

BL O/290/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3268618

BY

FIND FORM LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 05, 30, 32, 35, 41:

FORM

AND

OPPOSITION THERETO (NO. 600000810)

BY

ETI GIDA SANAYI VE TICARET ANONIM SIRKETI

Background and pleadings

1. Find Form Ltd (the applicant) applied to register the trade mark:

FORM

in the UK on 06 November 2017. It was accepted and published in the Trade Marks Journal on 01 December 2017, in classes 05, 30, 32, 35 and 42.

2. Eti Gida Sanayi Ve Ticaret Anonim Sirketi (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is raised against all of the goods and services in classes 30 and 35 of the application, namely:

Class 30: Beverages, tea and coffee; tea and coffee products; coffee beans; coffee substitutes; tea bags; fruit and herbal teas, fruit and herbal infusions; green tea; white tea; flavoured teas; iced tea; tea substitutes; instant coffee; ground coffee; coffee beans; chocolate and cocoa-based beverages; confectionery; yoghurt bars; snack chips and crackers made of corn, wheat and grain, all being high-protein products; savoury snacks; cereal bars and energy bars; coated nuts (confectionery); snack foods made from muesli, cereals, wheat, corn, rice, grains or maize all being high-protein products; granola snacks; high-protein cereal bars.

Class 35: Wholesale and retail services connected with drinks, vitamins, personal care products, health and beauty products, dietary and medicinal products; wholesale and retail services connected with tea and coffee products, coffee beans, yoghurt bars, savoury snacks, cereal bars and energy bars, coated nuts (confectionery), confectionery, granola snacks and high-protein cereal bars; wholesale and retail services connected with snack chips and crackers made of corn, wheat and grain and snack foods made from muesli, cereals, wheat, corn, rice, grains or maize all being high-protein products; all provided via retail stores, mail order and online retail store

services; information, advisory and consultancy services in relation to the aforesaid services.

3. The opposition is based on earlier International Registration designating the UK WO0000001027204, registered on 08/12/2009 and protected in the UK from 22/07/2010, for the mark:



4. Given the date of protection, the opponent's mark qualifies as an earlier mark in accordance with Section 6 of the Act and is subject to the proof of use provisions contained in Section 6A. As the opponent filed a fast track opposition it simultaneously filed evidence to prove genuine use of its earlier mark.
5. The earlier mark is registered for the following goods:

Class 30: Coffee, cocoa, artificial coffee, mocha (coffee), coffee substitutes, coffee or cocoa-based beverages; tapioca, sago; macaroni, meat pies, vermicelli; breads, pitas, pizzas; biscuits, crackers, wafers, pastries, petit-fours, tarts, cakes; desserts made of flour; puddings; honey, propolis; yeast, baking-powder, vanillas; any kind of flour, semolina, starch; sugar, powdered sugar; tea, iced tea; confectionery, Turkish delight, frozen yoghurt, (confectionery), chocolates, chocolate products, products covered with chocolate and candy, confectionery for decorating Christmas trees, chocolate-based beverages; chewing gum, ice creams, edible ices; salt, rice, boiled and pounded wheat bulgur, malt for food; appetizers made of cereal and flour, roasted corn and wheat, crisps, corn flakes, crushed oats, cereal for breakfast.

6. For the purposes of this opposition however, the opponent states that it relies only on 'breads, Zwieback and Etimek bread; biscuits and biscotti'.
7. It should be noted however, that the specification of goods covered by the opponent's earlier mark does not explicitly include the terms Zwieback bread, Etimek bread or Biscotti. The first two terms are bread products and are therefore encompassed under the wider term 'Breads' of the opponent's specification. The term 'biscotti' is defined by the Oxford English Dictionary as 'small rectangular biscuits containing nuts'.¹ This term is encompassed by the wider term 'Biscuits' in the opponent's specification of goods.
8. The goods on which the opponent can therefore rely are:

Class 30: Breads; biscuits.

9. In its statement of grounds, the opponent claims that:
 - The marks at issue are visually highly similar as the applicant's mark consists solely of the word FORM, which also appears in the earlier mark and, due to its size and position in the earlier mark, will be perceived first in that mark by the average consumer.
 - The verbal elements of the marks at issue, 'Eti FORM' and 'FORM', are phonetically highly similar.
 - Conceptually neither mark has any significance to the goods or services to hand that would help to differentiate the marks.
 - The applicant's goods and services are either identical or similar to the opponent's goods in terms of their nature, purpose, channels of trade and complementary natures.

¹ <https://en.oxforddictionaries.com/definition/biscotti>

- As the earlier mark has no significance in relation to the goods at issue, it therefore has a strong inherent distinctive character and should be afforded a broader ambit of protection.
- There is a likelihood of confusion between the marks at issue, which includes a likelihood of association between them.

10. In its counterstatement the applicant claims that:

- The opponent's evidence of use is insufficient and as such, the opponent has failed to demonstrate any genuine use of the earlier mark. That being the case, the opposition should be refused in its entirety.
- The applicant's mark is not similar to the opponent's earlier mark. The earlier mark contains an additional word element 'ETI' and a highly stylised figurative element which significantly alters the visual appearance of the mark. The rights afforded by the opponent's registration do not extend to exclusive rights in the word 'FORM'.
- The opponent's house mark 'ETI' is the first verbal element of the earlier mark and will be pronounced first. The later mark does not include the 'ETI' element. As 'ETI' has no meaning in English, it is highly unusual. The earlier mark also contains an intricate detailed figurative element in the top left of the mark, which is eye-catching. As such the applicant refutes the opponent's claim that the word 'FORM' in the earlier mark constitutes the dominant and distinctive element in that mark purely because it comprises the largest element in that mark.
- There is no likelihood of confusion between the marks at issue.

11. The opponent filed proof of use evidence and submissions in writing. The applicant filed written submissions, in which it commented on the opponent's statement of

grounds and evidence. I will not summarise the written submissions of either party here, but will refer to them when necessary, throughout my decision.

12. As no hearing was requested, this decision is taken following a careful perusal of the papers.
13. Throughout the proceedings the applicant has been represented by Bird & Bird LLP and the opponent has been represented by Hiddleston Trade Marks.

Evidence

14. The opponent submitted evidence of use in the form of a witness statement of Ms Zeynep Dipcin Akdogan, who is the Vice President of Marketing, and an Executive Committee Member of the opponent company, along with three exhibits numbered ZDA1, ZDA2 and ZDA3.
15. In the witness statement, Ms Akdogan states she has worked for the opponent company since 2006 and is thoroughly familiar with the English language (Turkish being her mother tongue).
16. Ms Akdogan states that exhibit ZDA1 is an extract from the UK IPO database which shows the registration details of the mark forming the subject of UK designation No. 1027204 (the opponent's earlier mark).
17. Ms Akdogan states that the opponent has been using its earlier mark in relation to the goods relied upon (breads, Zwieback and Etimek bread; biscuits and biscotti) in the UK during the relevant period (01 December 2012 to 30 November 2017).
18. Ms Akdogan states that the approximate sales of the goods relied upon during the relevant period for each of the last 5 years are as follows:

2013: £4265.37

2014: £7259.62

2015: £5595.46

2016: £6534.30

2017: £5003.30

19. Ms Akdogan states that the opponent has sold the goods relied upon, between 05 May 2013 and 01 December 2017, in London, Enfield, Manchester, Bristol and Sheffield.
20. Ms Akdogan states that exhibit ZDA2 comprises copies of invoices intended to illustrate sales of the goods relied upon under the opponent's earlier mark, for each of the years 2013 – 2017.
21. Finally, Ms Akdogan states that exhibit ZDA3 comprises a number of photographs illustrating the goods relied upon in the UK under the opponent's earlier mark.

Decision

Proof of use

22. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) 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

(b) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

Section 100 of the Act states that:

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

23. 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:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] 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 added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish),

“sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. 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 Bundervsvereinigung 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]."

24. According to section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. Consequently, the relevant period is 01 December 2012 to 30 November 2017.

25. Before assessing the opponent's evidence of use, I remind myself of the comments of Mr Daniel Alexander, Q.C., sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, where he stated that:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. Use should be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (to use the words of *Anheuser-Busch*).

20. 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 to review the 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.”

A n d

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually

provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

26. In the witness statement of Ms Akdogan, she refers to exhibit ZDA1 which is an extract from the IPO database that shows details of the registration of the earlier mark relied upon by the opponent. I can confirm that this information is correct. The mark relied upon is reproduced above in paragraph 3 of this decision and can be seen to be a complex figurative mark, comprised essentially of three components that form the whole.
27. Exhibit ZDA2 is described by Ms Akdogan as containing copies of invoices intended to illustrate sales of the relevant goods under the earlier mark, in the UK during the period 2013 – 2017. I note that there are several invoices submitted under this exhibit, however, it is also the case that a number of packing/weight certificates showing shipments of the opponent’s goods are included in the exhibit along with several check lists that also display some of the opponent’s goods intended to be shipped from Turkey to customers of the opponent. The check lists and packing certificates appear to tally with each other.
28. The invoices that have been submitted under ZDA2 can be considered as two ‘batches’ for ease of reference and analysis. The first ‘batch’ contains five invoices from a company called Tees Limited which is based in Enfield, London. These invoices show sales of the opponent’s goods, via Tees Limited, to three other entities, one invoice to Midgros Foods Limited of Nottingham; one invoice to Venus Foods Ltd of Manchester, and three invoices to EDA Quality Foods Limited of London. Of the three invoices going to EDA Quality Foods Limited two are duplicates. Consequently, there are in fact only four invoices in the first batch, i.e. those sent out by Tees Limited.

29. The invoice from Tees Limited to Midgros Foods Limited is dated 07/09/2017 and shows sales of £34,333, of many different products from the opponent, however the only indication of the mark at issue is a reference to a sale of 'ETI FORM' totalling £252.
30. The invoice from Tees Limited to Venus Foods Ltd is also dated 07/09/2017 and shows sales of £14,142 of many different products from the opponent, however the only indication of the mark at issue on that invoice is a reference to a sale of 'ETI FORM ETIMEK' totalling £50.40.
31. The invoices from Tees Limited to EDA Quality Foods Limited are dated 27/10/2017 and 02/11/2017. The first invoice shows sales of £18,517 of many different products from the opponent, however the only indication of the mark at issue on that invoice is a reference to a sale of 'FORM' totalling £209.88. The second invoice shows total sales of £64,823.38, with sales of 'ETI FORM ETIMEK' being £954.
32. The second 'batch' of invoices submitted under exhibit ZDA2 consists of eight invoices going from EDA Quality Foods Limited to four entities. The four customers of EDA Quality Foods Limited are: New Foods of Liverpool Ltd, Liverpool; Ravza Ltd, Sheffield; Istanbul Foods Ltd, Bristol and 42 Brothers Ltd, London. The evidence provides two invoices for each of these companies, comprising eight invoices in total however, each invoice has been duplicated and therefore the second batch essentially contains four invoices, one to each of the companies listed above.
33. The invoice from EDA Quality Foods Limited to New Foods of Liverpool Ltd is dated 24/10/2016 and shows sales of £7.15 of a product listed as 'Etimek Form'.
34. The invoice from EDA Quality Foods Limited to Ravza Ltd is dated 13 January 2017 and shows sales of £6.09 of a product listed as 'Etimek Form'.
35. The invoice from EDA Quality Foods Limited to Istanbul Foods Ltd is dated 15/02/2017 and shows sales of £5.83 of a product listed as 'Etimek Form'.
36. The invoice from EDA Quality Foods Limited to 42 Brothers Ltd is dated 16/08/2017 and shows sales of £6.44 of a product listed as 'ETI Etimek Form'.
37. None of the invoices in either 'batch' displays the earlier mark relied upon.

38. It appears that Tees Limited and EDA Quality Foods Limited are authorised distributors of the opponent's goods in the UK.
39. I note that each of the invoices going from EDA Quality Foods Ltd to New Foods of Liverpool Ltd; Ravza Ltd; Istanbul Foods Ltd and 42 Brothers Ltd, displays the same 'previous balance' of minus £778.75.
40. Exhibit ZDA2 also contains three packing and weight certificates, however two of them are duplicates. The duplicated version provides information about a shipment of goods from the opponent in Turkey to Tees Limited, in Enfield. The other certificate shows similar information of shipments intended for EDA Quality Foods Ltd. These certificates do not display the opponent's earlier mark but do contain the 'ETi' figurative logo without the word 'FORM' although that logo is not particularly clear and the 'ETi' element is blurred on all copies. These certificates do not provide any information as to the value of the shipments, merely the weights of each product item that has been ordered and prepared for shipping. The duplicated certificate to Tees Limited is dated 12/07/2017. The certificate to EDA Quality Foods Limited is dated 10/12/2016.
41. There are also several pages of check lists of stock, all of which provide information of product items and values presented in US dollars. There are no indications as to the destination of the products listed and whilst nine pages have been submitted, many are duplicates, in fact one is replicated four times. In all, there are four check lists. None of these check lists are dated. The 'ETi' logo is displayed but not in conjunction with the word 'FORM' as per the registered mark. These check lists appear to tally with and support the information presented in the packing and weight certificates of the opponent.
42. ZDA2 also contains a number of pages of 'Fatura' from the opponent (one is undated), which incorporate the figurative detailed element in the earlier mark with the stylised 'ETi' element, at the head of each page. On these documents the words 'FORM', 'FORM ETIMEK' and 'FORM BREAD RUSKS' are also present, listed as specific products further down the page, however the mark as registered is not shown at all. One of the 'Fatura' shows Tees Limited as the customer and is dated

12/01/2017. The other 'Fatura' list EDA Quality Foods Limited as the customer, the oldest of these, dated 07/01/2014 does not list any 'FORM' product at all.

43. On much of the evidence provided under exhibit ZDA2, the words:

- FORM R. BREAD LIGHT
- FORM BREAD RUSK
- FORM
- ETI FORM LIGHT
- ETI
- ETIMEK
- ETIMEK FORM
- FORM ETIMEK

are displayed as names of specific products of the opponent. However, the combination 'ETI FORM', which comprises the verbal elements present in the earlier registered mark, is not used as an expression on its own. The mark relied upon is not displayed in any of the evidence in exhibit ZDA2.

44. Exhibit ZDA3 comprises six colour photographs. The first photograph shows a wrapping for the opponent's product 'Sliced Bran Rusk Bread', the mark relied upon is present on the wrapping and the text is in English. The photograph is not dated.

45. The second photograph is, I assume, the reverse of the wrapping in photograph one. There is no indication of the mark, or any parts of the mark relied upon, in photograph two.

46. The third photograph appears to be identical to the first photograph, but with Turkish language used rather than English.

47. The fourth photograph is a slightly different wrapping to that shown in photographs one and three. It also shows the mark relied upon and the language used is Turkish. This wrapping has a date stamp, which shows the date 10 April 2018.

48. Photograph five shows a display stand of food products in a retail setting, with prices shown in pounds sterling. The opponent's rusk bread is on show, but the mark relied upon is not present. The figurative device element of the opponent's mark is shown on some of the products, and the textual element 'ETi' is shown in combination with the term 'MEK', forming the word 'Etimek' which is used commonly by the opponent throughout the evidence and seems to be a type of rusk bread. The word 'FORM' is not shown at all in this photograph.
49. The final photograph shows another retail stand with many types of food products on display and prices set in pounds sterling, however the image is not clear enough for me to pick out the opponent's goods or mark. Aside from the date stamp on photograph four, none of the images in ZDA3 are dated.
50. Having considered all of the evidence of use submitted by the opponent to prove genuine use of the mark relied upon, I come to the following conclusions:
51. The opponent has submitted no information at all as to the extent of marketing or promotional activity undertaken to raise brand awareness in the UK during the relevant period. There is also a lack of information as to the market share that the opponent enjoys, however, in the context of the UK breads and biscuits market, which is likely to be worth at least hundreds of millions of pounds annually, the low volume of sales shown in evidence suggests that the opponent's share of that market is extremely small at best.
52. The evidence provided by the opponent cannot be said to be token or 'sham', in the sense that the opponent has shown only use intended purely for the purpose of maintaining the trade mark, and certainly the applicant has not argued that this is the case. I also accept that a very small amount of use can be deemed to amount to genuine use in certain circumstances and that no *de minimis* rule can apply. However, the assessment of evidence of use cannot be based solely on the volume of sales of goods or services, a multi-factorial assessment must be carried out.
53. In '*Sant Ambroeus*'², Ms Anna Carboni, sitting as the Appointed Person (AP) stated:

² BL O/371/09

57. That brings me to the *Sonia Rykiel* case, from which the hearing officer relied on the passages set out at paragraph 34 above. That case also concerned the use of a trade mark in relation to clothing. The CFI began its findings in the usual way, citing article 43(2) and (3) of the old Regulation and the proof of use provisions under rule 22(2) IR, and considering the authorities on the meaning of genuine use. Having referred to the fact that scale and frequency of use of the mark were among the factors to be taken into account, the CFI added the following:

“40. As regards the scale of the use made of the earlier trade mark, account must be taken of, inter alia, first, the commercial volume of all the acts of use and, second, the duration of the period over which the acts of use were carried out and the frequency of those acts (judgment of 14 December 2006 in Case T-392/04 *Gagliardi v OHIM – Norma Lebensmittelfilialbetrieb (MANÛ MANU MANU)*, not published in the ECR, paragraph 82).

41. To examine whether an earlier trade mark has been put to genuine use in a particular case, an overall assessment must be carried out, taking account of all the relevant factors in the case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court of Justice has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as

warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark (order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21; *LA MER*, cited in paragraph 32 above, paragraph 57; see, by way of analogy, *Ansul*, cited in paragraph 21 above, paragraph 39).

42. ...

43. The Court of Justice also added, in paragraph 72 of its judgment in Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, that it was not possible to determine *a priori* and in the abstract what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down. Thus, in that judgment, the Court held that, when it serves a real commercial purpose, even minimal use of the trade mark can be sufficient to establish genuine use.”

58. I see nothing in these statements to tell me that the CFI was about to apply any different understanding as to the meaning of genuine use from that which the Court of Appeal had in *LABORATOIRE DE LE MER*. But there then came the following passages:

“42. However, the more limited the volume of sales of items bearing the mark, the more necessary will it be for the party opposing new registration to produce additional evidence to dispel possible doubts as to the genuineness of the use of the mark in question (*HIPOVITON*, cited in paragraph 31 above, paragraph 37).

And

44. The Court of First Instance has held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*HIWATT*, cited in paragraph 35 above, paragraph 47, and Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 28).

59. These latter passages reinforce the points that I have raised above as to the evidential requirements imposed on the proprietor under the Regulation and IR. Bearing those requirements in mind, it does not appear to me that anything that followed in the CFI's analysis was inconsistent with the guidance from the ECJ. It did not impose a pre-set minimum of use but took into account the actual use that had been demonstrated (under the applicable rules of evidence), including its scale and frequency, the nature of the products and the structure of the market concerned.

54. Whilst the opponent has shown sales of some of the relevant goods, namely rusk breads, within the UK during the relevant period of time, the evidence only shows the mark, as it is relied upon, in three photographs from exhibit ZDA3. Two of those images are in the Turkish language and two of them are not dated. The image that is dated shows a date outside the relevant period. Whilst that date may indicate a sell by/use by date, i.e. a date for the future, the product concerned is a type of bread or rusk and the date shown is some 5 months outside the relevant period. It is likely therefore that the good on show in that image was manufactured and date stamped later than 30 November 2017, which is the end of the relevant period.

55. The sales figures over the relevant period are very small when considering the size of the market for bread and biscuits, being goods of everyday consumption. There is a complete lack of marketing or promotional material and no explanation as to what has been done by the opponent to raise awareness of the brand in the UK.

56. The opponent has shown that it supplies goods to two companies in the UK, Tees Limited and EDA Quality Foods Limited. The evidence shows that, in turn, those two

customers have made sales of the opponent's goods to six other entities. All of these sales have taken place within a relatively short space of time, towards the end of the relevant period. The earliest sales invoice which contains any reference to the 'FORM' brand, provided by either EDA Quality Foods Limited or Tees Limited, shows sales of the opponent's goods including rusk breads, from EDA Quality Foods Ltd to New Foods of Liverpool Ltd on 24th October 2016. The other sales invoices that contain a reference to the 'FORM' brand are all dated 2017, many from the latter half of that year.

57. From the evidence before me, it is very difficult to determine what mark has been used in the market place during the relevant period. It is clear that the 'ETi' element in the earlier mark is the opponent company's house mark (comprising the first element of the company name) and that the word 'FORM' is a secondary mark used as the name of a specific type of bread or rusk.

58. I do not find that the opponent has provided solid and objective evidence of effective and sufficient use of the trade mark on the market concerned. Referring back to the comments of Mr Daniel Alexander, Q.C. set out in paragraph 25 above, I conclude that the evidence submitted by the opponent is not clear, precise, detailed or well-supported, but is insufficiently solid and does not prove genuine use of the mark relied upon.

59. Whilst it is clear that the opponent has made some sales of rusk bread in the UK, those sales have been very small in number and the scale and frequency of use of the mark cannot be said to offset that low volume of sales. In the alternative, the scale and frequency of use of the mark can also be said to be very limited. With an absolute lack of information as to marketing/promotional expenditure or activities intended to raise brand awareness, combined with the fact that there is just one single example, in English, of the mark as relied upon throughout the body of evidence, the opponent has not proven genuine use of the mark relied upon in this opposition.

60. In the event that I am found to be wrong on the finding that the evidence is insufficiently solid, I go on now to consider the question of variant use of the mark being relied upon.

61. As I have found above, there is very little evidence showing the mark relied upon. The textual elements 'ETi' and 'FORM' appear on invoices, check lists and packing certificates, and the detailed device element is displayed on some of the invoices, however the mark relied upon only appears in three photographs, two of those being undated and two being in Turkish, in exhibit ZDA3 of the evidence provided by the opponent.

62. When considering the question of variant use, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under s.46(2) of the Act, which is analogous to Section 6A(4)(a), in *Nirvana*³ as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

63. Although this case was decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered.

³ BL O/262/06

64. The earlier mark relied upon is the composite mark below:



65. I find that the mark relied upon has not been shown sufficiently in use by the opponent. The marks shown to be used in trade by the opponent, are variations of the registered mark which in my opinion would have a significant impact on the average consumer. I find the marks that have been shown in use are variations that do alter the distinctive character found in that composite mark.

66. The evidence shows that the opponent uses the word 'FORM' without the figurative elements in the registered earlier mark, as part of product codes on invoices, check lists and packing/weight sheets. The opponent also uses the figurative elements and the letters 'ETi' together, without the word 'FORM'. Within exhibit ZDA2 there are no examples at all of the earlier mark as registered. In ZDA3 there are three examples of the mark incorporating both the 'ETi' verbal element and the word 'FORM', but this very limited, undated evidence, in which two of the three photographs are in Turkish, is not sufficient to satisfy me that the opponent has proven genuine use of its mark during the relevant period of time.

67. Accordingly, I find that there has been no genuine use of the opponent's earlier mark during the relevant period

Conclusion

68. The opponent has failed to show that its earlier mark has been used in the market place as registered. As such, the opponent is not entitled to rely upon its earlier

mark, which means that the opposition fails. Subject to appeal, the applied for mark may proceed to registration.

Costs

69. The applicant has been successful and is entitled to a contribution towards its costs. I award Find Form Ltd the sum of £500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing the statement of case and considering the counterstatement	£200
Preparing written submissions and considering the opponents evidence and written submissions	£300
Total	£500

70. I therefore order Eti Gida Sanayi Ve Ticaret Anonim Sirketi to pay Find Form Ltd the sum of £500. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 28th day of May 2019

**Andrew Feldon
For the Registrar
The Comptroller-General**