

O/0607/23

TRADE MARKS ACT 1994

**TRADE MARK REGISTRATIONS UK439845, UK477782, UK477783, UK583123,
UK1582199, UK2006310, UK2012466**

AND

INTERNATIONAL TRADE MARK IR1174169

IN THE NAME OF SAIC MOTOR CORPORATION LIMITED

AND

APPLICATIONS 504611-18

BY MORRIS COMMERCIAL LIMITED

TO REVOKE THE TRADE MARKS FOR NON-USE

Background and pleadings

1. This decision covers eight consolidated applications by Morris Commercial Limited (“the applicant”) to revoke trade marks consisting of, or including, the word MORRIS on the ground of non-use. All but one of the eight marks at issue were at one time registered in the name of MG Rover Group Limited (“MGR”). In 2001 and 2003, MGR granted British Motor Heritage Limited non-exclusive, royalty-free, licences to use the MORRIS marks. Following the demise of MGR, seven of the marks were assigned. The current proprietor is SAIC Motor Corporation Limited (“the proprietor”). The 2001/2003 licences remain in force because they apply to MGR’s successors in title. The eighth mark at issue is an international registration filed in the name of the proprietor in 2013 and subsequently protected in the UK.

2. The marks concerned are set out in the following table.

<i>Trade mark</i>	<i>Date of registration/ protection in UK</i>	<i>Goods/services</i>
MORRIS UK439845	14/08/1923	Class 12: Motor cars and motor-chassis; but not including platform trucks propelled by electric batteries and trucks fitted with mechanical means for lifting, lowering and handling the load.
MORRIS UK477782	14/02/1927	Class 7: Parts of engines for motor cars. Class 12: Engines and gearings for motor cars and motor car chassis and parts thereof.
MORRIS UK477783	14/02/1927	Class 6: Locks, lock mechanisms, lock covers, boxes, badges, emblems, signs, nameplates, identification plates, cocks (valves), tubes, pipes, piping, brackets, screws, nuts, bolts; washers, clips, fasteners, pins for engineering use, binges, springs, cables, and hooks, all being

		<p>components, parts and fittings of metal for motor cars and motor car chassis.</p> <p>Class 7: Electric ignition sparking plugs and piston rings, all being components, parts and fittings of metal for motor cars.</p> <p>Class 9: Electric contacts and terminals; electrical cutouts; electric switches; all being components, parts and fittings of metal for motor cars and motor car chassis.</p> <p>Class 11: Lamps; reflectors for lamps and lights; all being components, parts and fittings of metal for motor cars and motor car chassis.</p> <p>Class 12: Components, parts and fittings for motor car chassis, all being metal.</p> <p>Class 17: Gaskets of metal being components, parts and fittings for motor cars and motor car chassis.</p>
MORRIS UK583123	28/01/1938	Class 7: Marine internal combustion engines and internal combustion engines for industrial machinery and parts of such engines; but not including engines and parts thereof for lifting, lowering and conveying machinery.
MORRIS MINOR UK1582199	18/08/1994	Class 25: Articles of outerclothing, footwear, T-shirts, boxer shorts, and ties; all included in Class 25.
MORRIS MINOR UK2006310	8/12/1995	Class 12: Motor cars; parts and fittings for motor cars; shaped or fitted mats for motor cars; shaped covers for motor cars and for motor car seats.

<p>MORRIS MINOR</p> <p>UK2012466</p>	<p>29/03/1996</p>	<p>Class 28: Toys, games and playthings; scale model vehicles.</p>
<p>MORRIS GARAGES</p> <p>IR1174169</p>	<p>21/02/2014</p>	<p>Class 12: Automobile; wheels; hydraulic systems for vehicles; engines for land vehicles; coupling components for land vehicles; propulsion mechanism for land vehicles; shock absorbers for automobiles; vehicle chassis; transmission shafts for land vehicles; connecting rods for land vehicles, other than parts of engines; gear boxes for land vehicles; rear mirrors; windscreens; anti-theft devices for vehicles; interior decorations for automobiles; safety seat for children for land vehicles; repair outfit for inner tubes; tires for vehicles; brakes for land vehicles; bodies for vehicles; caps for vehicles petrol tanks; couplings for land vehicles; shock absorbing springs for vehicles; direction signals for vehicles; vehicles for locomotion by land, air, water or rail.</p> <p>Class 37: Repair information relating to vehicles; installation and repair of heating equipment; installation, maintaining and repair of machines; installation and maintenance of illuminating apparatus; maintenance and repair of vehicles; vehicle service station for refueling and maintenance; installation and maintenance of entertainment or sports apparatus.</p>

3. The applications for revocation were filed on 24th February 2022. They are made under section 46(1)(b) of the Trade Marks Act 1994, which is as follows:

“46(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) –

(b) that [genuine] use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(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 trademark to goods or to the packaging of goods in the United Kingdom solely for export purposes.”

4. The applicant claims that the contested trade marks were not put to genuine use in the UK during the period 24th February 2017 to 23rd February 2022 (“the relevant period”) and should therefore be revoked in full, effective from 24th February 2022.

5. The proprietor filed counterstatements resisting the applications on the ground that the marks were put to genuine use during the relevant period. In this connection, the proprietor claims that it is the successor in title to MGR. It further pleads that:

“2. MGR entered into Trade Mark Licence agreements dated 30 November 2001 and 1st August 2003 with British Motor Heritage Limited (BMH) with regard to a range of Trade Marks then owned by MGR including “MORRIS – word and all logos and in conjunction with MINI (Classic)”. The...Trade Mark[s] [are] thus covered by these licence agreements.

3. Under the terms of said licence agreements BMH have a non-exclusive, perpetual, royalty free licence to use the Trade Marks. BMH also make the Trade Mark[s] available for license by third parties.

4. BMH have continuously since at least 2001 either directly or via its licensees supplied goods including parts and components under the registered marks.”

6. Both sides seek an award of costs.

Evidence

7. Only the proprietor filed evidence. This consists of a short (2 pages) witness statement by Graham Payne with 13 supporting exhibits. Mr Payne is the Managing Director of British Motor Heritage Limited (“BMH”). His evidence is intended to show that BMH used, or authorised others to use, the contested trade marks during the relevant period in relation to:

- (i) Parts, components and accessories for vehicles bearing the MORRIS and/or MORRIS MINOR trade marks;
- (ii) Clothing in class 25 and toys or scale model vehicles in class 28.

Representation

8. The applicant is represented by Page, White and Farrer Limited. The proprietor is represented by HGF Limited. A hearing took place (remotely) on 21st April 2023. Mr James St. Ville KC appeared as counsel for the applicant. Mr Daniel Selmi appeared as counsel for the proprietor.

The law

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

10. In *Walton International Ltd & Anor v Verweij Fashion BV*¹ Arnold J (as he then was) summarised the case law of the CJEU relating to genuine use as set out in *Ansul BV v Ajax Brandbeveiliging BV*,² *La Mer*,³ *Sunrider Corp v OHIM*,⁴ *Verein Radetsky-Order v Bundesvereinigung Kamaradschaft*,⁵ *Silberquelle GmbH v Maselli-Strickmode GmbH*,⁶ *Leno Merken BV v Hagelkruis Beheer BV*,⁷ *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG*,⁸ *Reber Holding & Co KG v OHIM*,⁹ and *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*,¹⁰ and concluded as follows:

“(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: Ansul at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: Ansul at [36]; Sunrider at [70]; Verein at [13]; Leno at [29]; Centrotherm at [71]; Reber at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: Ansul at [36]; Sunrider at [70]; Verein at [13]; Silberquelle at [17]; Leno at [29]; Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: Gözze at [43]-[51].

¹ [2018] EWHC 1608 (Ch)

² Case C-40/01

³ Case C-259/02

⁴ Case C-416/04 P

⁵ Case C-442/07

⁶ Case C-495/07

⁷ Case C-149/11

⁸ Case C-609/11 P

⁹ Case C-141/13 P

¹⁰ Case C-689/15

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: Ansul at [37]. Internal use by the proprietor does not suffice: Ansul at [37]; Verein at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71]; Reber at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de

minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72] and [76]-[77]; Leno at [55].

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

11. Section 100 of the Act is also relevant. It states:

“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.”

12. In *Awareness Limited v Plymouth City Council*,¹¹ Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

¹¹ Case BL O/236/13

The MORRIS mark in class 7

13. It is convenient to start by considering the MORRIS mark registered in class 7 under UK583123. The registration covers internal combustion engines for marine and industrial machinery and parts of such engines. Mr Payne says nothing about the use of MORRIS in relation to such engines. Mr Selmi's skeleton argument refers to exhibits 5, 8 and 10 to Mr Payne's statement. I don't understand why. Those exhibits relate to parts for cars not marine engines or engines for use in industrial machinery. There is plainly no use of MORRIS in relation to the goods covered by UK583123. Consequently, the registration of the mark for these goods will be revoked for non-use.

The MORRIS MINOR marks in classes 25 & 28

14. I next turn to the MORRIS MINOR marks registered for (broadly) clothing and toys under UK1582199 and UK2012466.

15. The licences between BMH and MGR dated 30th November 2001 and 1st August 2003 are in evidence.¹² The earlier licence is essentially an agreement for BMH to market replacement parts and components for out-of-production motor cars and models bearing MGR's trade marks. This includes "*MORRIS – word and all logos and in conjunction with MINI (Classic).*" The later licence covers "*merchandise.*" The goods constituting 'merchandise' are not specified. The purpose of the later licence is recorded as serving "*...the common interest of keeping the ... trade marks in use.*"

16. The licences provide for BMH to grant sub-licences, but not without the prior written consent of MGR. The licences include provisions for termination but are otherwise binding on the parties' successors in title. They are governed by English law. The territorial scope of the earlier licence is expressly stated as being "*the world.*" The territorial scope of the later licence is not expressly stated, but plainly includes the UK.

17. As regards class 28, Mr Selmi drew my attention to page 2 of exhibit 3 to Mr Payne's statement, which he claimed showed use of MORRIS in relation to toy cars. The exhibit comprises three pages downloaded from BMH's website on 21st April 2022

¹² See exhibits 2 & 3

(i.e. two months after the applications for revocation were filed). It is the section of BMH's website devoted to licensing. The first page proclaims that BMH represents the classic marques Austin, Morris, Austin Mini, Morris Mini and others. The second page shows some model cars recognisable as scaled down versions of the original Mini motor car. The accompanying text says that "*Brandgenuity are the exclusive licence agent for BMW working with Mini and help to celebrate the rich history of these legendary brands through global licensing partnerships.*" Mr Selmi submitted that taken with Mr Payne's evidence and the licence agreements in evidence, this showed genuine use of the MORRIS marks in relation to toys and scale models in class 28.

18. However, as Mr St. Ville pointed out, there are numerous problems with this submission. The most obvious are:

1. None of the pages show the mark MORRIS on, or in relation to, the scale models shown;
2. Use of the name Morris simply on the badge of the model vehicle would not in any event be use of MORRIS as a trade mark for model cars;¹³
3. There is no explanation in the evidence as to the relationship between BMH and Brandgenuity, who are described on the webpage as the exclusive licence agent for "*BMW working with Mini*";
4. Mr Payne says nothing at all in his statement about the pages from exhibit three relied on by Mr Selmi at the hearing;
5. Consequently, there is no evidence that the webpage relied on at the hearing even existed during the relevant period;
6. The offer of global licensing partnerships in April 2022 clearly included an offer to licence the marks including in the UK, but it does not show that any such licence existed during the relevant period, let alone that any model cars were actually marketed in the UK under the MORRIS mark;
7. The registered mark is MORRIS MINOR, not just MORRIS.

¹³ CJEU, Case C-48/05 *Adam Opel v Autec*

19. For these reasons I find that the proprietor has not shown that MORRIS MINOR was put to genuine use in relation to any goods in class 28 during the relevant period. Consequently, trade mark UK2012466 will be revoked for non-use.

20. As regards Class 25, Mr Payne's statement draws attention to an example of the use of MORRIS marks in relation to clothing in exhibit 4.¹⁴ The exhibit is a copy of a document called a BMH 'Brand Deck'. It appears to have been downloaded from the website bmh-ltd.com. The page in question shows use of a logo bearing the word MORRIS above a T-shirt bearing a picture of a Morris Minor vehicle and, below that, in small script, the words and numeral 'Morris Minor 1000'. As Mr St. Ville pointed out, the use of MORRIS MINOR on the T-shirt is purely decorative in nature rather than as a trade mark for the product. In fact, the trade mark for the T-shirt is visible in the neck of the garment and it is not MORRIS (or MORRIS MINOR).

21. Mr Payne offers no explanation of what the 'Brand Deck' document is, when it was created (other than the fact that it is record as having been indexed as 2021.pdf), or who has seen or used it. It appears to be a marketing document for attracting potential sub-licensees. There is no specific evidence that it was made available to the public during the relevant period, or that anyone actually took a sub-licence for using MORRIS MINOR in relation to T-shirts. This is plainly hopeless as evidence of genuine use of MORRIS MINOR in the UK during the relevant period, with the consent of the proprietor, to create or maintain a market for T-shirts under the mark.

22. At the hearing, my attention was also drawn to a page in exhibit 5, which consists of BMH's Parts Guide and price list from 2018. One of the pages of this exhibit¹⁵ shows a leather jacket, a pair of gloves, and two T-shirts with prices in Pounds Sterling. Mr Payne does not mention this exhibit in his evidence in the context of showing use of MORRIS/MORRIS MINOR in relation to clothing. This is not surprising because the page to which Mr Selmi drew my attention shows no use whatsoever of any MORRIS mark. It is not clear why this page was included in the evidence. It is self-evidently irrelevant.

¹⁴ On page 8

¹⁵ Numbered 17 or 18 in the paginated bundle

23. I conclude there is no evidence of genuine use of MORRIS MINOR during the relevant period in relation to clothing. Trade mark registration UK1582199 will therefore be revoked for non-use.

The MORRIS mark in classes 6, 7, 9, 11, 12 & 17

24. I now turn to the registrations of **MORRIS** under UK439845, UK477782 & UK477783 in relation to motor cars and motor car chassis and parts and fittings therefor. The evidence of use of this mark appears to fall into three categories:

1. Use of MORRIS by BMH to designate replacement parts for cars sold under that mark;
2. Use by BMH of a MORRIS logo in relation to spare parts;
3. Use of MORRIS by third party 'Approved Specialists' to designate parts for cars sold under that mark and, in one case, also as part of their trading name.

25. Mr Selmi submitted that there is no requirement as a matter of law that the Proprietor must exercise control over the party that has made use of the mark. Accordingly, it did not matter there was no evidence of the proprietor exercising active quality control over the goods marketed by BMH as parts for MORRIS vehicles. In support of this submission, Mr Selmi referred me to the decision of Mr Geoffrey Hobbs Q.C. as the Appointed Person in *Einstein Trade Mark*¹⁶ in which Mr Hobbs held that:

“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”

¹⁶ [2007] RPC 23 at [24]

and can do so without showing that he has exercised control over the quality of the goods in question.”

26. I accept Mr Selmi’s submission, which also appears consistent with the reasoning of the House of Lords in *Scandecor Development AB v Scandecor Marketing AB*.¹⁷ However, there are two caveats. Firstly, the lack of any requirement for quality control by the proprietor does not mean that a licensee who uses the licensed trade mark in contravention of the licence must be taken to have used the mark with the proprietor’s consent. In *Copad SA v Christian Dior*¹⁸ the CJEU considered whether the use of a trade mark contrary to the terms of a licence could be held to be use of the mark with the proprietor’s consent. The relevant part of the court’s judgment is set out below:

“2. Article 7(1) of Directive 89/104, as amended by the Agreement on the European Economic Area, is to be interpreted as meaning that a licensee who puts goods bearing a trade mark on the market in disregard of a provision in a licence agreement does so without the consent of the proprietor of the trade mark where it is established that the provision in question is included in those listed in Article 8(2) of that Directive.”

27. This means that using a licensed mark in breach of the terms of a licence can in some circumstances still constitute using the mark with the proprietor’s consent. However, if the use contravenes one or more of the provisions set out in article 8(2) of the Directive, the licensee’s use is without the proprietor’s consent. Article 8(2) covers breaches of a) the duration of the licence, b) the form of the mark, c) the scope of the licensed goods or services, d) the territory of the licence, and e) the quality of goods or services provided in the licence (if any).

28. The second caveat is that the question of whether use of a mark by a licensee counts as genuine use of the trade mark only arises if the use in question is trade mark use, i.e. the sign is used 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.”*

¹⁷ [2002] FSR 7 HL

¹⁸ CJEU, Case C-59/08

29. Mr Payne's evidence is that BMH has, since at least 2001, either directly or via its licensees, supplied parts and components for classic British cars, including various MORRIS models. The Parts Guide and price list from 2018 at exhibit 5 is put forward as confirmation of this claim. The front cover and contents page of the document bear the prominent words 'British Motor Heritage' alongside a distinctive logo belonging to BMH. Page 5 of the document lists BMH's 'Approved Specialists' who are said to be "leading suppliers of Classic MG, Mini, Morris, and Triumph parts." The contents page lists, inter alia, the brands for which BMH provides replacement parts. MORRIS is not one of them. However, MINI is listed and Mr Payne points out that although the original MINI carried a variety of trade marks, between 1959 and 1969 a significant proportion were badged as MORRIS MINI.¹⁹ Page 9 of exhibit 5 shows some of the MINI bodysHELLS made and sold by BMH. None appears to bear any trade marks and there is nothing on the page to indicate they are specifically for the MORRIS MINI. This is not surprising because Mr Payne explains that:

"Many vehicles were originally sold under different marques in varying proportions at the same time (e.g. Austin/Morris Minis and Austin/Morris/MG/Riley/Wolseley/Vanden Plas 1100/1300s). Many of the goods are suitable for fitment across a range of vehicles bearing one or other of the licensed Trade Marks."

30. Consistent with this, except for certain body parts for the MORRIS MINOR vehicle, no sales figures have been provided for parts sold by BMH under the MORRIS mark. As the bodysHELL for a MORRIS MINOR is specific to that vehicle, Mr Payne says he is able to provide annual sales figures for 2018 – 2022. According to these figures BMH sold about 450 replacement wings for MORRIS MINORs in 2018, and 300 replacement grill surrounds. Sales reduced to around 400 replacement wings by 2021.²⁰

31. The obvious problem with this part of Mr Payne's evidence is that it simply shows that BMH sell replacement bodysHELLS and body parts for MORRIS MINORs and MINIs, some of which may have been originally badged as MORRIS MINI. It does not

¹⁹ It appears from the models shown on page 9 that the original Mini was manufactured from 1959 to 2000.

²⁰ See exhibit 13

show use of MORRIS by BMH to identify the trade source of the replacement bodyshells/parts. The mere fact the parts can be used for vehicles originally marketed as MORRIS cars is therefore irrelevant.

32. This brings me to the next part of the proprietor's case, which is that:

"..all parts we sell are sold with a British Motor Heritage label bearing a range of the licensed Trade Marks including the Morris logo. A photograph of a part bearing a BMH label is attached as exhibit Morris 12."

33. The photograph in question looks like this:



34. The label shown in exhibit 12 is potentially important evidence because it could be trade mark use. This is how the label appeared in the 2018 Parts Guide and price list:

Heritage Original Equipment



This label identifies genuine original British Motor Heritage parts and assemblies; look for it to ensure that you are using the highest quality original components.

British Motor Heritage products are manufactured using the original tooling and to the same exacting standards and engineering integrity as the parts used on the original production lines.

I am satisfied that this constitutes licensed use of the trade marks shown on the right of the label to identify the trade source of the parts to which it is attached.

35. According to Mr Selmi, the badge on the left in the second row of trade marks on the label is the MORRIS logo. He submitted that this is plainly the same logo shown in the 'Brand Deck' document at exhibit 4, which looks like this:



36. Mr Selmi submitted that the label therefore shows use of MORRIS in a “*variant form*” used to guarantee the trade source of [some of] the parts bearing that label. Mr St. Ville disagreed for two reasons. Firstly, he submitted that the badge shown in exhibit 12 does not show use of the word MORRIS, just a squiggle where that word would be if the badge was the same as the one shown in the Brand Deck document. Secondly, the MORRIS logo would not constitute an acceptable variant of the word mark MORRIS under section 46(2) of the Act, even if it includes that word.

37. So far as the first point is concerned, Mr Payne’s evidence (see paragraph 32 above) is that all the BMH parts carry the label bearing the MORRIS logo. The applicant did not put Mr Payne on notice that the truth of his evidence would be challenged, or file any evidence of its own, or ask to cross examine Mr Payne, prior to the hearing. Consequently, it was not open to the applicant to ask me at the hearing to disbelieve Mr Payne’s specific evidence about the inclusion of the MORRIS logo in the label attached to the parts sold by BMH.²¹ I therefore accept his evidence that the label shown at exhibit 12, including what he calls the “*MORRIS logo*”, is attached to all the parts sold by BMH.

²¹ *Extreme Trade Mark* [2008] RPC 2

38. However, as the Appointed Person pointed out in *Extreme Trade Mark*, this does not mean that Mr Payne's evidence must be accepted uncritically. Although the truth of his statement is accepted, the appropriate weight to be afforded to his evidence must be assessed from the specificness, sufficiency, consistency, and all other aspects that together determine its probative value. Unfortunately, Mr Payne does not define what he means by 'the MORRIS logo' (other than by referring to the picture in exhibit 12). Contrary to Mr Selmi's submission, it is not 'plain' from simply looking at the photograph in exhibit 12 that the MORRIS logo shown there is the same as the logo shown in the Brand Deck document, i.e. that it includes the word MORRIS.

39. It is difficult to understand how a party trying to show use of MORRIS as a trade mark can end up relying on a photograph of a label so small that all one can see is a squiggle where the word MORRIS is supposed to be. This leaves me in the position of having to make the best I can of the evidence available. In doing so, I keep in mind that it is necessary to consider the evidence as a whole. Therefore, a deficiency in one aspect of the evidence can be compensated for by other aspects of the evidence, provided that when taken together the evidence establishes the relevant fact to the standard required by the law. In civil proceedings this is the balance of probability.

40. I note that a label very similar to one shown in exhibit 12 is shown on page 6 of the 2018 Parts Guide and price list at exhibit 5. Unfortunately, the picture of the label is again very small and it is no easier to make out if the word MORRIS is present at the base of the MORRIS logo shown there. I observe that neither representation clearly includes the solid banner on which the word MORRIS appears in the version of the logo shown in the Brand Deck document.

41. Looking through the rest of the evidence, I note that the final page of the 2018 Parts Guide and price list includes an acknowledgement that "*trademarks used in this publication are covered by appropriate licensing agreements or other agreements with their respective owners.*" The trade marks in question, including the MORRIS logo, are shown below that statement. The MORRIS logo shown on that page looks like the one shown at paragraph 35 above, i.e. with the word MORRIS on a banner at the base of the logo. Exhibit 11 consists of an undated catalogue issued by Newton Commercial entitled MORRIS MINOR TRIM. According to the introduction page, Newton

Commercial is approved by BMH as a trim manufacturer. I note that the Morris logo (again including the word MORRIS) appears on that page and also on page 23.

42. On the other hand, exhibit 8 consists of a Parts Catalogue from the David Manners Group which operates a Morris Minor Centre in Birmingham. Mr Payne says this is one of its 'Approved Specialists'. It appears to provide a comprehensive range of parts for Morris Minors and a range of other classic cars. I note that the front cover of the catalogue contains a version of the MORRIS logo that looks like this:



43. This suggests there are different versions of the MORRIS logo, not all of which include the word MORRIS. Therefore, given that I cannot see the word MORRIS in the picture of the label Mr Payne says is attached to the parts BMH sells, I am unable to accept that the word MORRIS appeared on that label during the relevant period.

44. This brings me to Mr St. Ville's second point, that the use of MORRIS in the MORRIS logo shown at paragraph 35 above does not count as an acceptable variant of the word mark MORRIS. In *Colloseum Holdings AG v Levi Strauss & Co.*²² the CJEU held that:

“30. In light of the scheme and purpose of Regulation No 40/94 and the wording of Article 15(1) of that regulation, the conclusion reached by the Court in paragraph 30 of the judgment in Nestlé must also be applied in respect of ‘genuine use’ for the purpose of preserving the rights of the proprietor of a registered trade mark, within the meaning of that provision.

²² Case C-12/12

31. -

32. as is apparent from paragraphs 27 to 30 of the judgment in Nestlé, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. -

34. -

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1).²³ (emphasis added)

45. This means that use of a registered mark as part of a composite mark constitutes use of the former, provided that when used in the composite mark the registered mark continues to identify the trade source of the goods or services. If used in the MORRIS logo, the word MORRIS would plainly continue to identify the trade source of goods, just as it would if used alone. Therefore, use of MORRIS in the logo shown at paragraph 35 above counts as use of MORRIS for the purpose of section 46(1) of the Act. For the reason I have already explained, this does not assist the proprietor so far as the use of the 'MORRIS logo' on labels is concerned, but it potentially qualifies the use of MORRIS in the MORRIS logo shown on the final page of BMH's 2018 Parts Guide and price list.

46. This use appears to be within the relevant period. However, although the logo is acknowledged to be a licensed trade mark, the entry on the acknowledgments page is in fact the only use of a MORRIS logo in the document. The only use of the word MORRIS on page 3 of that document simply describes the intended purpose of some of the parts supplied by BMH's 'Approved Specialists'. In these circumstances, I do

²³ Now Article 16(1) of Directive 2015/2436

not accept that the use of MORRIS in the MORRIS logo on the acknowledgments page of the document shows use of MORRIS by BMH 'in relation to' the parts provided by it, or by its 'Approved Specialists'.

47. Exhibit 7 to Mr Payne's statement consists of pages downloaded from BMH's website in April 2022 (i.e. after the end of the relevant period) showing the businesses acting as BMH's 'Approved Specialists' at that time. It is more helpful to look at the list included in the 2018 Parts Guide and price list at exhibit 5 because that is dated within the relevant period. It also identifies which of the businesses provide parts for MORRIS and MINI (including MORRIS MINI) cars. Ten such businesses are listed in the UK. I have already mentioned two of them. Mr Payne exhibits pages from the catalogues/parts lists provided by four of them (including the two I have already identified).²⁴

48. Mr Payne says that exhibit 8 comprises of the Parts Catalogue of Abingdon MG. As I noted earlier, this is headed as the catalogue of David Manners Group, which operates a Morris Minor Centre in Birmingham. This business appears to provide a comprehensive range of parts for Morris Minors and other classic cars. The parts provided are described as "*genuine, OE & Aftermarket parts*" (emphasis added), suggesting that not all of them are sourced from BMH. In fact there is no specific claim in the catalogue that any of the parts are supplied by BMH. Further, there is no use of MORRIS as a trade mark for any of the parts. Rather, the words MORRIS MINOR are used to designate the intended purpose of the replacement parts, i.e. they are parts for MORRIS MINORS.²⁵

49. Exhibit 10 consists of a document issued by Moss Europe. The catalogue includes an acknowledgement that Moss Europe is a BMH Approved Specialist. According to the terms of the acknowledgement, this allows Moss Europe the use of "*Marque logos and some of the artwork in the catalogue.*" It is not clear what this refers to. The document is entitled "*Parts and Accessories for your MORRIS MINOR.*" The words MORRIS MINOR are even more clearly used here simply to designate the intended purpose of the replacement parts. I note some of the parts shown in the catalogue

²⁴ See exhibits 8 -11

²⁵ This means that it is the sort of use that anyone could make of the mark per section 11(2)(c) of the Act

bear third-party brands, indicating that BMH was not the source of those parts. This document does not show use of MORRIS MINOR to guarantee the trade source of any of the parts. There is no other use of MORRIS or MORRIS MINOR as a trade mark.

50. As mentioned above, exhibit 11 consists of an undated catalogue produced by Newton Commercial entitled 'MORRIS MINOR TRIM'. The Morris logo (including the word MORRIS) appears on the 'introduction' page and on page 23. It is not clear whether this document was made available to the public during the relevant period. I note that the old Switch logo appears as one of the credit and debit cards shown as accepted. It has been many years since I last saw that debit card mark in use. The rest of the document consists of pictures and descriptions of numerous pieces of trim for various versions of the MORRIS MINOR. Again, the use of MORRIS MINOR describes the make and model of the car the trim is for. The words are not used to indicate the trade source of the replacement trim, i.e. as a trade mark for those goods.

51. Exhibit 9 consists of two pages downloaded from the website morrisminorspares.com in April 2022 (i.e. after the end of the relevant period). It is headed ESM MORRIS MINORS and appears to consist of an index to a catalogue of "unique" parts for "Van and Pick-up"²⁶ sold by that business. There is no use of MORRIS as a trade mark in the pages in evidence, except possibly as part of the business's trading name.

52. In this connection, I note that clause 2 of the 2001 licence in favour of BMH states that:

"2.1 BMH shall not use nor authorise any third party to use the Trade Marks as part of any corporate name under any circumstances. BMH shall not authorise any third party to use the Trade Marks as part of any trading name without the prior written consent of MGR. In the event that MGR gives its consent to such use, BMH shall procure that such party shall, if requested by MGR sign a Use of Name agreement in a form satisfactory to MGR.

²⁶ It appears from page 2 of exhibit 11 that although MORRIS and MORRIS MINOR are registered for 'motor cars' there may also have been a MORRIS MINOR van and pick-up.

2.2 BMH shall not grant a sub-licence to use the Trade Marks to any third party without the prior consent of MGR, such consent not to be unreasonably withheld or delayed, and then only on terms no less onerous than the terms and conditions set out in this Agreement. MGR shall provide BMH with the name of a person authorised to give the required consent. The parties shall agree on a procedure for providing such consent.”

53. Mr St. Ville pointed out that there was no evidence that MGR or the current proprietor had consented to BMH granting sub-licences to any of the parties relied on by Mr Payne, or given the required written consent for BMH to authorise ESM MORRIS MINORS to use MORRIS as part of its trading name.

54. Mr Selmi invited me to find that as the evidence showed these third parties were using MORRIS, the necessary authorisations must have been given. That argument is, of course, self-serving and entirely circular. So far as the sub-licensing point is concerned, I note that clause 2.2 of the licence says that “*consent* [for sub-licences is] *not to be unreasonably withheld.*” This suggests there was a presumption in favour of such arrangements. Therefore, if it had been material, I would have been prepared to accept that the sub-licensing claimed by Mr Payne was authorised by the proprietor. In any event, so far as the sale of parts obtained from BMH was concerned, all the ‘Approved Specialists’ would have been doing was acting as suppliers or retailers, which would not normally require a sub-licence.

55. The position is different when it comes to the required prior authorisation for BMH to permit any third party to use MORRIS as part of a trading name. The presumption in clause 2.1 is against such use. Therefore, in the absence of evidence that consent was given, I am not prepared to infer that it was. Consequently, I do not accept that use of ESM MORRIS MINORS is covered by the licence. Therefore, to the extent that this use is claimed to be use of MORRIS and/or MORRIS MINOR in relation to parts for vehicles, I find it is use of the marks in a form that is contrary to the licence. Consequently, any such use of the marks was not with the proprietor’s consent and, therefore, would not count even if the parts catalogue referred to on the webpages in evidence was available during the relevant period.

56. Thus far I have looked at the evidence which has been filed. However, as Mr Alexander made clear in *Awareness v Plymouth City Council*, it is necessary to evaluate this evidence against the background of the material that should have been available to the proprietor, but which has not been provided. This includes:

- (1) Clear (and legible) examples of MORRIS being used to guarantee the trade source of car parts;
- (2) Evidence from BMH's Approved Specialists as to how they used MORRIS under licence as a trade mark for parts for cars during the relevant period (if they did);
- (3) Invoices showing sales of MORRIS parts;

57. As it is, I find the evidence insufficiently solid to establish genuine use of MORRIS as a trade mark, within the relevant period, with the proprietor's consent, in relation to cars or parts for cars in classes 6, 7, 9, 11, 12 & 17. Therefore, the registrations of MORRIS under UK439845, UK477782 & UK477783 will be revoked for non-use with effect from 24th February 2022.

The MORRIS MINOR mark in class 12

58. I next turn to the registration of MORRIS MINOR under UK2006310 in relation to cars, parts, fittings, and accessories therefor. The proprietor relies on:

- (1) Use of MORRIS as an acceptable variant of MORRIS MINOR;
- (2) The sale by BMH of replacement bodysells for MORRIS MINORs;
- (3) Use of MORRIS MINOR by 'Authorised Specialists' David Manner Group, Moss Europe, and Newton Commercial.

59. As I have not found any genuine use of MORRIS in relation to the goods at issue it follows that point (1) would not assist the proprietor, even if use of MORRIS counts as an acceptable variant of MORRIS MINOR (which I doubt, because MINOR is not descriptive and contributes to the distinctive character of MORRIS MINOR).

60. I reject the evidence provided to support points (2) and (3) for the same reasons I rejected it in relation to use of MORRIS. Therefore, the registration of MORRIS MINOR under UK2006310 will be revoked for non-use with effect from 24th February 2022.

The MORRIS GARAGES mark in classes 12 & 37

61. Lasty, I turn to the protection of MORRIS GARAGES under IR1174169 in relation to vehicles, parts, fittings, and accessories therefor in class 12, and associated services in class 37.

62. There is no evidence of use of MORRIS GARAGES as such during the relevant period.

63. Mr Selmi again relied on use of MORRIS by BMH and its 'Authorised Specialists' as an acceptable variant of MORRIS GARAGES. This was on the basis that GARAGES is descriptive of the registered goods/services. However, as the evidence does not show genuine use of MORRIS in relation to goods in class 12, reliance on that mark cannot assist the proprietor. I note for the record that none of the licences relied on by the proprietor cover services in class 37.

64. Therefore, the protection of MORRIS GARAGES in the UK under IR1174169 will be cancelled for non-use with effect from 24th February 2022.

Overall outcome

65. The registration/protection of all eight of the marks will be cancelled on grounds of non-use with effect from 24th February 2022.

Costs

66. The application has succeeded and the applicant is therefore entitled to a contribution towards its costs. Mr St. Ville asked for additional on-scale costs to cover the extra work the applicant undertook analysing the evidence the proprietor originally filed in May 2022 with the counterstatements. The evidence was attached to 88 emails. This evidence was not admitted because it was not in an appropriate form. The proprietor subsequently filed Mr Payne's statement and 13 exhibits as its evidence in

the eight consolidated revocation actions. On 30th November 2022, the registrar's caseworker invited the applicant to file evidence and/or written submissions in response to the proprietor's evidence. The applicant did neither, opting instead to request a hearing in order to make oral submissions.

67. Strictly speaking, there was no need for the applicant to do any work on the evidence filed by the proprietor with the counterstatements until it was admitted. However, as the proprietor's representatives copied the original material to the applicant (as it is required to do when filing evidence), it is understandable that the applicant considered it.

68. Mr Selmi resisted any additional costs on the grounds that the applicant could not have spent much time on the evidence because it did not file any evidence or written submissions in response. I take the point, but the applicant still had to look through the material in order to decide how or whether to respond to it. Mr St. Ville told me that the applicant had actually spent around £22k on the proceedings. I will therefore include an additional sum to contribute to the applicant's extra costs from considering the proprietor's evidence in both its original and amended form. However, as the material was largely duplicative, this will be a modest sum.

69. I assess costs as follows based on the scale set out in Tribunal Practice Notice 2/2016:²⁷

£1600 for the official fees for filing 8 forms TM26(N);

£1000 for the work involved in preparing and filing the forms (which were simple and largely duplicative);

£400 for considering the evidence originally filed by the proprietor;

£1000 for considering the replacement evidence;

£1100 for attending the hearing and preparing a skeleton argument.

²⁷ This, not the current scale, applies to proceedings started prior to February 2023

70. I therefore order SAIC Motor Corporation Limited to pay Morris Commercial Limited the sum of £5100. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the final conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 27th day of June 2023

Allan James
For the Registrar