

O-306-16

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2520015
FOR THE TRADE MARK**



IN THE NAME OF ITAMARA DALL ALBA REGIS

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO 500839
BY CASA BRASIL (BOURNEMOUTH) LIMITED**

Background and pleadings

1) Itamara Dall Alba Regis (“the proprietor”) is the registered proprietor of trade mark registration no. 2520015 (“the registration”) for the following mark:



2) The trade mark was filed on 1 July 2009¹ and completed its registration procedure on 16 October 2009. It is registered in respect of the following goods and services:

Class 29: Meat, fish and poultry.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.

3) On 19 June 2015, Casa Brasil (Bournemouth) Limited (“the applicant”) filed an application for revocation of the trade mark registration on the grounds of non-use based upon Sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”).

¹ The registration was initially filed in the name of SAO Paulo Import Export Limited (UK) Ltd T/A Casa Brasil but was subsequently assigned to the proprietor with effect from 1 June 2012.

4) The proprietor filed a counterstatement denying the claim stating that the registration has been used in the course of business.

5) Revocation is sought under Section 46(1)(a) in respect of the 5 year period following the date of completion of the registration procedure, namely 17 October 2009 to 16 October 2014 (“section 46(1)(a) period”). The applicant claims an effective date for revocation of 17 October 2014.

6) Revocation is also sought under Section 46(1)(b) in respect of the following time periods (I shall refer to these as the “section 46(1)(b) periods”):

- 22 February 2010 to 21 February 2015, with an effective revocation date of 22 February 2015.
- 6 May 2010 to 5 May 2015, with an effective revocation date of 6 May 2015.

7) Only the proprietor filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

8) A hearing took place via video-link on 5 May 2016, with the applicant represented by Mr Jonathan Hill of Counsel, instructed by Hybrid Legal Limited. The proprietor was represented by Mr Frederico Singarajah of Counsel, instructed by Healys LLP.

EVIDENCE

Witness statement of Itamara Dall Alba Regis and exhibits IDAR1 to IDAR3

9) Ms Regis states that the trade mark Casa Brasil was first used in the United Kingdom in 2002 and states that she “took over conduct of the commercial activities” when her husband passed away on 2 December 2005.

10) Ms Regis states that when she began taking control of the commercial activities in 2005 she expanded them “substantially” as follows:

- Increased the number of products on offer to over 100 items, including pre-cooked food and meat. There is no evidence showing these goods being offered for sale, invoices or any other corroboratory evidence.
- Expanded the size of premises to approximately 5 times what it was in 2009. She states that “Whilst the shop is based in the same market in Queensway, London for over 16 years, we have constantly taken up more space in the market”.
- Participated in fairs, seminars, business meetings and public speaking opportunities. No specific details have been provided.
- Sponsoring events and donating to charities in Brazil and in the UK. No further details, including dates, have been provided.
- Ms Regis states that in 2008 she began “operating a café and juice bar in Leicester Square”. No further details have been provided. On 24 August 2015 (after the 46(1)(a) and (b) periods) Ms Regis also opened a café in Queensway, London.
- Organisation of art exhibitions at the Queensway shop “with a number of exhibitors such as Sandra Rocha Griffiths in February 2015, Eunice Pascalli in May 2015, Romansani since July 2015, and in December 2015 we shall exhibit the works of Angelika Berndt, a well known British photographer – “Apageart”.”
- Nominated for the “Best of 2015” award from a Brazilian based magazine. It hasn’t been stated what they have been nominated to be the “best” for, or at.
- Ms Regis also states that in 2015 the proprietor was chosen by a Latin American distributor to sell and distribute its goods in London.
- Began using the mark for the class 29 goods in 2009, class 30 for the majority of the goods in 2000 (sandwiches and prepared meals since 2004) and the class 43 services since 2010.

11) Ms Regis filed three exhibits, the first being extracts detailing the registration. The second exhibit, IDAR2, consists of a number of advertisements which have been placed in “Brazilian News”, “LEROS”, “Brazilian Post”, “Brasilobserver.co.uk” and the website braziliannews.uk.com. I shall provide further details of the advertisements but firstly make the following general observations: 1) the witness statement does not provide any circulation figures or indication of how many people, and where, viewed the adverts, 2) many are in Portuguese, 3) they include the mark as registered, and 4)

the mark does not appear on any of the goods, and 5) the majority of the goods are sold under third party brands.

12) Exhibit IDAR2 consists of the following:

- An advertisement showing the words “Casa Brasil” at the top. On the right hand side of the advertisement “SPI London, date: 07/05/2004” is hand written. This is before the 46(1)(a) and (b) periods and so it does not assist the proprietor.
- An advertisement from the website jungledrums.org. It is dated 12 May 2004 which is before the relevant periods and, therefore, does not assist the proprietor.
- An advertisement in “Brazilian News” dated 10 March 2010. It shows the mark as registered in the top right hand corner of the advertisement and shows a number of goods, including tea, coffee, etc. The representations of the goods are not clear but you can see that the goods are individually branded, but not by the registration. In the bottom right corner of the advertisement it states “Now new modern premises, with butchers section”.
- Further advertisements placed in “Brazilian News” (website braziliannews.uk.com) dated 23 June 2010 and 11 August 2010 respectively. The advertisement states “The most traditional and best range of Brazilian products in London” and shows goods such as books, magazines, groceries, teas, coffees, etc. None of which bear the registration. Other examples from the same publication/website are from “Brazilian News” dated 24 November 2010, 1 December 2010 and 12 January 2011 and refers to Casa Brasil as being an off-licence.
- Advertisements which appear in a publication called “REAL”. The Portuguese hand written dates “Janeiro 2011”, “Outubro 2011” and “Janeiro 2012” appear in the bottom right hand corners. A further advertisement is dated “27 de Fevereiro – 5 de Marco se 2014”.
- Advertisements which appear in a publication called “Leros”. They are dated “Junho 2012”, “Outubro 2012”, “Agosto 2013”, “Janeiro 2014”, “Fevereiro 2014” and “May 2015”. Some of the articles are in Portuguese and the others in English. Each of the advertisements show the proprietor’s UK address with

some including a map showing the location. None of the goods referred to in the advertisement bear the registration. Two of the advertisements include pictures of an unbranded hamper which appears to show third party products.

- An advertisement which appears in “BrazilianPost” dated “Julho 2013”. The advertisement includes an article about the proprietor referring to it as a “store”. The article states “We are also working with a butcher to offer the best quality cuts of meat.”. The advertisement does not show any pictures of meat, or any goods bearing the registration.
- An article placed in “BrazilianPost” dated 1 – 14 October 2013. It is headed “Casa Brasil celebrates Children’s Day”. It shows third party branded goods.
- Further extracts from “brasilobserver.co.uk” with the hand written dates 13 – 26 February 2014, 27 February – 12 March 2014 and 21 March – April 2014.

13) Exhibit IDAR3 consists of various letters. I summarise each as follows:

- Undated letter from Liliam Chagas de Moura, Head of Trade and Investment at the Embassy of Brazil to “Whom it may concern”. It makes reference to the proprietor stating she was a speaker at a seminar for “The Brazilian Community Businesses in the United Kingdom: Challenges for Striving and Strategies for Growth”. The seminar was held at the embassy on 24 November 2009, i.e. within the section 46(1)(a) period. The letter does not include the mark, but it does state “Ms. Regis presented her experience with Casa Brasil – Sao Paulo Imports, a store selling Brazilian products in the United Kingdom since 1989.”
- An undated letter from Teresa Nemes, Member of the Board of trustees in charge of events for the Anglo-Brazilian Society. The letter does not contain any information on the events, for example, how many people attended, who they were or what was charged for the services.
- The next letter is duplicated below in its entirety. As can be seen it is dated 14 August 2015, i.e. within the section 46(1)(b) period. The letter makes no reference to the registration:

dot.tv productions ltd
364a ivydale road, london se15 3dg

London 14th August 2015

To may be concern, I declare that Dot.tv Productions Ltd, has produced a video about Itamara Della Alba and Casa Brasil for Canal Londres. The video was post in May 13, 2010, at <http://www.canal-londres.com.br/midias-statement-itall-rtbr> where it still can be seen.

Best regards,



Silvino Ferreira Jr – Editor of Canal Londres

- A letter dated 10 December 2010, i.e. within the relevant 46(1)(a) and (b) periods, from the Brazilian Christian Community to the proprietor. The letter thanks the proprietor for supporting the Brazilian community. In particular, it states that “Because of Casa Brasil and the Catering service you are able to offer we provide the after church tea 46 times, during almost all Friday’s in 2010”. The witness statement does not provide any additional information regarding the catering services provided, i.e. what was charged or if the services were provided on a charitable basis.



Brazilian Christian Community – Bayswater-LDN
Church Our Lady Queen of Heaven - Queensway Road - Queensway

London, 10th December 2010.

Dear Casa Brasil / CEO Itamara D'alba

We the Brazilian Christian Community like to be thankful for your support during these year of 2010.

Thanks for your support we are able to provide to the brazilian communitiy so many activitys, like

06.08.10 – Life Coaching – Etel Harris

13.08.10 – NHS, Heart Attack, etc – Dr Rebecca Wood

20.08.10 – Revenuen and Account – ASC Accounts

27.08.10 – Met Police and Queensway Neighbourhood Team – Westminster City Council

10.12.10 – Christmas Party. – (thanks for all your donations)

Because of Casa Brasil and the Catering service you are able to offer we provide the after church tea 46 times, during almost all Friday's in 2010.

Please accept one more time my compliments and grattitude in my name and our Community

Sincerelly

Carlos Augusto Barros

- A letter dated 22 October 2015, i.e. after the relevant periods, from Guilherme Tavares who is the director of Creative Brasil to “whom it may concern”. The letter states:



80b Compayne Gardens NW6 3RU

To whom it may concern

We, from Creative Brazil/Nossa Voz/Cantar declare that Casa Brasil supplied the catering for our cultural event on 25th of September 2015 at the Brazilian Embassy.

The company provided food and service at the event in a very professional level.

Many thanks for the offer to our project.

London, 22/10/2015

Guilherme Tavares

director of Creative Brazil / Cantar Project

www.creativebrazil.org

14) Ms Regis states that the "annual sales of the class 29 and 30 goods, as well as class 43 services were as follows:

| Year | Amount |
|-------------|---------------|
| 2001-2002 | £85,122 |
| 2002-2003 | £109,206 |
| 2003-2004 | £155,261 |
| 2004-2005 | £207,896 |
| 2005-2006 | £217,937 |
| 2006-2007 | £184,867 |
| 2007-2008 | £231,490 |
| 2008-2009 | £277,922 |
| 2009-2010 | £312,195 |
| 2010-2011 | £316,719 |

| | |
|--------------|-------------------------------|
| 2011-2012 | £294,324 |
| 2012-2013 | £257,461 |
| 2013-2014 | £230,283 |
| 2014-2015 | £226,507.47 (not yet filed) |
| 2015 to date | £110,610.40 (as at 30.09.15)” |

15) With regard to the advertising spend, Ms Regis states that the following was “spent on promoting the goods/services were as follows”:

| Dates | Amount |
|--------------|---------------|
| 2002 | £5,513 |
| 2003 | £6,159 |
| 2004 | £7,466 |
| 2005 | £7,686 |
| 2006 | £8,457 |
| 2007 | £7,963 |
| 2008 | £9,653 |
| 2009 | £12,616 |
| 2010 | £13,228 |
| 2011 | £13,985.36 |
| 2012 | £6,133.72 |
| 2013 | £40,940 |
| 2014 | £33,897 |
| 2015 | £9,310.14” |

16) Ms Regis states that the mark has been used on the goods and services in London, Manchester, Birmingham, Bournemouth and Edinburgh. Further, Ms Regis claims that the marks has been used on the goods and services outside of the UK in Belgium, Brazil, Denmark, Israel, Italy, Japan, Portugal, Saudi Arabia, Spain, Switzerland and USA.

Legislation

17) Section 46(1) of the Act states that:

“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 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.”

18) Section 100 is also relevant, which 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.”

General case law principles

19) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the

Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

DECISION

20) During the hearing Mr Singarajah helpfully stated that all of the exhibits showed use of the mark for the goods and services but exhibit IDAR3 related solely to the services. I intend on reviewing the evidence in relation to the goods and services separately.

Goods

21) What is immediately clear from the evidence is that the registration does not appear on any goods. Whilst the exhibits are not entirely legible, all of the products appear to be branded with third party marks, and not the registration. The proprietor is clearly a shop which sells various Brazilian goods. Therefore, it is a question of whether the proprietor's use of the mark in a retail context is sufficient for such use to overcome a non-use revocation action for a registration covering goods. Section 46 (1)(a) of the Act includes the words "in relation to" which means that whilst a mark may not actually be used on the goods for which it is registered, it may still be deemed to have been genuinely used and overcome a revocation claim. There is no general rule on whether such use is sufficient and every case will turn on its own facts.

22) In *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11), Mr Daniel Alexander Q.C. as the Appointed Person stated at paragraph 17 to 20 that:

".....unless it is obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of "use in relation to" goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:

"...even where the sign is not affixed, there is use "in relation to goods or services" within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party."

The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in what is now Article 42 of the European Union Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/091, the General Court said at paragraphs 23 and 24 that:

“In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being ‘in relation to goods or services’ (*Céline*, paragraph 21).

Conversely, there is use ‘in relation to goods’ where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use ‘in relation to goods or services’ within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.”

23) In *Euromarket Designs Inc. v Peters* [2001] F.S.R. Jacob J. (as he then was) stated at paragraph 56 that:

“That is not all on the question of non-use. If one looks at the advertisements they are essentially for the shops. True it is that some of the goods mentioned in the advertisements fall within the specification, but I doubt whether the reader would regard the use of the shop name as really being “in relation” to the goods.

I think this is an issue worthy of trial in itself. The argument is that there is an insufficient nexus between “Crate & Barrel” and the goods; that only a trade mark obsessed lawyer would contend that the use of “Crate & Barrel” was in relation to the goods shown in the advertisement.

57. In this connection it should be borne in mind that the Directive does not include an all-bracing definition of “use”, still less of “use in relation to goods”. There is a list of what may *inter alia* be specified as infringement (Article 5(3), corresponding to section 10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Article 10(2), equivalent to section 46(2)). It may well be that the concept of “use in relation to goods” is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled “Boots”, only a trade mark lawyer might say that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign “in relation to” the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel United States shops to the United Kingdom in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.”

24) In *Cactus SA v OHIM*, Case T-24/13, the General Court held that the owner of what was then a CTM (now an EUTM) who used the mark only as the name of a shop had used the mark “in relation to” the natural plants, flowers and grains sold in the shop (as well as in relation to retail services for those goods). This is because it had demonstrated that the public would link the (otherwise unbranded) goods to the mark used for the shop and regard the user of that mark as being responsible for the quality of the goods. The court stated at paragraphs 69 to 71 that:

“Accordingly, in view of the context of the present case, as described in paragraphs 66 to 68 above, and, in particular, the applicant’s specific expertise in the plants and flowers sector, which it publicises, it must be

considered that the documents submitted by the applicant which show the earlier marks establish to the requisite standard that there is a link between those marks and plants, flowers and seeds which bear no mark. Those documents show that the applicant offers for sale or sells those goods with the earlier marks as the only indication of a trade mark, with the result that those marks are the only signs that provide an indication of the commercial origin of the goods in question.

That conclusion is not affected by the consideration referred to by the Board of Appeal and OHIM that, in the light of the registration of the earlier marks in relation to retail services in Class 35, the earlier marks must be regarded as designating the applicant's stores which retail plants, flowers and seeds, not those goods themselves. Although the earlier marks are also registered to designate retail services in respect of the sale of plants, flowers and seeds, as is apparent from paragraphs 31 to 39 above, that does not mean, given the context of the present case described in paragraphs 66 to 68 above, that those same marks may not also designate plants, flowers and seeds which bear no mark and which are offered for sale in shops operated by the applicant.

In those circumstances, it must be concluded that the Board of Appeal erred in deciding that the applicant had not proved genuine use of the earlier marks in relation to 'natural flowers and plants, grains' in Class 31."

25) During the hearing Mr Hill highlighted that the onus is on the proprietor to show use of the mark and, on the balance of probabilities, to discharge the burden placed upon them under section 100 of the Act. I note paragraph 20 of the *Multisys* trade mark² whereby Mr Daniel Alexander QC, sitting as the Appointed Person, stated:

"Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time review the

² *Advanced Perimeter Systems Ltd v Keycorp Ltd (Multisys Trade Mark)* [2012] RPC 14 at [17]-[22]

material that it has to prove use of it. Courts and tribunals are not unduly harsh as to the evidence they are prepared to accept as establishing use.”

26) The evidence shows that the proprietor has at least one shop (based in London) where it sells goods which bear third party brands. The proprietor has not demonstrated that a link has been established between the registration and the goods themselves other than it selling products on the behalf of others. The goods will therefore be selected on the basis of the brands under which they are marketed rather than the retailer. Since no link has been demonstrated then such use cannot be viewed as being consistent with the essential function of the mark which is to guarantee the identity of the origin of the goods.

27) During the hearing Mr Singarajah made reference to the proprietor’s evidence which advertised hampers (two advertisements in the publication “Leros”). He argued that since the hamper is sold in the shop and does not bear a third party trade mark then this constitutes evidence of use of the registration for the goods. Mr Hill stated that “hampers” is not a term recognised for trade mark classification purposes. Further, the goods themselves (once taken out of the hamper) would be individually branded and this does not constitute genuine use of the registration. I agree with Mr Hill that a shop selling “hampers” which contains individually third party branded goods is not genuine use of the registration. Consumers will merely denote trade origin from the individual brands placed on each of the goods. Further, there is no evidence to show that hampers were in fact sold, i.e. invoices, sales receipts, etc. Therefore, I reject this line of argument.

28) The proprietor’s goods also cover class 29 “meat, fish and poultry”. These goods are often sold over a meat counter and are not individually branded. Therefore, as Mr Hill agreed, the sale of such goods may be use of the registration “in relation to” the goods since they would not be individually branded and in the mind of consumers the shop would denote trade origin. Ms Regis did state that the proprietor was working with a butcher in order to provide meat, though there is no evidence to support this claim and to determine whether such use is genuine. Therefore, the proprietor has failed to show genuine use for any of the goods covered by the registration.

29) Taking all of the evidence into account, the proprietor has failed to show genuine use of the mark for the goods covered by the registration. In this instance, use in a retail context has not been sufficient to overcome the revocation claim.

Services

30) As previously stated, during the hearing Mr Singarajah helpfully advised that exhibit IDAR3 relates solely to the services covered by the registration. The exhibit has been reviewed at paragraph 13 of the evidence summary and comprises of letters from third parties. The authors of these letters have not provided them under cover of a statement of truth and, as such, they must be considered as hearsay. Further, three of the five letters are headed "To whom it may concern", which was discussed by Professor Ruth Annand, sitting as the Appointed Person, in *DUCCIO* Trade Mark BL O343-09, whereby she observed³:

"There are two ways in which "to whom it may concern letters" can be introduced in Registry proceedings. First, the writer of the letter can provide a verifying affidavit, statutory declaration or witness statement to which his or her letter is exhibited. Second, the party seeking to rely on the letter can provide an affidavit, statutory declaration or witness statement to which the third party letter is exhibited. In the first case, the letter is part of the writer's own evidence. In the second case, the letter is hearsay evidence admissible by virtue of section 1 of the 1995 Act."

31) Guidance on how hearsay evidence should be treated is addressed under section 4 of the Civil Evidence Act 1995 it permits such evidence in civil proceedings but provides the following guidance as to the weight to be accorded to such evidence:

"Considerations relevant to weighing of hearsay evidence.

³ Also see Tribunal Practice Notice (TPN5/2009) headed "Correspondence solicited for proceedings"

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following -

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.”

32) Hearsay evidence should not be discounted simply because it is hearsay though I must take the above in factors into consideration in order determine the necessary weight to attach to the evidence, if any at all. On this basis, I shall review each of the letters in turn, bearing in mind that the guidance above.

33) Whilst the letter from the Head of Trade and Investment at the Embassy of Brazil is undated, it does make reference to a seminar which was held at the Brazilian embassy on 24 November 2009 whereby Ms Regis “presented her experience with

Casa Brasil – Sao Paolo Imports, a store selling Brazilian products in the United Kingdom since 1989”. Although the event is before the relevant 46(1)(a) and (b) periods, I may take into consideration evidence which casts light back on the circumstances during the aforementioned periods. Mr Singarajah argued that the aural presentations given by the proprietor about its catering experiences support there being genuine use. I am required to take into account all of the relevant facts and circumstances surrounding the case, and verbal use of the registration may assist the proprietor. However the talk appears to be about the retailing of goods rather than the services covered by class 43. Even taking the letter as *prima facie* evidence (and not limited in value by virtue of it being hearsay) it does not provide details of sales, number of customers, services provided, etc. Therefore, it does not support the proprietor in demonstrating genuine use of the registration for the class 43 services. For the same reasons the undated letter from Teresa Nemes of the Anglo-Brazilian Society does not assist the proprietor.

34) With regard to the letter from the editor of Canal Londres there is no reference to any services being provided or anything that associates the proprietor with such class 43 services. This hearsay letter does not assist the proprietor in its attempt to prove genuine use of the registration for the services which it covers.

35) The only letter within either of the section 46(1)(a) and (b) relevant periods (10 December 2010) is from the Brazilian Christian Community. It states “Because of Casa Brasil and the Catering service you are able to offer we provide the after church tea 46 times, during almost all Friday’s in 2010.” It is not clear whether the “tea” was provided on a charitable basis or, if not, the revenue created or how this may create and maintain a marketshare. I accept that not-for-profit use of the registration may constitute genuine use of the mark, though I do not accept that supplying a single organisation with tea is sufficient commercial exploitation of the registration on the market for the class 43 services which is to create or preserve an outlet for the services that bear the mark⁴.

⁴ See Arnold J. summary in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52

36) Finally, the letter from Creative Brazil refers to an event held on 25 September 2015. This is after the relevant section 46(1)(a) and (b) periods and so it does not assist the proprietor in demonstrating genuine use.

37) Ms Regis does state in her witness statement that the proprietor opened a café in August 2015. This is after the relevant section 46(1)(a) and (b) periods and does not cast light on these periods or assist the proprietor in its defence of the registration.

38) In view of the above, the proprietor has not demonstrated genuine use of the registration for the class 43 services.

Conclusion

39) The application for revocation succeeds in its entirety. The registration shall be revoked under section 46(6)(a) with effect from 17 October 2014.

COSTS

40) The applicant for revocation has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant for revocation the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

| | |
|---|--------------|
| Official fee | £200 |
| Preparing a statement and considering the other side's statement | £300 |
| Considering the other side's evidence | £200 |
| Preparing for and attending a hearing | £400 |
| TOTAL | £1100 |

41) I therefore order Itamara Dall Alba Regis to pay Casa Brasil (Bournemouth) Limited the sum of £1100. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of June 2016

MARK KING

For the Registrar,

The Comptroller-General