

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 1417500  
IN THE NAME OF VALE MILL (ROCHDALE) LIMITED  
FOR THE MARK:**

**MASTER CHEF**

**AND**

**AN APPLICATION FOR REVOCATION THEREOF (NO. 500452)  
BY SHINE LIMITED**

## THE BACKGROUND AND THE PLEADINGS

1) Vale Mill (Rochdale) Limited (“the Registered Proprietor”) is the proprietor of UK trade mark registration 1417500 for the trade mark shown below:

### MASTER CHEF

It completed its registration procedure on 14 February 1992. It is registered in respect of:

**Class 21:** *Oven gloves, oven mitts, oven gauntlets, oven-heat resistant pads, place mats; all included in Class 21.*

2) In its application Shine Limited (“the Applicant”) seeks revocation of the registration in respect of all of the goods for which it is registered. It bases this application on non-use under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). The relevant time periods when the Applicant claims non-use are:

- i) Under section 46(1)(a): 15 February 1992 to 14 February 1997.
- ii) Under section 46(1)(b): 15 February 1997 to 14 February 2002; 15 February 2002 to 14 February 2007; 15 February 2007 to 14 February 2012; and 11 June 2009 to 10 June 2014.

Revocation is sought under section 46(1)(a) with effect from 15 February 1997 or under section 46(1)(b) with effect from 15 February 2002, 15 February 2007, 15 February 2012 or 11 June 2014 respectively, depending on the outcome of its claims.

3) The Registered Proprietor filed a counterstatement, denying that the mark has not been put to genuine use in respect of all the registered goods during at least the five-year period 11 June 2009 to 10 June 2014. The Registered Proprietor filed evidence relating only to the period 11 June 2009 to 10 June 2014 (“the relevant period”), together with submissions. The Applicant did not file evidence. Neither side requested a hearing, but both sides filed submissions in lieu of attendance at a hearing. I therefore give this decision after a careful review of the papers before me.

## THE REGISTERED PROPRIETOR’S EVIDENCE

5) In a witness statement dated 28 October 2014 Mr Allan Donnelly states that he is the Registered Proprietor’s Financial Director, and that he has been employed by the Registered Proprietor since 1996. He attaches twelve exhibits to his witness statement; they are listed below. Mr Donnelly’s descriptions of, and comments on, these Exhibits, as given in his witness statement, are shown below in inverted commas and italics. References to “VM” are to the Registered Proprietor.

6) **Exhibit AD1** is described by Mr Donnelly as “... *a photograph of an oven glove in plastic packaging bearing the sign MASTER CHEF sold by VM*”. The exhibit is undated, and bears the following image:



Beneath an elaborate representation of a steaming cooking pot and ladle surrounded by ingredients there appears the word BESCO, and below it, between two curling flourishes, the words Master Chef in capital case in an italic-style type.

7) **Exhibit AD2** is described by Mr Donnelly as “... an extract from VM’s UK sales figures in relation to the oven glove shown in Exhibit AD1 during the period 8 December 2010 to 12 March 2012”. This covers part of the relevant period. Mr Donnelly adds: “A total of 2975 of this type of oven glove were sold to UK retailers during this period”. This exhibit consists of a list of 28 invoices, appearing in each of the months of the period covered except November and December 2011. Eight customers are shown. Quantities invoiced vary from 25 to 600. In each case only one product is shown as invoiced: BESCO MASTER CHEF DBL OVEN GLOVE.

8) **Exhibit AD3** is described by Mr Donnelly as “... images of a double oven glove with a Master Chef label and MASTERCHEF branded packaging”. The exhibit is undated, and bears the following image:



The image shows what appears to be an oven glove folded to bear a label. In the top left, relatively small, is the word MINKY shown against a dark background. Much larger, across the top centre of the label, and followed by a small <sup>TM</sup> symbol, is the word MASTERCHEF above the description “Premium Double Oven Glove” and a picture of a steaming pot being stirred. Sewn into the seam of the product on the left is a textile label bearing the words “Master Chef” in capital case.

9) **Exhibit AD4** is described by Mr Donnelly as “... images of an oven glove with a Master Chef label and MASTERCHEF branded packaging”. The exhibit is undated. The product shown is longer than that in Exhibit AD4, but it bears the same “Master Chef” textile label. The packaging label is as described above for Exhibit AD4, except that the product description is “Premium Oven Glove”.

10) **Exhibit AD5** is described by Mr Donnelly as “... VM literature featuring three types of MASTERCHEF branded oven gloves, sold by VM”. No evidence is provided as to whether, where, how, to whom and, when this material was ever communicated. It is undated.

11) **Exhibit AD6** is described by Mr Donnelly as “... artwork for a label intended to be attached by a kimble tag to the label of MASTER CHEF branded oven gloves sold by VM”. The label prominently bears the word MASTERCHEF as described for

Exhibit AD3 above. No evidence is provided to show when or whether labels based on this artwork were ever attached to oven gloves sold by the Registered Proprietor during the relevant period.

12) **Exhibit AD7** is described by Mr Donnelly as “... artwork for packaging for a Premium Double Oven Glove and Premium Oven Glove bearing the sign *MASTERCHEF*, sold by VM”. The packaging prominently bears the word *MASTERCHEF* as described for Exhibit AD3 above. No evidence is provided to show when or whether packaging based on this artwork was ever attached to oven gloves sold by the Registered Proprietor during the relevant period.

13) **Exhibit AD8** is described by Mr Donnelly as “... extracts from VM’s UK sales figures in relation to its plain whipped, bound blue and black/grey double and single oven gloves all bearing the sign *MASTER CHEF* as shown in Exhibits AD3 to AD7 during the period 15 June 2009 to 7 August 2014”. He adds: “A total of 8,807 of these types of oven gloves were sold to UK retailers during this period”. This exhibit consists of a 6-page list of 242 invoices. The invoice dates range more or less evenly over the entire period (relatively fewer (19) are shown for 2011); a range of customer names is shown; invoice quantities range up to 500, though in most cases they range between 10 and 50; all relate to one or other of the following product descriptions: M/CHEF D O GLV 86CM WHIPPED; M/CHEF D O GLV 86CM BOUND BLUE; M/CHEF SINGLE OVEN GLOVE BLACK/GREY STR; M/CHEF DOUBLE OVEN GLOVE BLACK/GREY STR.

14) **Exhibit AD9** is described by Mr Donnelly as “... two photographs of an apron/pot holder set. The packaging clearly states ‘MasterChef pot holder’. The pot holder itself comprises a label displaying the trade mark *MasterChef*”. The exhibit is undated, and bears the following image:



It shows a folded fabric product or products (in one photograph the fabric appears striped in a darker shade than in the other) and a “packaging” label (though how this label is attached to the product is not clear). In the top left of the label is the word MINKY shown against a dark background. To the left of a diagrammatic representation of the product the words “Premium Chefs Apron with Pot Holder” are prominently displayed, and below them the following lines of text:

Four layers provide grip, steam  
and spill protection, heat  
protection and comfort

Adjustable neck strap  
Thick cotton canvas  
2 large pockets  
MasterChef pot holder  
Split Front – easy movement

The “Master Chef” label referred to by Mr Donnelly as “comprised” by the pot holder itself is not visible.

15) **Exhibit AD10** is described by Mr Donnelly as “... extracts from VM’s UK sales figures in relation to the apron/pot holder set shown in Exhibit AD9 during the period 11 December 2012 to 27 May 2014”. This covers only part of the relevant period. Mr Donnelly adds: “A total of 458 sets were sold to UK retailers during this period”.

16) **Exhibit AD11** is described by Mr Donnelly as “... a summary of sales figures relating to the sale of goods listed in Exhibits AD2, AD8 and AD10 between June 2009 and August 2014”, though it is in fact headed: “Masterchef sales June 2009 to March 2014”. The data is as follows:

Masterchef sales June 2009 to March 2014

Product	Description	Qty
CC13503100	M/CHEF APRON+POTHOLDER BLACK/GREY STR	458
CC13592100	M/CHEF OR/GR STAPRON & POTHOLDER	7
CC13593100	M/CHEF BLK/GR ST APRON&POTHOLDER	3
GG06400100	M/CHEF D O GLV 86CM WHIPPED	6,120
GG06400150	M/CHEF D O GLV 86CM BOUND BLUE	2,200
GG06509101	BESCO MASTER CHEF DBL OVEN GLOVE	2,975
GG06703100	M/CHEF DOUBLE OVEN GLOVE BLACK/GREY STR	39
GG06803100	M/CHEF SINGLE OVEN GLOVE BLACK/GREY STR	448

17) **Exhibit AD12** is described by Mr Donnelly as “... a selection of invoices, details of which are listed in Exhibits AD2, AD8 and AD10”. It consists of 27 invoices in all, dating from 13 July 2009 to 18 August 2014 (over two months after the end of the relevant period), the last two invoices dating from after the close of the relevant period. The invoices are spread fairly evenly over the period, involve supplies to locations throughout the UK, and contain items showing the following product descriptions:

BESCO MASTER CHEF DBL OVEN GLOVE  
M/CHEF D O GLV 86 CM WHIPPED  
M/CHEF D O GLV 86 CM BOUND BLUE  
M/CHEF SINGLE OVEN GLOVE BLACK/GREY STR  
M/CHEF DOUBLE OVEN GLOVE BLACK/GREY STR  
M/CHEF APRON + POT HOLDER BLACK/GREY STR  
M/CHEF OR/GR ST APRON +POT HOLDER  
M/CHEF BLK/GR ST APRON + POT HOLDER.

## LEGISLATION AND CASE-LAW

18) The relevant parts of section 46 of the Act read:

“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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 is 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) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(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.”

19) Section 100 is also relevant; it reads:

“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.”

20) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in 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 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].



(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

21) On the subject of arriving at a fair specification for goods and services in respect of which genuine use has been found, Arnold J (as he now is) comprehensively examined the case law in this area in his decisions as the Appointed Person in *Nirvana Trade Mark BL O-262-06* and *Extreme Trade Mark BL O-161-07*. His conclusion in *Nirvana* was that:

“(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20]”.

22) The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 (“Aladin”)* held that:

“43. Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44. With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the

goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

23) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as 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."

## **THE FORM IN WHICH THE MARK HAS BEEN USED**

24) For the purpose of demonstrating use in the UK section 46(2) provides that use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. The mark was registered as MASTER CHEF. In the exhibits appended to Mr Donnelly's witness statement the marks appear in the following forms:

**1. As used in Exhibit AD1**



**2. As used in Exhibits AD3, AD4, AD5, AD6, AD7**

**MASTERCHEF™**

**3. As used in Exhibits AD3, AD4**



**4. As used in Exhibit AD9**



Normal and fair use of the opponent's mark would include use of the mark in normal scripts. In my view, the differences between the earlier mark as registered and the forms shown above amount to choice of typeface and do not alter the distinctive character of the mark, which consists in the combination of the words MASTER and CHEF. Nor do I think that the omission of the space between the two constituent words does so. In Exhibits AD3 and AD4 the mark is in any case shown both with and without the space. The two small curling flourishes on either side of the mark as used in Exhibit AD1 are negligible decoration. Any of the forms shown above is capable of showing genuine use of the mark.

**OVEN GLOVES**

25) As regards use in respect of oven gloves the Applicant submits that, because the product images provided by Vale Mill in Exhibits AD1 and AD3 to AD7 are undated and do not bear product codes, there is no way to tie them to the invoices so as to evidence sales of those products during the relevant period. However, in his witness statement Mr Donnelly explicitly states (at paragraph 5) that the sales figures in Exhibit AD2 are "*in relation to the oven glove shown in Exhibit AD1 during the period 8 December 2010 to 12 March 2012*", and (at paragraph 11) that the sales figures in Exhibit AD8 are "*in relation to its plain whipped, bound blue and black/grey double and single oven gloves all bearing the sign MASTER CHEF as shown in Exhibits AD3 to AD7 during the period 15 June 2009 to 7 August 2014*" [underlining added].

The product descriptions given in Exhibits AD3, AD8 and AD11, and in the invoices in Exhibit AD 12 are consistent with this.

26) The Applicant submits that there is inconsistency between Mr Donnelly's statements (in paragraphs 5 and 11), claiming total sales of 11,782 for oven gloves, and the fact that the invoices show sales of only 3,981 units (an additional 106 units having been sold outside the relevant period). However, Mr Donnelly explicitly

states (at paragraph 15) that Exhibit 12 is “a selection of invoices” [underlining added].

27) Having regard to the totality of the evidence, I accept that, during the period 8 December 2010 to 12 March 2012 (which falls within the relevant period), a total of 2,975 oven gloves as shown in Exhibit AD1 were sold under the Registered Proprietor’s mark. It is regrettable that Mr Donnelly’s witness statement does not state clearly exactly what labels and packaging appearing in Exhibits AD3 to AD7 were used at exactly what times in relation to the oven gloves covered by Exhibit AD8. However, the Registered Proprietor’s mark is prominently displayed in all the labels and packaging shown in Exhibits AD3 to AD7 in at least one of the forms I have assessed in paragraph 24. In particular, the form, shown as number 2 in paragraph 24, is used in all of them. Mr Donnelly explicitly states that the figures in Exhibit AD8 relate to the Registered Proprietor’s “plain whipped, bound blue and black/grey double and single oven gloves all bearing the sign MASTER CHEF as shown in Exhibits AD3 to AD7 during the period 15 June 2009 to 7 August 2014” [underlining added], going on to state that “A total of 8,807 of these types of oven gloves were sold to UK retailers during this period.” This total figure tallies with the figures given in Exhibit AD8. I find product descriptions in Exhibits AD2 and AD8, AD12 and Mr Donnelly’s witness statement consistent. However, Exhibit AD8 includes 13 invoices which post-date the relevant period. These invoices account for 486 items. Deducting these from the given total of 8,807 leaves a figure of 8,321. Taking all this into account, I accept that sales of oven gloves covered by Exhibits AD2 and AD8 amounting to a total of 11,296 were made under the Registered Proprietor’s mark in the period 15 June 2009 to 9 June 2014. Taken together, I find that all of this constitutes genuine use of the mark in relation to oven gloves in the relevant period.

## **POT HOLDERS**

28) Mr Donnelly explicitly states that the invoice figures provided in Exhibit AD10 are “in relation to the apron/potholder set shown in Exhibit AD 9 during the period 11 December 2012 to 27 May 2014”. His total sales figure of 458 tallies with Exhibit AD10, and product descriptions in Exhibits AD10 and AD12 are consistent. I accept that the mark appeared as shown in Exhibit AD9 on the goods supplied under the invoices listed in Exhibit AD 10. The Applicant submits:

38. The packaging of the product shown at Exhibit AD9 indicates that it was to be sold as a “Premium Chefs Apron with Pot Holder”. Of the eight lines of other text on the packaging, seven describe the apron while the eighth simply adds ‘MasterChef pot holder’. Accordingly, it is submitted that the product relied upon by Vale Mill Is in fact an apron, with a pot holder included as a minor extra. It is submitted that consumers would buy this product for the apron, not the pot holder.

39. Further the apron is branded prominently as MINKY. The use of MASTERCHEF in respect of the pot holder is minor and subsidiary.

40. In these circumstances, it is submitted that any application of a mark in respect of the minor extra only is not use as a trade mark and/or cannot

amount to genuine use and/or should impose a greater burden upon the proprietor in proving such use. For example, it is submitted that Vale Mill must show (but has not shown) that consumers recognise MASTERCHEF as being a badge of origin for the pot holder, despite it being highly likely (in Shine's submission) that consumers will think they are buying a MINKY apron, with a pot holder thrown in. Further, where the evidence of genuine use of MINKY for aprons is poor — because of low sales as discussed below — then it must follow that this has an even greater impact on the ability (or rather inability) of those low sales to prove genuine use of a mark applied to the pot holder extra”.

29) The principal mark on the packaging shown in Exhibit AD9 is MINKY. By contrast with the prominent display of the MASTERCHEF mark in Exhibits AD1 and AD3-AD7, the MasterChef mark is not conspicuously displayed in Exhibit AD9. The Applicant submits that the pot holder is included with the apron as a minor extra, and that any application of a mark in respect of the minor extra only is not use as a trade mark, or cannot amount to genuine use, or should impose a greater burden upon the proprietor in proving such use. The test I must apply in this case is whether the nature of the use of the MasterChef mark shown here is capable of being taken by the average consumer as a sign indicating trade origin – as *Ansul* puts it, whether the nature of the use is consistent with the essential function of a trade mark. The pot holder in this case is sold as part of a product combination aimed at penetrating the market for protective clothing and gear for use when cooking. The principal item in the product combination is no doubt the apron and the principal mark on the packaging label in Exhibit AD9 is MINKY. However, I am satisfied that the reference to the MasterChef pot holder on the packaging label in Exhibit AD9 is capable of being taken by the average consumer as a sign indicating trade origin; it represents use of the trade mark in a manner consistent with the essential distinguishing function, and is therefore capable of showing genuine use.

30) The Applicant submits that the Registered Proprietor's evidence does not establish which, if any, of the products denoted by the product codes shown in Exhibits AD10 and AD12 the packaging label in Exhibit AD9 relates to. It is true that the Registered Proprietor's evidence could have been presented much more clearly. Although the same label appears in both images in AD9, the shade of the striped fabric differs, and the product descriptions in Exhibits AD10 and AD 12 are consistent with the different product codes being accounted for by same basic product being supplied in different colours. Moreover, the product descriptions in AD10 and AD12 are in all cases indicative of a striped apron plus pot holder. In any event, however, Mr Donnelly explicitly states that sales figures in Exhibit AD10 are “*in relation to the apron/pot holder set shown in Exhibit AD9 during the period 11 December 2012 to 27 May 2014. A total of 458 sets were sold to UK retailers during this period*”. The figure 458 tallies with the figures given in Exhibit AD10 for the product number CC13503100. I accept that the MasterChef mark shown in Exhibit AD9 was shown on 458 apron and potholder sets in the period 11 December 2012 to 27 May 2014. The question is whether this figure suffices to establish genuine use.

31) The figure in this case cannot be viewed as indicating sham or token use. It is certainly low. However, use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may

qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. The purpose of the use requirement is not to assess commercial success or to restrict trade mark protection to the case where large-scale commercial use has been made of the marks. In this case supplies have been made to customers in the UK over a period of seventeen and a half months during the relevant period. This was commercial use. Whilst not every proven commercial use qualifies as genuine use, assessing the facts overall, I find that the use shown does equate to genuine use of the Registered Proprietor's mark in connection with pot holders during the relevant period.

## **A FAIR SPECIFICATION**

32) I have found that the Registered Proprietor has proved genuine use for *oven gloves* in the relevant period. I do not consider that the average consumer would regard the terms *oven gloves*, *oven mitts* or *oven gauntlets* as describing discrete categories or sub-categories of goods. Rather, they would all be seen as referring to the same category or sub-category of goods for which I have found use, namely articles enabling the hands to be slipped in glove-like fashion into a protective covering which, by means of heat resistant padding, enables the user to handle hot cooking utensils without burning the hands. Accordingly, the registration for *oven gloves*, *oven mitts*, *oven gauntlets* stands. In any event, oven mitts and oven gauntlets would in my view clearly fall within the term *oven gloves* so it is pointless to revoke them specifically when they fall within a broad term which can be retained.)

33) I have found that the Registered Proprietor has proved genuine use for *pot holders* in the relevant period. The term *oven-heat resistant pads* is a broad one, in my view potentially covering various sub-categories consisting of the kind of product concerned including, for example, those which are placed beneath hot articles such as cooking utensils to protect the surfaces on which they are placed from heat damage and also the type of pads for which genuine use has been established. On the principles explained in *Aladin*, it would be unfair to allow a specification for such a broad category as *oven-heat resistant pads* to stand when use has only been shown for a narrower sub-category. The specification must be limited to reflect the sub-category of goods for which I have found use. Accordingly, I consider that *oven-heat resistant pads (namely pot holders)* represents a fair specification in this case.

34) No evidence whatever has been provided of any use in respect of place mats during the relevant period. Accordingly, the registration for *place mats* must be revoked.

## **OUTCOME**

35) The Registered Proprietor offered no evidence of use in respect of any of the goods of its registration for any of the periods in respect of which the Applicant sought revocation prior to the relevant period. Accordingly, the registration shall be revoked, with effect from the earliest date from which the Applicant sought

revocation, namely 15 February 1997, save for the following goods. The mark shall remain registered for the following goods.

**Class 21:** *Oven gloves, oven mitts, oven gauntlets, oven-heat resistant pads (namely pot holders); all included in Class 21.*

## **COSTS**

36) The Registered Proprietor requested a full award of costs, observing that this was the second time in five years that the Applicant had applied to cancel this registration. The Applicant replied that this application referred to a completely different period, and that an opposition filed by the Registered Proprietor in December 2012 meant that it had not had to compile evidence of use from scratch in the present proceedings. I am not persuaded that the previous cancellation proceedings should have any impact on the costs assessment required of me. The applicant has succeeded only partially. The proprietor has retained the goods for which it has been using the mark. The result might be described as a “score draw”. Neither side will be favoured with an award of costs.

**Dated this     day of March 2015**

**Martin Boyle  
For the Registrar,  
The Comptroller-General**