

O-140-21

TRADE MARKS ACT 1994

IN THE MATTER OF
UK TRADE MARK No. 1320799:

McGeorge OF SCOTLAND

REGISTERED IN CLASS 25
IN THE NAME OF J & D McGEORGE LIMITED

AND

APPLICATION No. CA502564 BY WALMART APOLLO, LLC TO REVOKE
ON THE GROUNDS OF NON-USE

BACKGROUND AND PLEADINGS

1. J&D McGeorge Limited (“**the Proprietor**”)¹ is the registered proprietor of UK trade mark registration no. 1320799 (“**the Registration**”) registered on 26 February 1990 for

The logo for McGeorge OF SCOTLAND features the name 'McGeorge' in a large, elegant, cursive script. Above the 'e' in 'George', the words 'OF SCOTLAND' are written in a smaller, plain, uppercase font.

, specified for the following goods in Class 25:

Knitted articles of clothing included in Class 25; all manufactured in Scotland.

2. On 12 April 2019,² Walmart Apollo LLC (“**the Applicant**”) applied to revoke the Registration under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“**the Act**”). The Applicant alleges non-use of the Registration during the following periods:

Period No.	Start Date	End Date
1	27/02/1990	26/02/1995
Period 1 is invoked under section 46(1)(a), being the five-year period following registration of the Proprietor’s contested trade mark.		
2	27/02/1995	26/02/2000
3	12/04/2014	11/04/2019
4	12/01/2014	11/01/2019
Periods 2, 3 and 4 are invoked under section 46(1)(b), during which five-year periods it is claimed that use has been suspended with no proper reason.		

3. The Proprietor filed a notice of defence denying the claims under both grounds. Its counterstatement indicated the Proprietor’s intention to submit evidence to show “*significant use*” and “*real commercial exploitation of the mark*”. It also quoted from case law, stating that the purpose of the provisions requiring that a registered mark must have been genuinely used is “*not to assess commercial success or reputation or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to*

¹ A number of corporate players feature in the associated history of this trade mark registration, several of whose names included the word ‘McGeorge’ – for the avoidance of confusion, it should be noted that the Proprietor in these proceedings is J&D McGeorge Limited with the Scottish Company number SC524907.

² With minor amendment on 24 April 2019.

*the case where large-scale commercial use has been made of the mark.*³ During the evidence rounds both parties filed evidence and submissions, which I describe and reference in this decision to the extent that I consider warranted.

4. Trademark Eagle Limited acted as attorneys for the Proprietor, who requested an oral hearing, which took place before me by video conference on 15 December 2020; Chris Hoole of Appleyard Lees IP LLP attended on behalf of the Applicant and Denise McFarland of counsel attended for the Proprietor.⁴ Both parties filed skeleton arguments. I have read all the papers filed.

APPLICABLE LEGISLATIVE PROVISIONS

5. Section 46 of the Act deals with revocation. The following extracts reflect the statutory law at the time when these proceedings were commenced.
6. The relevant provisions are:

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

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

....

(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 in 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.

3 (08 /07/2004 T-203/02, Vitafruit, EU:T2004:225, § 38).

4 David Moy and Christopher Thomas, of Appleyard Lees IP LLP, and Rosario Valdez-Knight and Jeanette Wood, of Trademark Eagle Limited, also attended the hearing.

(4) [...]

(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.

7. Section 100 of the Act is also relevant and 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.*” It is therefore plain that in defence of this revocation action the burden of proof falls on the Proprietor to show genuine use of its registered trade mark.

CASE LAW ON GENUINE USE

8. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use, based on rulings of the Court of Justice of the European Union (“**the CJEU**”), 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 Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, 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].”

PROBATIVE CONSIDERATIONS

9. In making my determination as to whether the evidence presented shows the necessary genuine use, I also take account of judicial comment as to probative and evidential issues in such cases. In *Awareness Limited v Plymouth City Council*⁵, Daniel Alexander Q.C. sitting 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

5 Case BL O/230/13

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.”

10. In *Dosenbach-Ochsner*⁶, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person stated that:

“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.”

THE RELEVANT PERIODS

11. The Applicant has challenged the Proprietor to show genuine use of the contested Registration in the course of several five-year periods, as detailed in the background and pleadings (paragraph 2 above). **Periods 1 and 2** cover the decade immediately following the date of registration, and, taken together, may be considered “**the earlier periods**”, and as essentially covering **March 1990 – February 2000**.
12. Periods 3 and 4 substantially overlap one another and together cover a period of five years and three months, up to the date on which the Applicant filed its application to revoke. **Periods 3 and 4**, taken together, may be considered “**the later periods**” covering **12 January 2014 – 11 April 2019**.

6 *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13

EVIDENCE (OUTLINE)

13. The materials filed during the evidence rounds ran to several hundred pages and comprised the following:

Proprietor's evidence of use

- **(First) Witness Statement of Lorenzo Borre**, dated 19 September 2019 - together with **Exhibits LB1 - LB59**. (Exhibit LB28A is the **Witness Statement of Dr Emanuela Saba**, dated 18 September 2019)

The registry granted a **confidentiality order** dated 22 January 2020 in relation to **Exhibits LB11, LB12, LB19, LB20 and LB21**. That order remains in place, and to the extent that this decision refers to evidence from the contents of those exhibits, it shall be redacted.

- **Witness Statement of James Carrie**, dated 12 September 2019 together with **Exhibits JC1 – JC6**
- **Witness Statement of Arthur Rennie**, dated 17 September 2019 together with **Exhibits AR1 – AR3⁷**

Applicant's evidence and submissions

- **Written submissions** dated 23 March 2020, challenging the sufficiency of the evidence filed by the Proprietor.
- **Witness Statement of Christopher James Hoole** dated 23 March 2020 with Annexes 1 and 2

Registered Proprietor's evidence and submissions in reply

- **Proprietor's observations in reply**
- **Second Witness Statement of Lorenzo Borre**, dated 23 September 2020 (herein "**WS2LB**") together with **Exhibits LB(2)(1) – LB(2)(8)**, including:
- **Witness Statement of Stuart Maxwell**, dated 17 September 2020)⁸

7 (There was an error in the referencing: whereas the witness statement refers to Exhibits AR1, AR2 and AR3, those three were in fact combined as a single Exhibit AR3. And whereas the witness statement refers to Exhibits AR4 and AR5, those were filed as AR1 and AR2. The Proprietor's representatives had highlighted the error in its correspondence dated 10 October 2019; the corrected witness statement was not before me, but I interpret the evidence in light of the clarification.)

8 Filed as Exhibit LB(2)(1) to the second Witness Statement of Lorenzo Borre.

- **Witness Statement of Simone Castronovo**, dated 17 September 2020⁹

CHAIN OF OWNERSHIP OF THE CONTESTED REGISTRATION

14. The first witness statement of Dr Lorenzo Borre includes an account of the history of the proprietorship of the Registration. Ms McFarland described the history as “somewhat complex”, but noted that there was no challenge to the account. Indeed, I note that the attorneys for the Applicant set out its understanding of the chain in their skeleton argument, and although they highlighted a few ruts in the path, the legitimacy of the chain of ownership does not appear at issue in these proceedings. The purpose of my outline below is largely to introduce and contextualise various players relevant to or referenced in the account of genuine use.
15. **Ownership in the later periods (12 January 2014 – 11 April 2019):** The current Proprietor of the contested registration is J&D McGeorge Limited, a Scottish Company (SC524907) incorporated on 22 January 2016.¹⁰ Lorenzo Borre is the CEO of the Proprietor.
16. The current Proprietor company has owned the contested registration since 20 April 2016, when it acquired the trade mark from a company registered in England and Wales under number OC385731 (herein “**McGeorge LLP**”).¹¹ **Exhibit LB01** is an extract from Companies House register, which shows that McGeorge LLP was incorporated on 11 June 2013, filed dormant accounts on 30 June 2016 and was dissolved on 9 May 2017. (The significance of company dormancy was one of the issues aired at the hearing and I’ll return to it.)
17. Dr Borre states at paragraph 3 of his first witness statement that it was he who incorporated McGeorge LLP. McGeorge LLP acquired the contested trade mark registration on **6 March 2014, (a couple of months into the later periods)**, albeit along with other McGeorge of Scotland trade marks.

⁹ Filed as Exhibit LB(2)(8) to the second Witness Statement of Lorenzo Borre

¹⁰ Exhibit LB09

¹¹ Exhibit LB17 - Company OC385731 started as J.&D. MC. GEORGE LLP, but changed its name to St Michael Mill's Investment LLP on 25 January 2016

18. **Ownership in the earlier period (March 1990 – February 2000):** The contested trade mark registration was first registered in February 1990, originally in the name of J&D McGeorge Limited (“**McGeorge Ltd #1**”), a Scottish Company registered under number SC027103 (now dissolved).¹² **Exhibit LB13** exemplifies one of the ruts mentioned above: it shows an assignment with an effective date given as 3 January 1998, but which was not executed until 28 November 2000 (nearly three years later). Exhibit LB13 shows the assignment to transfer half a dozen trade marks from McGeorge Ltd #1 to **Dawson International Holdings (UK) Ltd** (SCO54674). That assignment does not feature in the trade mark register, which records the Registration as having transferred to Dawson International Holdings (UK) Ltd only for a couple of weeks in 2006. However, there is nothing in the Act that requires the recordal of such assignments. Put broadly, **during the earlier period**, the contested trade mark registration was largely in the hands of **McGeorge Ltd #1** or latterly in the hands of **Dawson**.

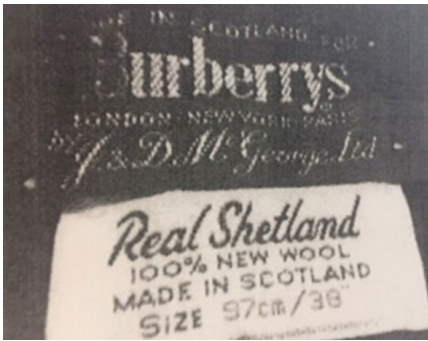
EVIDENCE RELATING TO THE EARLIER PERIOD (March 1990–February 2000)

19. The main witness on behalf of the Proprietor is Dr Borre, who has produced two witness statements, with over 60 exhibits. Dr Borre had no direct involvement with McGeorge in the earlier periods. However, in his first witness statement he refers to and exhibits various contemporaneous materials and public records, and includes signed witness statements from others who *were* personally involved at the relevant time (i.e: Mr Carrie and Mr Rennie, described below).

Co-branding in the late 1980s

20. At paragraph 14 of his witness statement, I understand Dr Borre to be saying that in the 1980s McGeorge Ltd #1 was co-branding for Harrods and Burberrys. **Exhibit LB06** shows what appear to be labels on pullovers, which include those brand names, along with the name of the knitwear company. For example:

¹² Exhibit LB18. (Exhibit LB04 provides evidence as to that company, including that it was incorporated in 1949; despite the identical name it is of course an entity quite separate from the current Proprietor.)



21. In my view the Harrods and Burberrys label images are not use of the mark as registered (nor, to be clear, is that claimed as such by Dr Borre) – they show the words “made in Scotland ...by J & D McGeorge Ltd; the words are in cursive script similar to, but not identical to that used in the contested registration. The used mark does not include the mark as registered,¹³ and the use of J.D. McGeorge Ltd is use of a company name with elements added (J.D...) and omitted (“of Scotland”), which together alter the distinctive character of the mark compared to the form in which it is registered.
22. Also at paragraph 14 of his witness statement, I understand Dr Borre to be saying that there was co-branding of McGeorge of Scotland with Simpsons of Piccadilly “which took place around 2008”. Exhibit LB06 also includes the following image:



Although this image does feature the contested trade mark, it also strikes me that Dr Borre’s reference to 2008 must surely be wrong. The statement is made amidst surrounding references to the 1980s and it seems more likely (in the context of other evidence) that the image of the Simpson Piccadilly label dates from around that time.

23. Centrally, I note of course that the evidence relating to the 1980s predates any of the relevant periods and so has no direct bearing on the issue of proof of use underpinning this decision (nor indeed would evidence from 2008). The reason for my referring to this

¹³ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

evidence is that it helps illuminate references elsewhere in the evidence to the concept and practice of secondary labelling.

Turnover for the earlier period

24. At paragraph 22 of his first witness statement Dr Borre, presents a table showing turnover from March 1990 – March 1992 relating to the Scottish company producing the knitwear goods; those turnover figures are drawn from **Exhibits LB22A – LB24**. For example, **Exhibit LB23** shows an independent audit report in relation to McGeorge Ltd #1 for the 12 months up to 31 March 1991, which identifies the principal activity of the company as the manufacture of knitted outerwear and where a net profit of over £150,000 is shown, based on a turnover of over £7.5 million. **Exhibit LB24** shows a subsequent independent audit report in relation to McGeorge Ltd #1 for the 12 months up to 31 March 1992. This report includes a review of the business which states: *“Trading continues to be difficult. The company’s product ranges have been repositioned to focus on its strength in its key markets. On 2 November 1991 the manufacturing business of McGeorge was transferred to Dawson International Sports and Leisurewear whilst McGeorge continues to sell under its own brand.”* Page 8 of the exhibit appears to show that in 1992 the company’s turnover in the UK was over £790,000.

Evidence of James Carrie

25. Dr Borre also refers to and exhibits a witness statement of James Carrie, dated 12 September 2019. Mr Carrie gives evidence for these proceedings based on his personal involvement in the businesses that at that time sold the McGeorge of Scotland goods. Mr Carrie was, from 1991, the financial director for the Dawson businesses whose consolidated knitwear businesses included McGeorge of Scotland and he was appointed a director of McGeorge Ltd #1 on 27 November 1992.
26. He states that McGeorge of Scotland products were originally manufactured in a factory in Dumfries, Scotland, with occasional use of Scotland-based subcontractors at peak times. As part of a restructuring by Dawson, production of McGeorge of Scotland goods subsequently moved to Hawick, and the Dumfries factory closed.

27. He states that the advertising budget for McGeorge of Scotland was mainly spent on various trade shows / exhibitions, which were the main form of advertising for most knitters that time. He recalls that these trade shows cost around £5000 - £8000 annually.
28. He states that the goods sold under the registration were knitted goods including jumpers, cardigans, waistcoats, gloves and hats. He expressly confirms that all McGeorge of Scotland products were manufactured in Scotland and states that the main markets were the UK, Europe, USA and Japan. He states that garment labels were mainly the stylised McGeorge of Scotland logo that is the challenged trade mark, but highlights that other different versions were also registered as trade marks.
29. He refers to various knitwear brands falling under the amalgamated interests Dawson, including Barrie (which itself covered Chanel and Hermes) and Pringle, as well as McGeorge of Scotland, and that some time after 1993 (it is not entirely clear when) priority was given to Pringle and others, with McGeorge of Scotland becoming “secondary labels”.
30. Mr Carrie also provides **Exhibits JC1 – JC6**, which are the accounts filed at Companies House for McGeorge Ltd #1, which he is shown to have personally signed off. Although those exhibits include statements to the effect that the company made neither a profit nor loss in the relevant years (e.g. 1995 under Exhibit JD4, and 1996 under Exhibit JD5), the annual turnover figures for the company from 1993 – 1996 from the sale of knitwear ranges from over £2million to over £4 million, and even by 1997/1998 turnover was between nearly £500,000 - 750,000 annually. He states that from memory he believes that sales of McGeorge of Scotland goods probably dropped to £50,000 pounds in the year 2000 as a consequence of non-investment in this business in favour of Barrie. Mr Carrie does not recall how many units of knitwear were sold for the years 1993 – 2000, but states that the volume would have been significant given the turnovers set out in the accounts.

Evidence of Arthur Rennie

31. Dr Borre also refers to and exhibits a witness statement of Arthur Rennie, dated 17 September 2019. Mr Rennie worked in a range of roles at McGeorge Ltd #1 during the earlier period, and from February 1993 to June 1998 worked for Dawson International

United Brands in Hawick, whose brands included McGeorge of Scotland, and where his role included purchasing apparel, customer and agent liaison and sales order processing.

32. Mr Rennie refers to an investment of over £5 million pounds in a brand new factory and in state of the art electronic knitting machines. This accords with **Exhibit LB08** - an article from the Glasgow Herald business section from February 1986 headlined "Dawson's McGeorge unveils expansion" describing investment by "*J and D McGeorge of Dumfries millions of pounds in expanding knitwear manufacture over the next five years, with new technology and factory development creating over 140 jobs.*"
33. Mr Rennie states that the new factory was fully operational by early 1988 employing 400 people. Mr Rennie states that "it was around this time that things started to go wrong" for both McGeorge and Dawsons for various commercial reasons. He states that as sales volume, value and profitability faltered, McGeorge started manufacturing product for Pringle, which was an expanding sister company in the Dawson group. "*The McGeorge Administration was made redundant and the McGeorge selling function relocated to Pringle HQ in Hawick ... starved of resource McGeorge was side-lined into what was effectively a second label business*".
34. He states that although McGeorge of Scotland eventually became a second label of Barrie and Glenmac within the Dawson group "there was a loyal independent agent base, customer (retailer) base and ongoing consumer demand for the McGeorge brand." He states that following further reorganisation at Dawson in 1998, the reducing sales of McGeorge of Scotland were not even reported separately but merely lumped together as 'second label / others'" but that there were, however, still sales of knitwear manufactured in Scotland and branded McGeorge of Scotland.
35. Mr Rennie provides and explains sales figures by country of the brand McGeorge within the period 1990 – 1997; this includes sales in the UK but also exports to Europe and elsewhere in the world. **Exhibit AR3** (as originally filed – see footnote 7 above) is a little difficult to follow, but includes printouts from a spreadsheet, with various columns blacked out in redaction, but which Mr Rennie explains shows the levels of orders relating to the years 1992, 1993, 1994, 1995, 1996 and 1997, where McGeorge unit sales were over 74,000 for Autumn 1992, declining to 11,569 for the Autumn season of 1996 and over 4000 units for Summer 1997.

36. **Exhibits AR1** and **AR2** show contemporaneous memo responses from Mr Rennie, relating to sales forecasts.¹⁴ The memos are dated 25 April 1997 and 27 September 1997 and headed “Barrie Knitwear” (a sister brand within Dawson which Mr Rennie’s role covered), but the memos identify that the extracts refer to “MC” for McGeorge sales which are characterised as “cust” or “second”. I note the abbreviation “cust” is referenced in a column alongside Simpson (Piccadilly) Ltd, Scotch House, and Brook Brothers. The memo states that “non-customer McGeorge sales are classed as second label”. Mr Rennie states that second label sales may cover instances where the McGeorge company sells goods that are “supplied without the McGeorge label, so could either be a secondary label owned by the McGeorge company or a customer’s own label”. Mr Rennie confirms that “the style of the brand used within the relevant period” (the earlier period) conformed to that of the contested mark.

My findings as to the earlier period

37. At paragraph 20 of his first witness statement Dr Borre points out that the earlier period covers a time before his companies owned the contested trade mark registration and that the company that owned the Registration originally no longer exists. He comments that as such it is impossible to provide the level of detailed evidence of use that he would like to in relation to that earlier period. I acknowledge those facts and take them into account in my assessment of the evidence filed in relation to the earlier period. I also take into account that, during the evidence rounds, the submissions filed on behalf of the Applicant focussed only on the later periods and made no specific criticism of the filed evidence in relation to the earlier periods.

38. I find that the evidence I have considered above is not entirely clear as to the extent to which turnover is attributable to use of the contested registration - as opposed to potentially other trade marks; the clarity of that attribution is further impaired by the references to customer labels and secondary labelling. However, the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, ruled that “*the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark*” and that “... a registered trade

¹⁴ As previously noted, the witness statement before me misaligned to refer to AR4 and AR5.

*mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' ...".*¹⁵ I note that the evidence from the earlier period includes issues of co-branding; in my view co-branding such as that shown in relation to Simpson Piccadilly falls within the scope of the wording of *Colloseum*.

39. Taken as a whole the evidence for the earlier period provides a consistent narrative account of the McGeorge business engaged in manufacturing knitwear in Scotland, applying the label featuring the contested trade mark and selling the goods to customers not only overseas, but also in the UK. Although the earlier period covers a declining commercial output and profile for the brand, the statements of the witnesses, based on their first-hand knowledge, indicate use on some scale across both periods 1 and 2, which is supported by corroborative evidence of turnover. Although not shown as such, the range of goods is stated to have covered a number of forms of knitwear, and I am satisfied that the evidence is enough to establish genuine use of the mark in the UK in relation to a range of knitwear goods manufactured in Scotland and to defeat the revocation claims for periods 1 and 2.

EVIDENCE RELATING TO THE LATER PERIOD

From the first witness statement of Lorenzo Borre and its 59 exhibits

Company structure

40. At Section C of his first witness statement Dr Borre describes the structure of his related companies. He gives the Proprietor's registered address in Glasgow and its trading address in Hawick, which is to say, both in Scotland. He states that Proprietor serves as the **holding company** for the relevant intellectual property rights and that it licenses use of the contested registration.
41. It will be recalled that in the initial part of the later period, the contested trade mark registration was owned by another of Dr Borre's incorporations - McGeorge LLP. Dr Borre states that that UK company (McGeorge LLP) was 100% owned by a Cypriot company, called 1881 J.&D. McGeorge Ltd (herein "**Cyprus 1881**")¹⁶ and that between 2013 – 2016

¹⁵ Case C-12/12, at paragraphs 32 and 35.

¹⁶ Exhibit LB10 shows the company information certificate for a Cypriot company of that name, under company number HE313839.

goods were sold under the Registration by **Cyprus 1881**, with the consent of the UK proprietor (then McGeorge LLP).

42. Dr Borre states that the Proprietor later granted a formal written licence to **Cyprus 1881** on 11 April 2016 and that following termination of that licence (also in 2016), a second formal written licence, dated January 2018, was granted to another Cyprus-incorporated company (Company number HE377422) which has a name that is identical to that of the Proprietor, namely J & D McGeorge Limited (herein "**Cyprus McGeorge**"). Together, Dr Borre refers to Cyprus 1881 and Cyprus McGeorge as "**the Licensees**". Dr Borre states that the licences were non-exclusive, permitting use of trade marks that include the contested trade mark "on or in association with the Licensed Products, as well as on packaging and promotional and advertising material." The redacted licence agreements were filed as **Exhibits LB11** and **LB12** and their contents fall under the confidentiality order mentioned previously. To the extent that in this decision I refer to the contents of those (or other confidential exhibits) such passages shall be duly redacted.
43. Dr Borre states that the Licensees are the **trading arms** which use the Registration, but that under the terms of the licence agreements [xxxx text redacted xxxx].¹⁷

My observations on the confidential licences

[xxxx text redacted xxxx]

Route to market

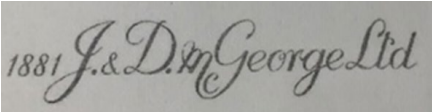
44. In the final paragraph of section C and at **paragraph 19 of his first witness statement** of his witness statement Dr Borre explains the route to market. He states that the goods under the Registration are all manufactured in Scotland, and include clothing such as sweaters, pullovers, cardigans, scarves, gloves and headwear. He states that the Proprietor sells through "Agents", who act as intermediaries arranging the sale of the McGeorge of Scotland goods to high end shops and boutiques in the EU and elsewhere. He references the three other confidential exhibits (**Exhibits 19, 20 and 21**) which he states are examples of Agents' agreements with the Proprietor relating to sale of goods under the registration. That is not precisely accurate, since I note that those confidential

¹⁷ LB11 – clause 10; Exhibit LB12 Clause 3

exhibits are in fact agreements entered into not by the Proprietor, but by the Licensees (Cyprus 1881 and Cyprus McGeorge). The contents of those Agreements are subject to the confidentiality order, but their existence is not confidential and I note that in his witness statement Dr Borre openly identifies that those examples are for agreements in Austria and Italy for years **2014, 2017 and 2018**. [xxxx text redacted xxxx]. He yet again states that “all goods sold under the Registration are manufactured in Scotland and from there shipped to the *Licensees in Cyprus who prepare the goods for onward transit* to customers in the UK or other jurisdictions in the EU.”

Evidence of sales and promotion

45. Dr Borre gives, at section H of his first witness statement, “the number of items of goods that were branded with the registration which were manufactured in Scotland and sold under the licence by the licensees” for each of the years 2014 – 2019. These range, for example, from over 2400 in 2014 to nearly 5300 in 2016 and over 3800 in 2018.¹⁸ Dr Borre states the average price for each item to be around 130 pounds. Turnover figures are also given for each of the years 2014 -2019, which range from over 300,000 Euros (2014) to nearly 690,000 Euros (2016) and nearly 500,000 Euros in 2018. These figures are corroborated by the witness statement of Dr Emanuela Saba, who provides accountancy services for the Licensees (Cyprus1881 and “Cyprus McGeorge”), who also states that the sales “relate to knitwear sold under McGeorge of Scotland”.¹⁹
46. In further support of the turnover figures Dr Borre provides **Exhibit LB29**, which he describes as “sample invoices of sales made.” Exhibit LB29 comprises 47 pages of individual invoices, which are numbered LB23A – Z (*sic*), then LB23AA and so on. Most

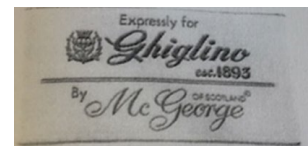
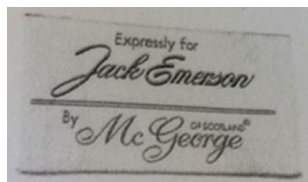
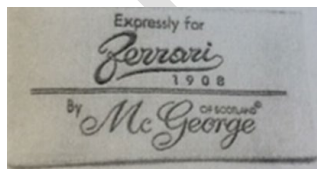
of invoices are headed:  (or similar, but without the “1881”) and show the Cyprus address of Cyprus McGeorge. Those invoices are from Cyprus McGeorge to clients in a range of countries including: Japan (e.g. LB23A, December 2014; LB23D, August 2015); Germany (e.g. LB23W, July 2017) and largely to Italy. The invoices are shown to be respect of goods such as “men’s turtle neck pullover” or “men’s shawl neck cardigan”. They do not show the branding of the goods, nor was I able readily

18 Paragraph 41 of his first witness statement.

19 Exhibit LB28A

to cross reference on the basis of product codes. However, I note that several of the invoices (e.g. LB23W – LB23AC) included the word “McGeorge” in brackets as part of the description in the invoice (e.g. LB23AA “LADY’S CARDIGAN (McGeorge)” September 2017).

47. Of the 47 invoices shown within Exhibit LB29 I noted only one that appeared to be sending knitwear to an address in the UK. That is **Exhibit LB23B**, which shows Cyprus 1881 to have sent ten cardigans and ten pullovers to a company address in Dumfries in July 2015. The 47 invoices also include a good number of invoices that are not for knitwear, but for delivery of wool yarn to Cyprus 1881.
48. At section H of his first witness statement Dr Borre gives the advertising expenditure in the UK for each of the years 2014 – 2019. For example, he gives figures of around 40,000 Euros in 2016, 2017 and 2018 on trade fairs and other advertising. No evidence is provided to corroborate that stated expenditure in or towards the UK, but Dr Borre refers at section K of his first witness statement to three short online articles from October 2016 - Fashion Network, The Scotsman and Scottish Enterprise.²⁰ The latter article is dated 12 October 2016 and refers to 1881 J&D McGeorge Limited having bought, with support from Scottish Borders Council and Scottish Development International, premises at Langlands Mill in Hawick with “plans to bring the building back to its original purpose as a textile mill commencing production and creating approximately 20 highly skilled knitting jobs in the Spring of 2017.”
49. Dr Borre states that his company also “makes bespoke products for some clients” some of which are co-branded.²¹ **Exhibit LB58** shows three such co-branded labels:



50. The Proprietor’s evidence in chief also referred to the registration of mcgeorgeofscotland.co.uk (“**the Website**”) - I’ll comment on that later in this decision. It also showed various images from look books for knitwear goods under the mark and

²⁰ (Exhibits LB38 2016– 40)

²¹ para xi Section L of his first witness statement

promotional stands in use in shops, for example showing Steve McQueen wearing a cable knit sweater in the 1968 film *The Thomas Crown Affair*.

Applicant's criticisms of the evidence

51. The Applicant used the evidence rounds to file submissions contesting the sufficiency and reliability of the Proprietor's evidence of use, as I summarise here. The only evidence on behalf of the Applicant is a witness statement by Mr Hoole, solicitor and attorney for the Applicant. His evidence exhibits Companies House documents establishing that the Proprietor and its predecessor are listed on the Companies House records as "dormant". The Applicant's submissions included:

- (i) That fundamental for a finding of genuine use is that there is use of the mark in the UK in the course of trade; and that since the Companies House evidence shows that the Proprietor and its predecessor have not traded at any time during the later periods there can be no use in the course of trade;
- (ii) That the accounting history (nil return) filed at Companies House is inconsistent with information given in [xxxx text redacted xxxx]. The Proprietor's evidence in chief did not explain the discrepancy;
- (iii) [xxxx redacted text xxxx];
- (iv) That the invoices in **Exhibit L29** show year on year shipments of wool to Cyprus, which suggests that the specified goods are not manufactured in Scotland, which is a requirement under the contested registration;
- (v) That there is no evidence of sales in the UK and that sales outside the UK are irrelevant;
- (vi) That the evidence does not explain the extent to which the Proprietor's brochures or the marketing materials were viewed or circulated; that there is no supporting evidence of advertising in the UK and the claimed expenditure is not reflected in the Companies House accounting history;
- (vii) That the evidence does not show how many independent third party views the Website generated during the later periods.

The Proprietor's evidence and submissions in reply

52. The Proprietor filed observations in reply and Dr Borre filed a second witness statement, including exhibits, featuring two other witness statements. I reference the Proprietor's points in reply as part of my findings below.

MY FINDINGS AS TO THE EARLIER PERIOD

Dormant status

53. I find that the fact that the records at Companies House show no trading activity by the Proprietor and its predecessor (McGeorge LLP) is not, as the Applicant argued, fatal to establishing use during the later period. That a company has filed dormant accounts is not a bar to it holding IP rights. The evidence is clear that the Proprietor is not a trading company; it serves as holding company that licenses to its associated companies use of the registered trade marks it owns.

Licence issues

54. **Exhibit LB2(8)** is a witness statement by **Simone Castronovo**, corporate legal and tax advisor to the Proprietor, who was personally involved in drafting the licence agreements. He points out the licence agreements are subject to Scots law, not English law, and states that Scots law does not require consideration for formation of a contract. He also submits that the licence fee clauses are not about income. He stated that since Lorenzo Borre owns both the Licensor and Licensees, it was open to Dr Borre to override any terms of a licence without written variation (including, presumably waiving or postponing payment of a fee) and it is similarly within his discretion to decide to how to allocate any income or whether to reinvest in the company structure as he deems convenient. I accept the Proprietor's position in that regard. I am satisfied that to the extent that there have been sales through the Licensees, use of the Registration has been with the consent of Proprietor or its predecessor and that consent operates irrespective of the existence of a formal written licence or permission. (As to whether any use with the Proprietor's consent has been in the UK is of course a separate question.)

Location of manufacture

55. In this case a crucial importance attaches to the location of the place of manufacture of the goods, since these are specified as limited to knitwear manufactured in Scotland.

Paragraph 10 of the skeleton argument filed on the part of the Proprietor referred to “the range of goods associated with the Registration and branding of McGeorge of Scotland have been Scottish goods, manufactured in Scotland and / or made of wools and yarns from Scotland” [my emphasis]. I do not accept that the relevant goods would include goods that are not manufactured in Scotland, even if it were the case that those goods were made from yarn that originated in Scotland. Such a circumstance would fail to meet the description of the goods as registered. However, that is not the position maintained by the Proprietor. At paragraph 13 of his second witness statement, Dr Borre explains that the Cyprus-based trading Licensee “*was responsible for the purchase of the raw material on the proprietor's indication of colours and materials, however, the finished product bearing the McGeorge of Scotland mark was made and manufactured in Scotland with the raw materials purchased by the Licensee ... in some cases the raw material was purchased and then sent back to Scottish suppliers for the manufacturing of knitwear products but above all it was sold to Italian customers who had difficulty buying the yarn from Scotland ...*”.

56. At paragraphs 8 and 9 of his second witness statement Dr Borre refers to his earlier witness statement, where under a statement of truth, he had repeatedly affirmed that the goods were manufactured in Scotland. By way of corroboration of his statements he enclosed a short witness statement of Stuart Maxwell, Director of Esk Knitwear Valley Co Ltd in Scotland.²² Mr Maxwell states as follows:

“We have been manufacturing knitwear for McGeorge of Scotland for knitwear branded McGeorge of Scotland since at least 2016 up to date for their knitwear collections.

We have supported McGeorge of Scotland's production process for some seasons for McGeorge of Scotland ..

We produce McGeorge of Scotland knitwear with the highest quality wool in Scotland from our mill.”

Exhibit LB(2)(2) shows an invoice dated 17 April 2018 from Esk to McGeorge Cyprus for 202 items of knitwear totalling nearly £7000.

57. Dr Borre states at paragraph 11 of his second witness statement that during the same period Hawick Knitwear Ltd was manufacturing knitwear for us up to 2018. No witness

²² Exhibit LB2(1)

statement or invoice evidence is provided in relation to Hawick Knitwear Ltd. There is also no further account of what became of the press-reported acquisition at Langlands Mill in Hawick.

58. I have noted a couple of aspects of the evidence in chief that raised questions about where the goods were made, and it is perhaps a little surprising that the corroborative evidence from Esk was furnished only in reply, especially as the turnover figures in the later periods involve hundreds of thousands of pounds annually, such that one would imagine the evidential trail may be readily and amply available. However, the Applicant made no request for cross-examination, which may have more fully answered any outstanding questions. And Dr Borre has provided a corroborative witness statement from Mr Maxwell and supportive invoice evidence. Mr Maxwell is also clear in his statement that the goods he manufactured were “*for knitwear branded McGeorge of Scotland*”. I am therefore satisfied that the evidence has shown that at least some of the contested goods were indeed manufactured in Scotland.

Use in the UK

59. The Applicant is of course correct in its submission that it is fundamental for a finding of genuine use there is use of the mark in the UK in the course of trade. However, the submission that since the Proprietor has itself not traded, there can be no genuine use is not correct. Genuine use clearly covers use not only by the Proprietor, but use with the consent of the Proprietor. Use by the Licensees could certainly therefore serve the purpose. I find that the evidence shows use of mark by virtue of the sales in Italy, Germany and elsewhere, along with some related promotional materials.
60. However, despite the associated turnover totaling hundreds of thousands of pounds, there is almost no evidence at all of sales or promotion *in the UK*. The Proprietor filed only the single invoice for goods sent to Scotland – the 20 items in **Exhibit LB23B** and that exhibit does not show use of the registered mark. Dr Borre states at paragraph 15 of his second witness statement that agents are not involved in sales in the UK because sales are made directly; he explains that there is a facility on the Website for customers in the UK to make direct contact which is then followed up by sending them catalogues and orders are taken directly. However, no evidence was filed to show such contact by a customer in the UK at any time in the relevant later periods.

61. Although I am unable to find genuine use on the basis of sales in the UK, genuine use may also include a scenario such as that submitted to be the case in this instance: knitwear made in Scotland by a manufacturer, operating with relevant permission, who also affixes to those items a label featuring the contested trade mark and which goods are then exported for sale outside the UK. This is clearly countenanced by the provisions of section 46(2) “*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.*”
62. Crucially, in my view, there is nothing in the evidence that establishes that the knitwear goods manufactured in Scotland, which are sold outside the UK under the brand, have the contested mark affixed to the goods or their packaging *in the UK*. It is certainly not explicit in the wording from Mr Maxwell’s statement, which I have quoted. I do note that at paragraph 10 of his second witness Dr Borre states that Esk Knitwear produces the goods and “sends the final knitwear products orders branded McGeorge of Scotland to Cyprus”. This may imply that the goods are sent with the label having been affixed in Scotland, but it is not made explicitly clear and more significantly, given the central importance of the point, there is no corroborative evidence. I have previously referred to Dr Borre’s statement that “all goods sold under the Registration are manufactured in Scotland and from there shipped to the *Licensees in Cyprus who prepare the goods for onward transit* to customers in the UK or other jurisdictions in the EU” [my emphasis]. The evidence also includes images of individual garment boxes bearing the brand. It could be that part of the preparation function in Cyprus involves the affixing of labels – including the co-branded versions I have referred to – and packaging in branded boxes. When I bear in mind the guidance as to probative considerations from the case-law I cited earlier, I find that the position is not clear enough for me to conclude that genuine use has been convincingly demonstrated on the basis of the affixing of the mark to goods in the UK for export.

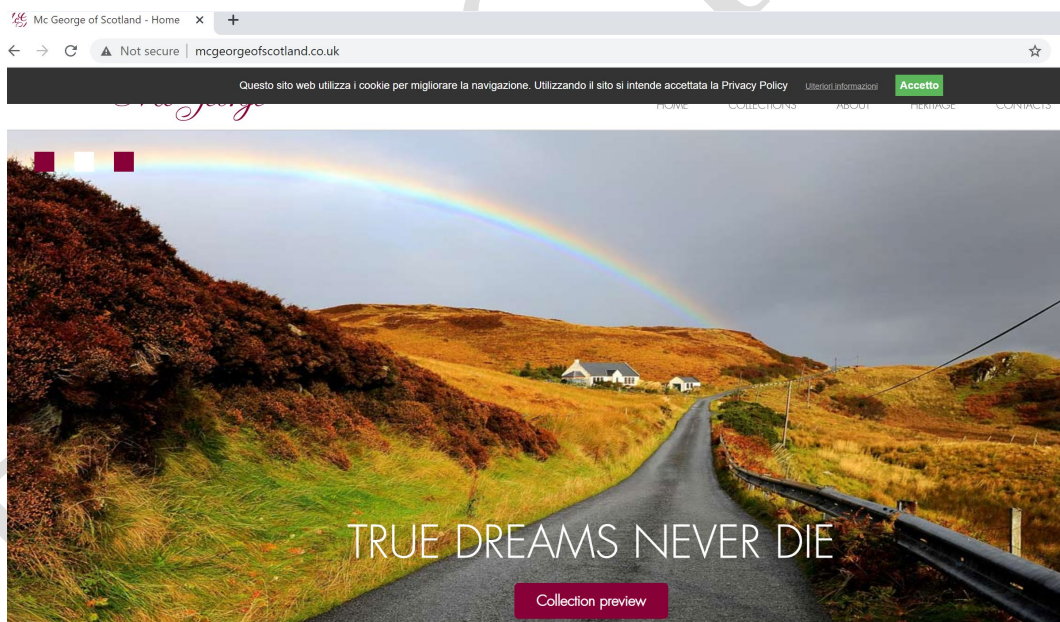
The Website

63. At paragraph 4 of his first witness statement, Dr Borre refers to the registration as of 12 December 2013 of the domain name registration for mcgeorgeofscotland.co.uk (“**the website**”). This is confirmed by **Exhibit LB02**. The same exhibit shows the site to have been last updated on the 17 June 2019. In my view, a domain of that name and

configuration, has the potential to be useful relevant evidence of use of the contested mark, and particularly since the mark in its stylised form (as registered) is shown to feature on the website (**Exhibit LB02A**). However, I have significant reservations about the extent to which the existence of the website in this case may constitute genuine use of the contested registration in the UK.

64. My concerns arise firstly from the way in which Dr Borre himself refers to the website - simply that it “has been in use since [registration of the domain].” This minimal expression is amplified at paragraph 5, but only to the extent of saying that the contested Registration (the stylised trade mark) “has been used over the years” [on the website]. **Exhibit LB02A** shows extracts from search results on the archive resource The Wayback Machine. It shows that the website was captured or “saved” 218 times between June 2014 and February 2019. Without better explanation or context I am not able to assess the significance of that figure. The exhibit also shows images captured from the website in each of the years 2014, 2015, 2016, 2017, 2018 and 2019. From across those 6 years only 4 different images are shown, and whilst they include the stylised mark and some mention “high quality Scottish knitwear since 1881”, they give little impression of a well-used site and changing site.
65. More significantly, the evidence does not show (nor is it even stated) that the goods are available for sale via the site. None of the goods is shown in the exhibit with prices – at all, let alone in pounds sterling - and there is no information on associated sales. As I understand it, it is not contended that the Website functions as a retail site as such, rather that it is a means by which the collections may be shown to and through Agents and to customers. That said, I have previously noted paragraph 15 of Dr Borre’s second witness statement, wherein he refers to direct sales in the UK for which contact may be made through the Website (though no evidence was filed of any actual access of the Website from the UK, or related contact or enquiry).
66. Although I do not overlook that that Website is in the English language, and has a co.uk suffix, there is no clear evidence of its targeting the UK, especially noting the absence of evidence of offers to sell, or actual sales, to the UK or enquiries from the UK. The evidence (including images filed from the Website) indicate a strong focus on sales of the goods in Italy.

67. The skeleton argument on behalf of the Proprietor invited me to access the Website, since it is in the public domain and that I would there note that it is published in English and provides a bricks and mortar address that is staffed and receives emails. Websites are open to change over time, so the only acceptable format for evidence in proceedings before the tribunal is one that captures conclusively the position at a particular point in time. This is achieved, for example, by the content of **Exhibit LB02A** (the content of which I have described above, and which does not, for instance, show the contact details mentioned by Ms McFarland). However, I confess that just before the hearing I did take up the invitation to view the Website, where I noted that its copyright date showed 2019, and, unusually for a co.uk site (accessed from south Wales), the privacy policy that popped up before one could access the site was presented in Italian, reading “*Questo sito web utilizza i cookie per migliorare la navigazione. Utilizzando il sito si intende accettata la Privacy Policy*”, as captured in context below.



68. To aid my assessment of website evidence in this context, in her oral submissions Ms McFarland referred me to the EasyFly judgment of Nugee J.²³ I have considered that referenced content, and have additionally referred myself to the summary offered by Birss J. *Warner Music UK Ltd v Tuneln Inc.*²⁴ The latter summary explains as follows:

“16. The legal principles are:

²³ *easyGroup Ltd v Empresa Aérea de Servicios y Facilitación Logística Integral S.A. - EasyFly S.A. and Anor* [2020] EWHC 40 (Ch), in particular paragraphs [47] to [54] thereof.

²⁴ [2019] EWHC 2923 (Ch)

- i) The mere existence of a website and its accessibility by local consumers is never enough to establish a territorial link, see Kitchin LJ in *Merck v Merck* [2017] EWCA 1834 para 168 and *L'Oreal v eBay* para 64.
- ii) The issue of targeting is to be considered from the perspective of the public in the relevant state (i.e. the UK), see *Merck v Merck* para 169 and *L'Oreal v eBay* para 65.....
- iii) The test is objective in the sense that a party's subjective intention cannot turn a website or page which is objectively not targeted at the UK into one which is (*Argos v Argos* [2018] EWCA Civ 2211 para 51). However that does not mean evidence of intention is irrelevant. On the contrary such evidence is relevant and possibly determinative in an appropriate case (*Merck v Merck* paras 169-170 and *Argos v Argos* para 51).
- iv) The court must carry out an evaluation of all the relevant circumstances, see *Merck v Merck* para 169 and *L'Oreal v eBay* para 65.
- v) It may be appropriate to treat a website as a whole, but in another case it may be appropriate to conduct a more fine grained analysis. Depending on how a website is organised, not all pages are necessarily targeted at the same place(s), see *Argos v Argos* para 51.....

17. The following is a non-exhaustive summary of factors which may be considered, the weight they bear necessarily varying from case to case:

- i) The appearance of the web pages themselves, which can include explicit statements of an intention to provide goods or services to the public in the UK and the highlighting of the UK in lists or maps.
- ii) Other aspects of the web pages such as language(s), currency(ies), telephone numbers, and the use of national top level domain names.
- iii) The nature and size of the service provider's business, the characteristics of the goods or services offered and provided, and the number of visits made by the public from the UK."

69. Having all of the above in mind, especially the absence of any evidence of UK sales or enquiries or promotional targeting, I find the Website is insufficient to establish genuine use of the Registration in the UK in the later period. There is no evidence of the Proprietor

/ the Licensees having directed their activity to the UK or having manifested the intention to establish commercial relations with consumers from the UK.²⁵

OUTCOME

70. Ms McFarland rightly urged that I view the evidence in the round. I have duly done so, but still find that the evidence is not enough for me to find genuine use of the mark in the UK in the later periods. That being so, the Registration is to be revoked. In line with the provisions of section 46(6)(b) of the Act (as addressed in Tribunal Practice Notice TPN 1-2007) the revocation of **UK trade mark No. 1320799 is effective from 12 January 2019** – i.e. the day following the end of the five-year period of non-use claimed as Period 4.

COSTS

71. The Applicant has succeeded in its application to revoke the contested trade mark. It is entitled to a contribution towards its costs. Such costs are to be made in line with the scale published in the annex to Tribunal Practice Notice TPN 2/2016. I have noted that the Applicant highlighted at the hearing that the evidence filed by the Proprietor was voluminous and risked exceeding the parameters indicated by the registry as set out in TPN 1/2015. In my view, the evidence filed is not of such an order that it could be considered unreasonable or in flagrant breach of the guidance; still, volume of the evidence, and its relevance, are of course factors to be taken into account, as too is the fact that proof was required for multiple periods.
72. I also note that Proprietor has successfully defended the revocation attack in relation to the earlier periods and that since the Proprietor was not involved in the business at that time it has had to undertake considerable work to gather its evidence for Periods 1 and 2. I also recognise that the Proprietor had to furnish evidence from Mr Castronovo to address points about Scots law, licences validity and dormancy, on which points I found in favour of the Proprietor. Consequently, although the application for revocation has ultimately succeeded, I consider it reasonable in this case to reduce the award payable by the Proprietor.

²⁵ See to the CJEU in *Peter Pammer v Reederei Karl Schlüter GmbH & Co. KG (C-585/08)* and *Hotel Alpenhof GesmbH v Oliver Heller (C-144/09)* (e.g. at para 47).

Official fee for filing the application for revocation	£200
Preparing statement of grounds and reviewing the counterstatement:	£200
Considering Proprietor's evidence in chief and preparing response submissions / evidence, and considering Proprietor's evidence in reply	£1500
Reduction of 50% in relation to the evidence / submissions component (as explained)	- £750
Preparing for and attending a hearing	£800
Total	£1950

73. I order J&D McGeorge Limited to pay Walmart Apollo LLC the sum of £1950 (one thousand nine hundred and fifty pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 5th day of March 2021

Matthew Williams
For the Registrar
