

1 UK INTELLECTUAL PROPERTY OFFICE

21 Bloomsbury Street
London, WC1B 3SS

3 Thursday, 23rd September 2010

4 B e f o r e :

5 MR. GEOFFREY HOBBS QC
6 (Sitting as the Appointed Person)

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8 In the Matter of the TRADE MARKS ACT 1994

9 - and -

10 In the Matter of Trade Mark No. 2488299 for the mark MELIS in
the name of Gima (UK) Limited

11 - and -

12 In the Matter of an Application for the Revocation thereto
under No. 83317 by Euro Gida Sanayi Ve Ticaret Limited

13 - and -

14 An appeal to the Appointed Person from the decision of
15 Mrs. A Corbett acting on behalf of the Registrar,
dated 11th May 2010.

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17 (Computer-aided Transcript of the Stenograph Notes by
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21 MR. GEOFFREY PRITCHARD (instructed by Messrs. Bowling & Co.)
22 appeared for the Appellant.

23 The Respondent did not attend and was not represented.

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25 DECISION
(As approved by The Appointed Person)

1 THE APPOINTED PERSON: The trade mark MELIS was registered under
2 number 2252920 in the name of Gima (UK) Limited for use in
3 relation to the following goods:

4 Class 29: Meat, fish, poultry and game, preserved,
5 pickled, dried and cooked fruits, vegetables, jellies, jams,
6 fruit sauces, eggs, milk and milk products, cheese, edible
7 oils and fats, salami and sausages, soup powder.

8 Class 30: Rice, bulgur, sago, tapioca, artificial
9 coffee, tea, cocoa, flour and preparations made from cereals,
10 bread, pastry and confectionery, ices, honey, treacle, yeast,
11 baking powder, salt, mustard, vinegar, sauces, spices and
12 rice, and pasta.

13 Class 31: Agricultural, horticultural and forestry
14 products and grains, fresh fruit and vegetables, seeds,
15 natural flowers and nuts.

16 Class 32: Mineral and aerated waters and other
17 non-alcoholic drinks, fruit drinks and fruit juices, syrups
18 and other preparations for making beverages.

19 It was registered on 11th May 2001 with effect from 15th
20 November 2000.

21 On 11th August 2008 Euro Gida Sanayi Ve Ticaret Limited
22 Sirketi applied for revocation of the registration on the
23 ground of non-use under sections 46(1)(a) and 46(1)(b) of the
24 Trade Marks Act 1994.

25 The registered proprietor filed evidence of use in the

1 form of a witness statement of its general manager Mr. Ismail
2 Gun. It was in due course decided by the Registrar's Hearing
3 Officer, Mrs. Ann Corbett, that the evidence was insufficient
4 to enable the registered proprietor to retain the protection
5 conferred by registration for all of the goods in respect of
6 which its trade mark was registered.

7 In her written decision issued under reference
8 BL O-144-10 on 11th May 2010 she concluded as follows:

9 "13: Gima's evidence, as detailed above, is not
10 extensive. Except to the extent that some of the photographs
11 of products show sell-by dates printed on some of the packets
12 (all of which post date the relevant periods) none of the
13 exhibits are dated though some of the photographs are said to
14 have been taken in September 2008 and are therefore from
15 outside the relevant periods. Gima has provided some details
16 of its turnover and advertising spend but none of the figures
17 given relate to the period relevant to my consideration under
18 section 46(1)(a). And whilst the figures given cover a period
19 which encompasses the latter three months of the period
20 relevant to my consideration under section 46(1)(b), I am not
21 able to break them down in such a way that would allow me to
22 determine how much, if any, sales were made during this period
23 nor the goods to which they relate.

24 "14: Despite these shortcomings, Gima gives evidence,
25 through Mr. Gun, of use of the mark on sausages and salamis

1 since 2000 and on white cheese since 2005 and claims that this
2 trade is ongoing. Furthermore, Euro confirms in its written
3 submissions that the use of the mark on beef sausage, chicken
4 sausage, beef salami, chicken salami and white cheese 'is not
5 contended by the Applicant'. So, notwithstanding that I do
6 not know the exact scale of the use, it is clear that there
7 has been use which has created and preserved a market share
8 and I find that there has been genuine use in relation to
9 these goods at the dates claimed.

10 "17: Gima's mark is registered for goods in classes 29,
11 30, 31 and 32 as set out in paragraph 1 above. The
12 registration in class 29 includes cheese, salami and sausages.
13 Whilst the evidence shows that Gima has used the mark in
14 relation to beef sausages, beef salamis, chicken sausages,
15 chicken salamis and white or 'combi' cheese, I do not propose
16 such a pernickety specification. In my view, cheese, salami
17 and sausages is how the consumer would perceive the goods and
18 is a perfectly reasonable specification for the use shown.

19 "18: The application for revocation is partially
20 successful. Gima's registration is hereby revoked under the
21 provisions of section 46(6)(b) of the Act with effect from 12
22 May 2006 for all goods other than:

23 "Class 29: Cheese, salami and sausages."

24 Her order for part-cancellation was made in the exercise
25 of the powers conferred by sections 46(5) and 46(b) of the

1 Trade Marks Act 1994. Section 46(5) states: "Where grounds
2 for revocation exist in respect of only some of the goods or
3 services for which the trade mark is registered, revocation
4 shall relate to those goods or services only."

5 Section 46(6) states: "Where the registration of a
6 trade mark is revoked to any extent, the rights of the
7 proprietor shall be deemed to have ceased to that extent as
8 from-

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

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

12 It is clear that the power provided by section 46(5)
13 must be exercised so as to give effect to Article 13 of the
14 Trade Marks Directive. The heading of Article 13 reads as
15 follows: "Grounds for refusal or revocation or invalidity
16 relating to only some of the goods or services."

17 Article 13 states: "Where grounds for refusal of
18 registration or for revocation or invalidity of a trade mark
19 exist in respect of only some of the goods or services for
20 which that trade mark has been applied for or registered,
21 refusal of registration or revocation or invalidity shall
22 cover those goods or services only."

23 This requires the list of goods or services covered by a
24 trade mark application or registration to be reduced to the
25 extent necessary to confine it to goods or services of the

1 kind for which the trade mark in question is fully
2 registrable.

3 The policy of the legislation with regard to the
4 importance of use is expressed in the ninth recital in the
5 preamble to the Directive in the following terms: "... in
6 order to reduce the total number of trade marks registered and
7 protected in the Community and, consequently, the number of
8 conflicts which arise between them, it is essential to require
9 that registered trade marks must actually be used or, if not
10 used, be subject to revocation".

11 Article 11 of the Directive points to the need for a
12 firm approach towards the excision of goods and services from
13 the scope of a registration which covers them in the absence
14 of commensurate use.

15 The registered proprietor appealed to an Appointed
16 Person under section 76 of the Act contending, in substance,
17 that the Hearing Officer's findings of fact, which were not
18 challenged, were sufficient to establish that its trade mark
19 should remain registered for all goods specified in the
20 existing registration, with the exception of "agricultural,
21 horticultural and forestry products and grains" in class 31.
22 This contention was developed in argument at the hearing
23 before me.

24 I was invited to accept that use in relation to goods or
25 services of the species X was sufficient to enable a trade

1 mark proprietor to maintain a registration for goods or
2 services broadly described in terms of the genus to which
3 species X belonged, with the test for identification of the
4 genus being one of consumer perception based on conceptions of
5 nearness and relatedness.

6 The argument in support of the appeal is encapsulated in
7 the following paragraphs of counsel's written outline of
8 argument for the hearing:

9 "14. In this case we say that the average consumer is
10 the ordinary person shopping in a supermarket, off-licence or
11 cash and carry. They will, we say, treat the use of these
12 particular foodstuffs in exactly the same way as they would
13 treat other food stuffs in a supermarket etc. They will
14 therefore take into account (a) the nature of the foodstuffs,
15 (b) the location of the foodstuffs and (c) the distinctiveness
16 of the mark used in relation to the foodstuffs.

17 "15. Take the sausages and salamis first. In a large
18 supermarket these will be encountered in either a meat
19 counter/refrigerator. They will not be segregated from other
20 meat or game products. Likewise the consumer would be liable
21 to store and use the products in the same way that he/she
22 stores or uses other meat products. For example, we say it is
23 self-evidently correct that that one can assume confusion (for
24 the purpose of 10(1)), if the trade mark 'Melis' were used on
25 say a beef kebab or a chicken wing. Likewise, we say it is

1 artificial to try and draw a distinction between (a) salami
2 and sausages and (b) fish, poultry and game. For that reason
3 we say that (on the basis of the use of salami and sausages
4 found by the hearing officer) the class 29 registration should
5 apply at the very least to the following:

6 "Class 29: Meat, fish, poultry and game, salami and
7 sausages.

8 "16. Turning to the combi and white cheeses. In a
9 supermarket these will be encountered in, or in near proximity
10 to milk, milk products and eggs. Likewise the consumer would
11 be liable to store such and use products in a similar way to
12 the way he/she treats other dairy products. For this reason
13 we say that class 29 registration should apply to at the very
14 least the following:

15 "Class 29: Milk, milk products and eggs."

16 "17. A further point is, of course, that the average
17 consumer can also be assumed to see Melis in at least two
18 different places -- the meat counter and the dairy products
19 aisle. We submit that the fact that the mark has been used
20 for two dissimilar food products is significant: it widens
21 the 'umbra' of the mark considerably. The significance of
22 this is made clear from the ANIMAL decision. There use was
23 proved in relation to a series of particular types of clothing
24 (T-shirts, jeans, vests, hoodies, shorts etc) aimed at a
25 particular market (surf image). Self-evidently this use does

1 not cover all possible types of clothing, however, the effect
2 of the use was sufficient to support a registration to
3 'clothing' (see ANIMAL para 23). We say the same is true
4 here. The effect of use for meat products and for dairy
5 products is, in effect, use exemplified in relation to
6 foodstuffs bought from a supermarket etc. Put simply, the
7 consumer, having seen the trade mark used on two dissimilar
8 food products in his/her shopping basket can be fairly taken
9 to assume that this exemplifies use in relation to a wide
10 range of foodstuffs and related products. It is perfectly
11 fair in these circumstances to assume there will be a
12 likelihood of confusion.

13 "18. This point is reinforced when the position in
14 smaller outlets, such as a cash and carry, is considered.
15 Here, of course, the goods will, to a much greater extent, be
16 placed cheek by jowl. We say that in such circumstances, it
17 is unrealistic to hold that the average consumer would believe
18 that the trade mark use of Melis was limited to a small
19 category of foodstuffs as opposed to the whole range of
20 foodstuffs set out in classes 29-32."

21 As indicated in those paragraphs, there was a fallback
22 position in the registered proprietor's case to the effect
23 that registration should, on any view, be maintained for meat,
24 fish, poultry and game, salami and sausages, milk, milk
25 products and eggs in class 29.

1 I do not accept that the approach for which the
2 registered proprietor contends represents the right way of
3 determining the degree of particularity with which an order
4 reducing the scope of the specification of goods or services
5 under section 46(5) of the Act should identify and define the
6 goods for which the trade mark is to remain registered.

7 The task is to reduce the coverage of the registration
8 so as to prevent the proprietor from claiming absolute
9 protection for the trade mark under sections 5(1) and 10(1) of
10 the Act in relation to goods or services of the kind for which
11 there has, without proper reason, been no genuine use within
12 the relevant period.

13 It is fair to say that the existing case law leaves some
14 room for argument as to how tightly worded the resulting
15 specification of goods or services should be (see paragraphs
16 13 to 19 of the decision of Professor Annand sitting as the
17 Appointed Person in Fox International Group Ltd v Penn Fishing
18 Tackle Manufacturing Co. BL O-217-10, 30th June 2010).

19 However, that does not appear to me to alter the basic
20 nature of the required approach. As to that, I adhere to the
21 view that I have expressed in a number of previous decisions.
22 In the present state of the law, fair protection is to be
23 achieved by identifying and defining not the particular
24 examples of goods or services for which there has been genuine
25 use but the particular categories of goods or services they

1 should realistically be taken to exemplify. For that purpose
2 the terminology of the resulting specification should accord
3 with the perceptions of the average consumer of the goods or
4 services concerned.

5 On reviewing the decision below from that perspective, I
6 am satisfied that the Hearing Officer applied the law to the
7 facts in the present case within the latitude allowed by the
8 value judgment that she was required to make.

9 More specifically, I consider that what the registered
10 proprietor is seeking to do on this appeal is to enlarge the
11 concept of fair protection so as to relate it far too closely
12 to the test for assessing whether goods or services are
13 "similar" to those specified in the registration of a
14 protected mark under sections 5(2) and 10(2) of the Act.

15 The latter test generally calls for the overall pattern
16 of trade to be considered in terms of the factors identified
17 by Jacob J in the British Sugar case: uses, users and
18 physical nature of the relevant goods and services; channels
19 of distribution, positioning in retail outlets, competitive
20 leanings and market segmentation.

21 However, that approach is adopted for the substantially
22 different purpose of deciding how far the protection conferred
23 by registration may extend beyond the situation of double
24 identity, that is to say identity of marks and identity of
25 goods or services, covered by sections 5(1) and 10(1) of the

1 1994 Act.

2 The scheme of the legislation is such that the test for
3 assessing similarity of goods and services should not be
4 collapsed back into the prior question of what the basic
5 specification of the registration should be in the context of
6 a successful application for part cancellation on the ground
7 of non-use.

8 The test for assessing whether there is similarity
9 sufficient to give rise to the existence of a likelihood of
10 confusion does not, in my view, provide the test for
11 determining what the basic specification should itself be.

12 The focus of attention under section 46(5) must be the
13 umbra -- not the penumbra -- of protection which the
14 registered proprietor can legitimately claim on the basis of
15 the genuine use he has made of his mark.

16 For the reasons I have sought to explain I think that
17 the reasoning of the argument advanced on behalf of the
18 registered proprietor seeks to prove too much.

19 My conclusion is that the appeal should be dismissed.

20 I have no reason to believe that the applicant for
21 revocation has incurred any or any appreciable costs or
22 expenses in connection with the appeal. The appeal will
23 therefore be dismissed with no order for costs.

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