o/805/25

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK2645011
IN THE NAME OF
MARCOS CARS LTD

IN RESPECT OF THE TRADE MARK

IN CLASSES 12 & 25

AND THE APPLICATION FOR THE REVOCATION THEREOF
UNDER NO. 503582

BY MARCOS SPORTSCARS LIMITED

BACKGROUND AND PLEADINGS

1. The trade mark shown on the cover page of this decision ("the Contested Mark") stands in the name of Marcos Cars Ltd ("the Registered Proprietor"). The details of the marks are as follows:

Filing date: 7 December 2012
Registration date: 10 May 2013
The goods as registered are as follows:

> Class 12: Vehicles; apparatus for locomotion by land; motors and engines for land vehicles; vehicle body parts and transmissions.
>
> Class 25: T-shirts; base ball caps; sweat shirts and shirts.

2. On 21 January 2021, Marcos Sportscars Limited ("the Cancellation Applicant") filed an application for revocation against all of the goods under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (the Act).

3. The period during which the applicant alleges non-use under section 46(1)(a) is the five years after registration of the mark, being 11 May 2013 to 10 May 2018 with revocation sought from 11 May 2018. Under the section 46(1)(b) ground, the applicant is alleging non-use of the mark for two periods, being 21 January 2016 to 20 January 2021 with revocation sought from 21 January 2021 and 22 October 2015 to 21 October 2020 with revocation sought from 22 October 2020.

4. The Registered Proprietor stated that the mark was put to genuine use in relation to all goods during each of the above periods.

5. Both parties provided evidence in these proceedings. The Registered Proprietor requested a main hearing which took place on 7 August 2024. The Cancellation Applicant did not attend and instead filed submissions.

6. The Registered Proprietor represented themselves and the Cancellation Applicant is represented by Maguire Boss.

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.

Evidence

8. The Registered Proprietor's evidence consists of a witness statement dated 26 July 2023 by Anthony Brown, who is the owner of Marcos Cars Ltd, together with seven appendices. The main purpose of the evidence is to demonstrate the use that has been made of the registration or that there was a genuine reason for non- use.

9. The Cancellation Applicant also provided evidence in the form of a witness statement from David Tate who is a trade mark attorney at Maguire Boss. This is dated 23 October 2023 and accompanied by 3 exhibits (which are previous witness statements and their accompanying documents). The majority of the evidence from the Cancellation Applicant refers to previous proceedings between the parties.

10. I note that both parties have made references to previous proceedings and ongoing disputes between the parties. For the avoidance of doubt, the focus of this decision is solely based upon the claims made in the Form TM26N. I am not bound by previous decisions of the Registry, especially ones relating to other marks and I will consider the claim on the basis of the relevant evidence and submissions in front of me.

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

DECISION

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

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 4 registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
>
> (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

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

(4) […]

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

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

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

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

13. Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

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 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]; *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]."

15. I remind myself that there are three periods of use requested by the Cancellation Applicant. The first is the five years following the date on which protection was granted in the UK. This would therefore be 11 May 2013 to 10 May 2018. There are also the two periods that the Cancellation Application has noted within its Form TM26N as follows: 21 January 2016 to 20 January 2021 and 22 October 2015 to 21 October 2020. I note that there is a significant overlap in all of the above use periods.

Evidence

16. Mr Brown states within his witness statement that the mark has been used continually since it was registered on development vehicles, components fitted to the vehicles, clothing, company documentation, including letters, emails and invoices.

17. He stated that some of these were provided in appendix I to his witness statement. I can see extracts of four invoices which relate to livery or graphics. These appear to be invoices where the Registered Proprietor has paid another company to provide them with livery and graphics printed onto what Mr Brown confirmed at the hearing is his prototype car as well as stickers of the above mark that were given away at events. These are not, therefore, evidence of sales made under the mark but rather purchases made of promotional material.

18. Next is a photo of a 'rev counter' from a car dashboard shown bearing the mark:[1]

[1] Page 11 of Witness Statement of Anthony Brown

19. Mr Brown has provided an invoice relating to the hire of his prototype car for a race track. The invoice is dated 22 June 2017 for a total of £550.[2]

20. Following on from this are two invoices from a company called “Make Your Mark” for t-shirts, fleeces, jackets and baseball caps bearing the Contested Mark totalling £582 and £390 respectively. Mr Brown stated that these goods were used at shows and exhibitions in 2013 and 2014. Photos of some of these t-shirts being worn at shows follow (Mr Brown states these photos are from 2014).[3]

21. Mr Brown states that he has built a “number of body shells” as development cars as well as the first production model which was put on hold by the client until the beginning of this year. He explains this is shown by the invoice dated 27 July 2018 bearing the mark in the top right corner. This invoice relates to “Build chassis 003 and fit body 001a spirit220 evolution Build to track day speck amount required is £43,000 deposit taken for £10,000”.[4]

22. Mr Brown explained that there had been a previous car company that used the name ‘Marcos’ but the original company has not been trading for some time. I mention this here as the next invoice provided by Mr Brown under the Contested Mark relates to work he undertook on a Marcos car – being one of the cars made under the previous Marcos company and not his own. This invoice totals £4,464.99. As pointed out by the Cancellation Applicant in their submissions, this does not relate to the goods for which

[2] Page 12 of the Witness Statement of Anthony Brown
[3] Page 12 of the Witness Statement of Anthony Brown
[4] Page 14 of the Witness Statement of Anthony Brown

the Contested Mark is actually registered for – the invoice would actually relate more to vehicle repair services and not the sale of cars/vehicles themselves for which the mark is registered and is therefore of little assistance.[5]

23. Appendix II contains a screenshot from the Facebook page of the Registered Proprietor. This screenshot is not dated and shows some of the same photos previously provided by Mr Brown above.

24. Appendix III is a further undated screenshot, this time showing the website of the Marcos Owners Club. Mr Brown mentioned that he gave permission for the contested mark to be used unconditionally by the Marcos Owners Club in 2013 until such a time as he asked for it not to be used. He explains that they have used it in magazines, on their website, on promotional material and other regalia although no examples of this have been provided in the evidence. The contested mark appears at the bottom of the webpage.

25. Turning now to Appendix IV, this contains the Micro-entity balance sheet for 2017 for Marcos Cars Ltd. This is of little assistance in these proceedings as I have not been provided with any further information as to what this balance sheet shows and so it does not help me ascertain sales figures or what is being sold.

26. There are articles within Appendix V, firstly dated 3 October 2013 from the Western Telegraph. This article states that Mr Brown is looking to start manufacturing sports cars and that he had already built a prototype for the track. The second article is also from the Western Telegraph and is dated 19 July 2014 and has the headline ‘Tony hopes to make history at Pendine’ together with a photo which has the following description ‘Tony Brown and his Marcos Spirit 220 prototype’.

27. Appendix VI shows a screenshot of a website with polo shirts available, including two options which have the mark on the chest.

28. Within his witness statement Mr Brown comments that he was:

[5] Page 14 of the Witness Statement of Anthony Brown

"forced to scale down all our activities towards the latter part of this period due to restrictions placed on us by the Government and Welsh Assembly, due to the pandemic, developmental research continued as did communications with our suppliers and interested parties. In Wales, where we are based, there were travel restrictions that prevented me using workshops and prevented distributors supplying materials for building and development".[6]

Analysis

29. The mark, as registered has been shown on some invoices, on a car and on some polo shirts.

30. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the registration, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year periods. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods for which use has been shown;
- The nature of those goods and the market(s) for them; and
- The geographical extent of the use shown.

31. 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.[7]

32. The Registered Proprietor has not provided me with any turnover figures or sales figures in relation to any of the goods the contested mark is registered for. I do not

[6] Paragraph 15.1 of the Witness Statement of Anthony Brown
[7] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

have any consolidated figures in relation to marketing expenditure, however, I believe it is reasonable to attribute the invoices payable to 'D-Sign Studio' and 'Make Your Mark' in Appendix I to marketing.

33. In relation the to class 25 goods, being 'T-shirts; base ball caps; sweat shirts and shirts', the only evidence I have been provided with that shows clothing available to purchase is the screenshot of the polo shirts for sale. As pointed out by the Cancellation Applicant in their submissions, there is no evidence of any actual sales. All other evidence showing clothing bearing the contested mark appears to be promotional wear at no more than a handful of events rather than being offered for sale to the public. I also have no sales or marketing figures relating to these goods. It goes without saying that the clothing market is extremely large and therefore even a small market share could be significant, however, I have not been given any evidence that allows me to make a finding that there has been genuine use in relation to these goods.

34. I turn now to the goods registered in class 12. Again, I am lacking in sales figures other than one invoice where a deposit was paid for Mr Brown to begin building a 'chassis 003 and fit body 001a spirit220 evolution Build to track day speck'. I note the Cancellation Applicant's submission that as the Registered Proprietor is waiting at this time to continue with the order so therefore it falls outside the relevant dates however, the order itself was seemingly started within the relevant period. Mr Brown confirms himself that this is not yet completed but that he has spent time over these past years developing the car. I don't doubt that it takes significant amounts of time to develop a car from scratch to the point it is roadworthy and ready for sale, particularly by a smaller independent outlet. I have seen some form of advertising in the evidence – showing the prototype car at events, for example. However, the evidence does not direct me to exactly what it is Mr Brown is aiming to sell when he attends those events.

35. In *Polfarmex S.A. v EUIPO*, Case T-677/19, EU:T:2020:424, the General Court ("GC") upheld a decision by the EUIPO Board of Appeal that, despite there being no sales in the relevant period, there had been genuine use in relation to racing cars. The court noted that unlike 'sports cars', the market for racing cars is a small and specialist one. After reviewing the evidence (including cooperation and co-existence

agreements, presentation of the cars at sporting events, press articles, brochures, correspondence from a company seeking to purchase a particular model and evidence of orders which were placed but later cancelled), the GC said:

> "69. Moreover, the content of all those documents is not disputed by the applicant. Likewise, it should be noted that, in the light of the observations in paragraphs 63 to 68 above, the applicant is not justified in claiming that the goods covered by the contested mark were never actually placed on the market or were never about to be placed on the market. It should be specified that the placing on the market of goods or services also includes circumstances in which that product or service is actually offered for sale, even if it has not yet been sold.
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> 70. It must also be stated that the Board of Appeal, in paragraph 48 of the contested decision, relied on the Court's case-law, which it was fully entitled to consider relevant in the present case. **As is apparent from the case-law, it is common knowledge that the market for high-end sports cars with technical specifications that are not intended for normal, everyday road use and the price of which exceeds that of most private use cars is often characterised by relatively low demand, by production to specific order and by the sale of a limited number of vehicles**. The Court held that, in such circumstances, the provision of accounting documents setting out sales figures or invoices is not necessary for the purposes of establishing genuine use of the mark in question. Further, the Court noted that publications demonstrated that the mark in question was the subject matter of public discussion in anticipation of a revival of production and sale of a car model bearing the mark in question (see, to that effect, judgment of 15 July 2015, *TVR ITALIA*, T-398/13, EU:T:2015:503, paragraph 57).
>
> 71. It follows that, having regard to the specific features of the relevant market, duly taken into account by the Board of Appeal when it relied on the case-law cited in paragraph 70 above, the evidence produced by the intervener shows the existence of various preparatory tasks and advertising efforts in relation to the SYRENA Meluzyna R model. Moreover, it shows, as contended by EUIPO,

not only that the car was about to be marketed, but also that it was available to order.

72. Moreover, it should be borne in mind that, contrary to the applicant's claims, it is apparent from the case-law cited in paragraph 41 above that use of the mark can be shown by evidence that the goods at issue are about to be marketed.

73. Accordingly, the Board of Appeal was fully entitled to consider that genuine use of the contested mark had been shown in respect of sports cars. That finding cannot be called into question by the applicant's other arguments." **(My emphasis)**

36. I do not consider that Mr Brown is producing cars that can be categorised as high-end sports cars. This is due to the price point of his cars being around £50,000, and therefore this takes us away from the finding in the above case.

37. Further, the only thing I have in evidence before me which shows advertising/press coverage of the goods at issue are from a localised newspaper. I therefore consider this to have a limited reach and there is no evidence to suggest any further audience it might have reached. Whilst it could be argued that the t-shirt evidence could also amount to advertisement of Mr Brown's mark at shows, I consider this evidence to be of limited assistance as I have not been provided with any accompanying evidence to show what Mr Brown was presenting at those shows or if the people at those shows knew that the t-shirts were related to the car.

38. I must also note that there are three relevant periods to consider for this matter and that the evidence is not consistent throughout all three. Rather, there is some evidence in the first relevant period (being the press articles and t-shirts being worn at shows) but no further articles or advertising comes in the second and third periods. The invoice for the production of a singular car comes in 2018 which falls outside of the first relevant period. As such, those points cannot be used together to form evidence in the same relevant period. Therefore, on the face of the evidence before me, I cannot make a finding of use in relation to the class 12 goods.

39. I note that the current class 12 specification includes 'motors and engines for land vehicles; vehicle body parts and transmissions' but I have not been provided any evidence in relation to these goods specifically and I would consider the rev counter put forward in evidence (which the Cancellation Applicant submits is actually provided by another company anyway) to be an instrument and not a vehicle body part and therefore, it is of no assistance here.

Conclusion

40. The application for revocation is successful in its entirety and the date for revocation will be 11 May 2018 for all goods.

Costs

41. The Cancellation Applicant has been successful and is therefore entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 2/2016. I have not awarded the Cancellation Applicant any costs in relation to their own evidence as it was not relevant to the current proceedings. In the circumstances, I award the Cancellation Applicant the sum of £700. The sum is calculated as follows:

Official fee	£200
Preparing application for revocation and considering the other side's statement	£200
Preparation of submissions in lieu of a hearing	£300
Total	**£700**

42. I therefore order MARCOS CARS LTD to pay MARCOS SPORTSCARS LIMITED the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of August 2025

L Nicholas

For the Registrar