

O/483/20

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 502783**

**TO REVOKE ON THE GROUNDS OF NON-USE
TRADE MARK REGISTRATION
NO. 1396236**

OF THE MARK:

TRUE TO NATURE

OWNED BY

ALEXANDER ROSS HOLDINGS LIMITED

BACKGROUND AND PLEADINGS

1. These proceedings concern the trade mark TRUE TO NATURE which was filed on 26 August 1989 and entered in the register on 17 May 1991. The trade mark is registered in the name of Alexander Ross Holdings Limited (“the proprietor”) in respect of the following goods:

Class 3: Soaps, perfumes; deodorants for use on the person; anti-perspirants; fragrant preparations for use in room fragrancing purposes; essential oils; cosmetics; preparations for the hair; non-medicated toilet preparations; preparations for use immediately before and immediately after shaving; all included in Class 3.

2. It is a condition of the registration that the trade mark shall be used only in connection with goods made from natural ingredients.
3. On 30 August 2019, The Burt’s Bees Products Company (“the applicant”) applied for the revocation in full of the above trade mark, relying on section 46(1)(b) of the Trade Marks Act 1994 (“the Act”). The period during which the applicant alleges non-use of the trade mark is 30 August 2014 to 29 August 2019 (“the relevant period”), with revocation sought from 30 August 2019, being the date of the application. In its application, the applicant states that:

“the Contested Mark has not been put to genuine use in the United Kingdom within the relevant five year period (set out below) and there are no proper reasons for non-use. Thus, the registration should be revoked on the ground of non-use under the provisions of Section 46(1)(b) of the Trade Marks Act 1994 (the "Act").

[...]

The Revocation Applicant requests that the Contested Mark be revoked in its entirety on the grounds of non-use under Section 46(1)(b) of the Act.”

4. The proprietor filed a counterstatement defending its trade mark for all goods for which it is registered.
5. The applicant is represented by HGF Limited and the proprietor is represented by Murgitroyd & Company. Only the proprietor has filed evidence. Neither party requested a hearing. Both parties have filed written submissions in lieu of a hearing. I have taken these into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE

7. The proprietor filed evidence in the form of the witness statement of Derek Blair Ross dated 24 January 2020, which is accompanied by 3 exhibits. Mr Ross is the director of the proprietor, a position he has held since its incorporation in 1987. I have read Mr Ross's evidence in its entirety and have summarised the more pertinent points below.
8. The proprietor was established in 1987 and is a family owned trading group that comprises of three companies. One of the companies is Scottish Fine Soaps Limited T/A The Scottish Fine Soaps Company ("SFS"). SFS creates luxury and bathroom beauty collections that are sold in over 30 countries worldwide. Mr Ross is also a director of SFS and has been since 1995. While the proprietor owns the trade mark subject to this application, its use is by SFS with the proprietor's consent.
9. Mr Ross states that the mark has been used by SFS in relation to non-medicated toilet preparations and candles, since at least 1989. The evidence contains examples of recent packaging of various products that all bear the mark. The examples show the mark on products such as soap, facial cleanser, moisturiser, hand and nail cream, body wash, bath therapy, body fudge, scented candles and body lotion.¹ These examples are undated.

¹ Exhibit DR1

10. Mr Ross explains that products displaying the mark have been sold on SFS's website, in retail outlets, in SFS's own factory outlet and online via amazon. Mr Ross exhibits a number of print outs of products displaying the mark from www.amazon.co.uk.² These print outs also include customer reviews that Mr Ross states were made following purchases of the products in 2014. I note the following:

- a. The printouts show five different type of products bearing the mark, being soap, body fudge, body lotion, facial cleanser and hand and nail cream. All products are listed as currently unavailable;
- b. Across the five products there are a total of 7 reviews, 5 of which are 'verified purchases'. The reviews are dated, with the earliest review being 1 December 2009 and the latest being 20 February 2014. All of these are outside the relevant period; and
- c. The print outs all have a print date of 23 January 2020, which is outside the relevant period.

11. Mr Ross states that more recently, sales of products bearing the mark have been sold from SFS's factory outlet and website. In order to demonstrate this, Mr Ross has exhibited print outs of stock reports from SFS's records.³ Mr Ross explains that the records show the following:

- a. That 44 cases of 50 bottles of shampoo were made available for sale at SFS's outlet on 8 December 2014 and that, by 22 November 2017, the amount available was 20 cases of 50 bottles, which were then all sold by late 2019; and
- b. That 218 units of body fudge were available for sale on 7 January 2014, with 67 units still being available on 2 October 2014. Those 67 remaining units were sold between 2 October 2014 and 12 December 2015.

² Exhibit DR2

³ Exhibit DR3

12. I note that of the transactions within the 'body fudge' stock report, only four of them take place within the relevant period. These transactions account for 100 products.

13. While Mr Ross states that the TRUE TO NATURE brand is cyclical and not one of the ranges currently concentrated on, it remains an important part of the proprietor's portfolio of products. Further, the sales of products bearing the mark via SFS's outlet keep the brand in the minds of their customers.

PRELIMINARY ISSUE

14. I note that in its submissions, the proprietor has submitted that:

"9. Mr Ross' Statement and thus his word and his evidence, was not challenged by the Applicant in cross-examination, or even by way of filing contradicting evidence.

10. It is not open to the Applicant now to invite the Tribunal to disbelieve Mr Ross' evidence."

15. I note that, in its submissions, the applicant has stated that:

"it is clear that the evidence submitted by the Registered Proprietor is insufficient to establish genuine use of the Contested Mark during the Relevant Period.

It is also clear from the evidence that there has not been use of the mark and the Registered Proprietor is relying on very thin evidence to infer the possibility of use within the Relevant Period, which is not sufficient for the purposes of establishing genuine use."

16. For the avoidance of doubt, I am of the view that the applicant has not invited the Tribunal to disbelieve Mr Ross' evidence but instead, has raised issues with the sufficiency of the evidence provided, which it is entitled to do. This decision will be

made on balance of all the relevant factors and the weight of the evidence provided by the proprietor.

17. Further, I note that the applicant, through paragraphs 14 and 17 of its submissions has included information regarding its instruction of investigators to investigate the state of commercial use of the proprietor's mark in the marketplace. I consider this to be an attempt to introduce evidence of fact into these proceedings after the conclusion of the evidence rounds. Even if I were to have taken this into account, it would not have been decisive to the question of whether the registered proprietor had sufficiently demonstrated use of its trade mark.

DECISION

18. Section 46 of the Act states:

"46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a)

(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 (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the 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 existing at an earlier date, that date.”

19. 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.”

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and

frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.

22. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

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

to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

[...]

28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

23. In addition, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

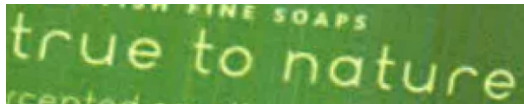
“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed

in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

24. While the mark is shown in evidence as it is registered (being a word only mark), the mark also appears (specifically in the examples of the mark displayed on products and on amazon.co.uk) in different shades of green, yellow or grey and in a slightly stylised lower-case font (reproduced below).



25. I note that the proprietor's mark is a word only mark and can be used in any standard typeface and registration in black and white will cover the use of the mark in different colours. Where a trade mark's use differs from its registered form, it will still be considered use upon which the proprietor may rely so long as it does not alter the distinctive character of the mark.⁴ In this case, I do not consider that the stylisation or use of colour alters the distinctive character of the proprietor's mark or detracts from the mark as registered and therefore this is an acceptable variation allowing for notional and fair use.

26. The proprietor's evidence does include examples of the mark on products and this is shown at Exhibit DR1 of the proprietor's evidence. These exhibits are undated, and the evidence does not explain when these examples were produced, only that they are 'samples of recent packaging'. However, I note that the proprietor's submissions state that the use shown is during the relevant period.

27. I have noted above that the amazon.co.uk print outs provided at Exhibit DR2 of the proprietor's evidence have a print date after the relevant date and that the products are shown as unavailable. Further, while there are a number of reviews for the products shown, they are dated outside the relevant period.

28. Moving on to the evidence regarding the stock reports exhibited at Exhibit DR3 of the proprietor's evidence, I note the applicant's submissions that state:

"whilst the Contested Mark features as a header for each table, very little information can be ascertained from the reports. For instance, there is nothing within the reports to link them to the Registered Proprietor's website, whatever this site may be. Mr Ross provides no explanation for the individual column headings (e.g. Lot, Reference, Batch, User) in the tables. Notably, some of the entries are marked as 'internal usage' or 'stock take' which is evidently not indicative of genuine use. There is absent any information that would suggest

⁴ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

sales have taken place, such as, customer information, order numbers, price, invoice numbers etc. Indeed, there is no contemporaneous evidence to show goods being sold, advertised, dispatched or used in any way. Whilst Mr Ross points to the descending volume of 'units', this does not amount to concrete, objective or verifiable evidence of sales and certainly does not establish that sales have taken place to UK customers."

29. I have considered both spreadsheets provided by the proprietor in detail and I note that they lack sufficient clarity. For example, the information in the 'reference column' of the spreadsheets is not clear and it is not obvious to me what is meant by 'Factory Shop' as it could be read as reflecting the movement of stock between the factory and the shop or other locations rather than evidence of actual sales to customers. However, I do accept that the evidence does corroborate the explanation given by Mr Ross at paragraph 6 of his witness statement (as outlined in paragraph 11 above). I note that some sales shown fall outside the relevant period and I will discuss this further below.

30. As I have set out above, there are two spreadsheets exhibited at Exhibit DR3. One in respect of the product 'True to Nature Body Fudge 200g' and the other in respect of 'True to Nature Shampoo 50x40ml'. I will deal with each in turn.

Body Fudge 200g

31. While the spreadsheet shows transactions involving 218 units of body fudge, only transactions involving 100 units fall within the relevant period. Of these, 97 contain the words 'Factory Shop' in the reference column. As the applicant has rightly pointed out, there is no explanation as to what the individual columns mean. However, in Mr Ross's statement, he describes these items as sold in the factory outlet. I also note that the remaining transactions have numbers in the reference column and as set out above, there is no explanation as to what this means. However, the content of Mr Ross's statement sets out that these are in relation to online sales. The issue with the online sales is that there is no evidence or explanation that suggests whether the website is a UK domain or that the buyer is located within the UK, therefore, it is unclear whether the goods were sold to UK

customers. Overall, I am of the view that the spreadsheet for 'Body Fudge 200g' demonstrates the sale of 97 products during the relevant period, but predominantly taking place during a one-month period.

50x40ml Shampoo

32. In respect of the '50x40ml Shampoo', the spreadsheet appears to show the lot quantity of the product go from 44 on 8 December 2014 to 20 on 22 November 2017. Mr Ross further explains that all 44 units of this product were sold between 8 December 2014 and late 2019. It is not clear what is meant by 'late 2019' and there is no information regarding this on the spreadsheets provided, with the last transaction taking place on 22 November 2017. I am of the view that, given the existence of these spreadsheets, information regarding sales during the relevant period would be readily available to the proprietor. As a result, I am only able to consider the evidence on what has been provided on the spreadsheet. From reviewing the information in Mr Ross's statement together with the spreadsheet, I am able to conclude that the proprietor has demonstrated, at its highest, the sale of 24 cases of 50 bottles of 40ml shampoo.

33. It is now necessary to determine whether the sale of 97 units of body fudge and 24 cases of 50 bottles of 40ml shampoo qualify as genuine use. I note that the use of the mark does not have to be quantitatively significant in order to prove genuine use, however, all the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark.

34. Of the use shown by the proprietor, I note the following:

- a. the market for goods at issue is significant;
- b. the nature of the goods at issue are that they will be purchased frequently by customers so the limited number of sales will be a factor that weighs against the proprietor;
- c. the frequency of sales of body fudge were limited to two transactions over a period of one month with the most recent transaction being 2 October

2014. As for the sales of shampoo, these were spread out over 7 transactions over 3 years, with the most recent transaction being 22 November 2017. The scale and frequency of use of the mark is, therefore, limited;

d. the use shown only relates to two types of toiletry products namely body fudge and shampoo so does not cover all the goods for which the mark is registered; and

e. given that there is no evidence of any online sales within the United Kingdom, the only sales of goods bearing the proprietor's mark that I can categorically point to within the evidence appear to originate from one location, being the factory shop which, as the proprietor has submitted, is located in Carronshore, Falkirk, Scotland. As a result, I am of the view that the territorial use of the mark is limited.

35. An assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁵

36. I have set out above that the photos of the products provided in Mr Ross's statement are undated. It is unclear whether these are from within the relevant period or not. Even if these were taken within the relevant period, I do not consider it enough to prove genuine use, either by itself or taking it into account on a global assessment. Further, the amazon.co.uk print outs and the amazon.co.uk 'verified purchase' reviews fall outside the relevant period. Therefore, these do not assist the proprietor. In any event, I do not consider that the evidence of five 'verified purchases' over a five-year period would have been sufficient to show genuine use either by itself or taking it into account on a global assessment.

37. Taking all of the above factors into account, and reminding myself that I must consider the evidential picture as a whole I do not consider that the sale of 121 units over 9 transactions from one location in what is a significant market is enough

⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

to prove genuine use of the proprietor's mark. This is particularly the case given that the majority of the sales took place at the beginning of the relevant period. The proprietor has, therefore, failed to satisfy the requirement for genuine use of its mark. The consequence of which is that the application for revocation succeeds in full.

CONCLUSION

38. The application for revocation has succeeded and, subject to any successful appeal, the proprietor's trade mark will be revoked with effect from 30 August 2019.

COSTS

39. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £700 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a revocation application and considering the proprietor's counterstatement:	£200
Preparing written submissions in lieu:	£300
Official fee:	£200
Total:	£700

40. I therefore order Alexander Ross Holdings Limited to pay The Burt's Bees Products Company the sum of £700. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of September 2020

A COOPER
For the Registrar