by way of a licencing agreement, or any other formality, in writing. Consent can be by way of a bare permission to use the mark. The evidence demonstrates that the RP is director of

Vanners International Ltd to which a 'licence' is said to have been granted. I do not consider it rational to argue that a permission granted by the RP, to a company of which he is director, does not amount to consent. Furthermore, consent could be inferred even if the RP was not a director of the purported licensee company. Indeed, the evidence (albeit undated) of collaboration with third parties, which shows the Contested Mark being used on goods, alongside the mark of the collaborator, would also amount to consent. In the instant case, I find that the RP's consent is demonstrated by virtue of his narrative evidence that Vanners International Ltd is using the mark. Whilst it may be the case (and I have no evidence to determine this either way) that there is no formal licence by way of executed documentation, there is no need for such formality. In my view, it is not necessary to analyse the RP's wording 'effective licence', or to treat it as any term of art. I interpret it simply as a synonym for 'informal permission'.

41. In the light of the foregoing, I find that the RP's evidence, in the round, succeeds in demonstrating that the Contested Mark has been used for the entirety of the First Relevant Period and for a significant proportion of the Second Relevant Period. I find that there has been genuine use for the purposes of the instant revocation.

Fair Specification

42. Following my dismissal of Ms Burchell's arguments on 'dormancy' and the validity of the assignments, the CA's concession, detailed above at [25], crystallises at this point. The CA is, therefore, committed to accepting that the Contested Mark has been used in respect of the following goods:

'bolts of cloth; ties; braces; cufflinks'.

43. I now proceed to frame a 'fair specification'.

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

‘In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.’

45. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

‘245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.'

46. For ease of reference, I set out the RP's specification, once more, thus:

<p>Class 14: <i>Jewellery; costume jewellery; decorative articles for personal use; cufflinks; tie pins; tie clips; tie bars; badges; shirt studs; stickpins; jewellery and metal accessories for personal use, all including precious metals, enamels, silk yarns, precious stones or miniature prints.</i></p>
<p>Class 24: <i>Fabrics, textiles and textile goods; natural and synthetic fabrics and textiles; silk fabrics; woven silk fabrics; woven mixed fabrics; silk/linen mixed fabrics; silk/cotton mixed fabrics; fabrics including metallic and technical yarns; fabrics for furnishing; fabrics for interior decoration; fabrics for clothing; fabrics for bridal wear; fabrics for neckwear, ties, cravats, scarves, pocket squares, bowties and cummerbunds</i></p>
<p>Class 25: <i>Clothing, footwear, headgear; ties; cravats; scarves; pocket squares; bowties; cummerbunds; silk clothing; silk ties, silk cravats, silk scarves, silk pocket squares, silk bowties, silk cummerbunds and silk neckties.</i></p>

47. A large proportion of the invoices relate to sales of silk fabrics, including blends of silk/wool, silk/wool/linen and cotton/silk/linen. It is my understanding that these materials are all 'natural' as opposed to 'synthetic' fabrics such as nylon or viscose, for example. The invoices also demonstrate the sale of many ties. Wherever the

material is identified, it is either silk or one of the aforementioned silk 'blends'. It is presumed that the references to 'bows' are to bow-ties. The largest order is in respect of 'fabric/tipping to be made into ties'. Photographs show use of the mark in respect of suspenders/braces, although it is not possible to determine the date of this evidence. Excerpts from The Company's webpages show product listings for cufflinks, bracelets and lapel pins.

48. My view is that the evidence does not demonstrate use of the mark in respect of goods beyond the following: fabrics, ties, suspenders/braces, natural fabrics (of silk or silk blends), bracelets, stickpins and cufflinks. The mark has been used in respect of a number of fabrics aside from pure silk; i.e. blends composed, variously, of silk with linen, cotton or wool. The invoices indicate fabrics composed of varying per centages of silk/linen/cotton/wool; some of which blend silk with one other material, and others being blends of silk with two other materials. There is evidence of the mark having been used for 'jacquard' silk fabric, a particular sub-type of silk fabric by virtue of the weaving technique to create the textures characteristic of it. It is evident in images and product descriptions for the metal accessories that they are fashioned from, variously: gold, silver, mother of pearl and turquoise stones. I can see no obvious use of enamel or 'miniature prints' in these items. I understand 'textiles' to be a broad term which will encompass various fibre-based material beyond cloths, such as, inter alia: fibres, yarns, threads and filaments. There is nothing in the evidence to indicate that the mark has been used to these latter items. Furthermore, 'textile goods' is a broad term covering a wide array of finished goods such as tablecloths, towels and curtains, to name but a few. In my view, the mark has not been shown to have been used in respect of such finished goods, or goods of that ilk.

49. In the light of the foregoing, I consider the following to be a fair specification, the revisions by way of additional wording marked in underline:

Class 14:

Jewellery, namely bracelets; decorative articles for personal use, namely bracelets, lapel pins and cufflinks; cufflinks; stickpins; jewellery and metal

accessories for personal use, namely bracelets, lapel pins and cufflinks, all including precious metals, silk yarns or precious stones.

Class 24:

Fabrics;; natural fabrics; silk fabrics; woven silk fabrics; woven mixed fabrics; silk/linen mixed fabrics; silk/cotton mixed fabrics; fabrics for furnishing; fabrics for interior decoration; fabrics for clothing; fabrics for neckwear, ties, cravats, scarves, pocket squares, bowties and cummerbunds.

Class 25:

Clothing, namely ties, bowties and suspenders (braces); ties; bowties; silk clothing, namely ties; silk ties, silk bowties, silk neckties

Conclusion

50. The RP has *demonstrated* genuine use for the goods specified above at [49].

51. The RP has *failed to demonstrate* genuine use for the following goods:

Class 14:

costume jewellery; tie pins; tie clips; tie bars; badges; shirt studs; [jewellery and metal accessories for personal use to the extent that they all include] enamels or miniature prints.

Class 24:

[...] textiles and textile goods; natural [...] textile goods; synthetic fabrics and textiles; fabrics including metallic and technical yarns; fabrics for bridal wear.

Class 25:

footwear, headgear; cravats; scarves; pocket squares; cummerbunds; silk cravats, silk scarves, silk pocket squares, silk cummerbunds.

52. Consequently, the *Application* to revoke registration UK00003145398 has:

- *failed* in respect of the goods listed above at **[49]**; and
- *succeeded* in respect of the goods listed above at **[51]**.

53. Subject to a successful appeal, the RP's registration UK00003145398:

- may remain registered only for the goods specified above at [49];

and

- is revoked, from the earliest revocation date sought, 16 April 2021, only for the goods specified above at [51].

Costs

54. Both parties have enjoyed a measure of success. I therefore make no order for costs.

Dated this 25th day of July 2025

N. R. Morris

For the Registrar,

the Comptroller-General