

O/563/21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 3078297

IN THE NAME OF SIG TRADING LIMITED

IN RESPECT OF THE TRADE MARK

SIGNATURE[®]

IN CLASSES 6, 17 & 19

AND

THE APPLICATION FOR REVOCATION THEREOF UNDER NO. 503249

BY THE AMTICO COMPANY LIMITED

Background and pleadings

1. SIG Trading Limited (“the proprietor”) is the registered proprietor of trade mark registration no. 3078297 registered in the United Kingdom for the mark **SIGNATURE**[®]. The trade mark was filed on 23 October 2014 and completed its registration procedure on 20 February 2015. It is registered in respect of goods in class 6, 17 and 19. This matter concerns all goods in class 19, which are set out below:

Class 19: Non-metallic building materials; non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; non-metallic monuments; non-metallic framed conservatories, doors and windows; non metallic building materials; geotextiles; non-metallic waterproofing materials; bricks; natural and artificial stone, cement, lime, mortar, whiting, plaster, gravel; asphalt, pitch, bitumen and preparations made from these materials (other than paints) for use in building and construction; non metallic boards for use in buildings; wall boards; clips; studs; boards for use in building and construction; sealants; non metallic plugs; small items of non metallic hardware used in building and construction; cement; building materials made of plaster; plaster and plaster compositions for use in building construction; non metallic partitioning and non metallic partitioning materials; non metallic partitions; parts, fittings and accessories for all the aforesaid goods; but not including pipes, tubes, couplings, joints for all the aforesaid goods; fittings not of metal for buildings; door fittings and door stops not of metal; window fittings and window stops not of metal; non-metallic mouldings; timber mouldings; non-metallic extrusions; blinds not of metal or textile; blinds of wood; blinds of plastic; non-metallic partitions; non-metallic partition installations; non-metallic ceiling installations; non-metallic ceiling panels; non-metallic wall claddings; non-metallic wall panels; timber wall panels; non-metallic doors; timber doors; non-metallic glazing units; non-metallic glazing panels; glass for use in buildings; printed glass for use in buildings; routed glass for use in buildings; etched glass for use in buildings; architectural glass elements;

architectural glass installations; decorative glass elements; decorative glass installations; non-metallic exhibition stands; signs not of metal; signs of wood; signs of plastic; flat roofs, not of metal, in particular flat sealings, namely bitumen webs, liquid sealings, plastic sealings; flat roof fittings, not of metal, in particular dome lights and fittings, roof edging systems, covers for terraces; wood, namely construction timber, lumber, profiled wood, boards of wood; facades, not of metal, in particular facade claddings, including slate, fibre cement, hardboard, plastic components; roof coverings, not of metal, in particular clay roof tiles, concrete roofing tiles, slate, fibre cement, double web panels, bitumen; roofing materials, not of metal; guttering, not of metal, in particular gutters, down pipes; fittings, not of metal, for high pitched roofs, in particular underfloor webs, insulating membranes, attic stairs; green roofs, not of metal; building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal; non metallic building materials; doors and windows; floors; roofs and roofing materials; tiles; non-metallic waterproofing materials; bricks; natural and artificial stone, cement, lime, mortar, plaster, gravel; asphalt, pitch, bitumen and preparations made from these materials (other than paints) for use in building and construction non metallic boards for use in buildings; wall boards; internal walls, ceilings and partitions; non-metallic clips; boards for use in building and construction; sealants; non metallic plugs; small items of non metallic hardware used in building and construction; cement; building materials made of plaster; plaster and plaster compositions for use in building construction; non metallic partitioning and non metallic partitioning materials; non metallic partitions; non-metallic roofing materials; non-metallic building materials having insulation properties; pvcu roofing products, fascias, guttering, down pipes, cladding; internal partitioning made of non-metallic materials; partitioning materials (non-metallic-); blocks (non-metallic-) for use in flooring construction; ceramic tiles for flooring and facing; ceramic tiles for flooring and lining; ceramic tiles for flooring of building; flooring made of wood; flooring materials (non-metallic-); flooring (non-metallic-); flooring tiles (non-metallic-); hardwood flooring; synthetic flooring

materials or wall-claddings; tile floorings, not of metal; wooden flooring; fillers for repairing walls; rendering compositions for use in building; rendering compositions for use in construction; renderings; erosion control fabric, mats and sheeting, not of metal [geotextiles]; fabrics for use in civil engineering (geotextiles); stabilisation fabrics [geotextiles] (non-metallic-) for use in construction; erosion control fabric [construction]; erosion control fabric, mats and sheeting, not of metal [geotextiles]; erosion control sheeting or fabric for construction use; tree guards (non-metallic-) [[structures]; paving products (non-metallic-); paving; synthetic paving composites; liners of plastic material; lawn guards (non-metallic-) [[structures]; non-woven fabrics for land stabilisation; non-woven fabrics for soil stabilisation; stabilisation fabrics [geotextiles] (non-metallic-) for use in construction; stabilisation fabrics (non-metallic-) for use in construction; waterproofing boards (non-metallic-); drainage installations (non-metallic-); non-woven fabrics for land drainage; venting (non-metallic-); building boards of plastics materials; building materials of plastics material; construction elements of plastic; expanded plastics for use in construction; expanded plastics for use in building; transparent plastic panels for building construction purposes; transparent plastic panels for building purposes; transparent plastic roof tiles; aggregate materials for use in concrete; concrete; building elements of concrete; building elements made of concrete; concrete building elements; concrete building materials; concrete panels; concrete piles; concrete pipes; polymer concrete; reinforced concrete; synthetic concrete; trench drains [concrete drainage structures]; composite structures (non-metallic-); movable partitions [walls] of non-metallic materials; moveable walls made of non-metallic materials; cladding panels (non-metallic-) for walls; wall panels (non-metallic-); wall panels not of metal; wall boards; plastic wallboards; fibre cement; spacers being building elements made of fibre reinforced cement; adhesive mortar for building purposes; levelling preparations [cement or mortar]; ties (non-metallic-) for use in building; ties (non-metallic-) for retaining insulation between the internal and external walls of buildings; non-metallic ceiling tiles having sound insulation properties;

insulation glass for building; roofing felt; tarred felts; felt roof coverings; asphalt roofing felt; roofing underlayment; roofing membranes; bituminous sealing membranes; roof vents (non-metallic); parts and fittings for the aforesaid goods.

2. The Amtico Company Limited (“the cancellation applicant”) seek revocation of the trade mark registration on the grounds of non-use based upon section 46(1)(a) and section 46(1)(b) of the Trade Marks Act 1994 (“the Act”). The application for revocation was filed on 24 July 2020.
3. Revocation is sought under Section 46(1)(a) in respect of the 5-year period following the date of completion of the registration procedure, namely 21 February 2015 to 20 February 2020. Revocation is therefore sought from 21 February 2020. Revocation is also sought under Section 46(1)(b) in respect of the time period 24 July 2015 to 23 July 2020. Revocation under this ground is sought from 24 July 2020.
4. The proprietor filed a counterstatement denying the claim that the mark had not been put to genuine use in respect of the goods for which it is registered in class 19 under both section 46(1)(a) or 46(1)(b) of the Act.
5. Only the proprietor filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
6. A Hearing took place on 17 June 2021 at 9.30am. Only the proprietor chose to be represented at the hearing. The proprietor was represented by Mr Florian Traub of Pinsent Masons LLP. The cancellation applicant filed written submissions in lieu, which will not be summarised but will be referred to if and when necessary during this decision. The cancellation applicant is represented by Barker Brettell LLP.

Legislation

7. Section 46 of the Act states:

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

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

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

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (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.

(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”.

8. 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.”

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

10. The proprietor filed evidence in the form of a witness statement in the name of Andy Williamson, described as the Commercial Director of SIG UK. In his witness statement, Mr Williamson states that the “relevant group company” is SIG Trading Limited, and that he is duly authorised to make the witness statement on behalf of the company. The witness statement introduces 9 exhibits, namely Exhibit AW01 to Exhibit AW09.

11. Within its written submissions, the cancellation applicant questioned that the use of the mark in the evidence is use with authorisation of the proprietor, stating that the relationship between the proprietor and SIG UK had not been

explained and was not evidenced. At the hearing, Mr Traub submitted on behalf of the proprietor that it is a subsidiary company wholly owned by SIG UK, and highlighted that Mr Williamson had expressed in his witness statement he was authorised to make submissions on their behalf. He also referred me to page 35 of Exhibit AW04 supplied in the evidence, which refers to various names used by the companies, as well as to the invoices provided at Exhibit AW08, which state payment is to be made to the proprietor, SIG Trading Limited. I see no reason to doubt that Mr Williamson was in a position to provide evidence on behalf of the proprietor, nor do I see any reason to find that where use has been made it was not made by the proprietor itself, particularly as the invoices provided state payment is to be made to the proprietor. Further, even if the use of the mark was made by SIG UK rather than the proprietor itself, section 46(1)(a) and 46(1)(b) require use either by the proprietor, or with its consent. In this case, the consent between the companies in the group as mentioned in Mr Williamson's witness statement is implied. It is my view that I do not need further evidence or explanation on this point to establish that, to the extent that the evidence shows the use of the mark, this will be use either by the proprietor, or with its consent.

12. Within his witness statement, Mr Williamson explains that the trade mark represents one of the "leading brands in the roofing segment" of his company, and that the trade mark was established in late 2014 / the beginning of 2015.
13. Mr Williamson states the mark was established to provide its customers with "quality products and accessories around clay tiles, PU Liquids, Rooflights and so-called "torch on" roofing systems", and that it has been in continuous use in the UK since it was established.
14. Mr Williamson provides sales figures in relation to products sold under the mark in the UK as follows:

	2014	2015	2016	2017	2018	2019	2020 Aug YTD
Signature PU	N/A	N/A	N/A	£48,434	£387,454	£487,018	£150,611
Signature Felt	N/A	£456,501	£879,812	£1,180,517	£1,439,041	£1,402,169	£701,689
Signature Approved	N/A	N/A	£203,420	£335,552	£668,394	£575,889	£258,309

Signature Tiles	£272,961	£1,041,930	£1,488,995	£2,185,053	£2,488,153	£2,109,519	£1,171,469
	£272,961	£1,498,431	£2,572,227	£3,749,556	£4,983,042	£4,574,595	£2,282,078


15. Mr Williamson also provided figures showing website traffic for its website at Exhibit AW07. This shows over 7000 visits in 2018 and 2019, and over 8000 up until August 2020. The website itself has a “.co.uk” domain, and although the extract is dated 18 December 2020, Mr Williamson confirms it was available in that form during the relevant period. The webpage itself discusses primarily the “torch on system range”. It describes a “fire retardant cap sheet” as well as underlay options, and both torch applied and self-adhesive “vapour control layers” offered under the mark SIGNATURE[®]. The mark used in respect of the torch on range is copied below:

SIGNature Torch on System Range

About the SIGNature Torch on System range

The SIGNature Torch on System range is an EXT.F.AA fire rated roofing system intended for both new work and overlav projects. Offering 20 or 25 year warrantv



16. Exhibit AW01 comprises a brochure displaying the mark  dated July 2016 and discussing a range of handmade and machine-made clay roofing tiles.

17. Exhibit AW02 comprises a print out from www.sigroofing.co.uk. Although it is dated the day prior to the print out of the website provided at Exhibit AW07 (as

discussed above), the content is much the same, showing the marks shown in paragraph 15 and again discussing the torch on system range. Mr Williamson confirms this was available during the relevant period within the witness statement.



18. Exhibit AW03 shows the mark on advertisements in the magazine RCI Roofing Cladding & Insulation. The advertisements promote the Torch-On roofing system describing it as a 'built up roofing system for flat and pitched roofs'. The magazine is dated June 2018, and the same advertisements are shown on additional pages with a date of 4 October 2018 showing. The date of 4 October 2018 appears to be the date of the capture, with the date appearing next to a timestamp at the bottom of the page.

19. Exhibit AW04 comprises over 200 pages. It includes data sheets, brochures and certification documents which provide additional detail about products appearing under variations of the stylised mark. Where the documents are undated, Mr Williamson stated in his witness statement that he could confirm the documents were used and available to customers during the relevant period.¹ The documents include, but are not limited to those listed below:

- Signature Bitumen Roofing Felts data sheet (dated September 2014, May 2015)
- Signature Fire Rated Cap Sheet data sheet (dated September 2014, May 2015)
- Signature Systems Surface Prep Layers data sheet (dated September 2014, May 2015)
- Signature Underlays data sheet (dated September 2014, May 2015)
- Signature Vapour Control Layers (dated September 2014, May 2015)
- Signature Edge Erosion and Coating system brochure (undated)
- Signature Liquid Waterproofing PU Liquid Fibre data sheet (undated)

¹ See paragraph 10

- Signature Liquid Waterproofing Signature PU 20 certification (dated 31 October 2019)
- Signature Liquid Waterproofing Signature brochure (undated)
- Signature PU reinforcing fabric (undated)
- Signature PU Terrace Brochure (undated)
- Signature PU Corrosion & Coating Liquid data sheet (undated)
- Signature PU-10 Liquid Coating data sheet (undated)
- Signature PU-20 Liquid Coating Kit data sheet (undated)
- Signature PU PVC Primer data sheet (undated)
- Signature Rooflights range brochure (undated)
- Signature PU Same Day Primer data sheet (undated)
- Signature PU Reinforcing Tape data sheet (undated)
- Signature PU Thickening Agent data sheet (undated)
- Signature PU TPO/FPO Primer data sheet (undated)
- Signature PU Joint Sealer data sheet (undated)
- Signature PU Liquid Fibre data sheet (undated)
- Signature PU Next Day Primer data sheet (undated)
- Signature PU PVC Primer data sheet (undated)
- Signature PU Reinforcing Tape data sheet (undated)
- Signature PU Same Day Primer data sheet (undated)
- Signature PU Terrace data sheet (undated)
- Signature PU Thickening Agent data sheet (undated)
- Signature PU TPO/FPO Primer data sheet (undated)
- Signature PU-10 Liquid Coating data sheet x 2 (undated)
- Signature PU-20 Accelerator data sheet (undated)
- Signature PU Edge Corrosion & Coating Liquid technical application guide (undated)
- Signature Built-up Flat Roofing Systems brochure (undated)

20. Exhibit AW05 comprises various news and press articles, as well as what appear to be article briefs, in that they are the instructions for articles or press releases rather than the finished articles or press releases as published. Some of these reference 'SIGNature' products. This include a news release dated 23 May 2018 referring to the SIGNature (as a word) 25 roof waterproofing system

BBA accreditation, in addition to an article in ‘INSIGHT Tech Talk’ from June 2019 discussing the ‘SIGnature Torch-On’ offering a top fire rating. An article brief dated June 2018 discusses the SIGnature PU Liquid Waterproofing system, the SIGnature PU-20 Liquid Coating Kit and the SIGnature PU-10 Liquid coating kit.

21. Exhibit AW06 includes slides from a contractor training course presentation. The course date is missing from the slides, but they make reference to the ‘BBA’ applied for being due in the 3rd quarter of 2018 in respect of the SIGnature Liquid Waterproofing System. Exhibit AW07 is a screenshot of the proprietor’s website as mentioned previously.

22. Exhibits AW08 comprises several invoices. These include 5 from each year from 2015 to 2020. Of the 2020 invoices, 2 fall outside both the relevant dates in the second half of 2020. The majority of the invoices show UK addresses² but the consumer details have been redacted. The invoices themselves are headed with SIG ROOFING trade mark and not the mark as registered. The invoices reference to various products referencing ‘SIGnature’ as set out in the table below. Where an item description is included multiple times within a year they are not necessarily repeated below, but the frequency has been noted.

2015	2016	2017	2018	2019	2020
Invoice of 1 June 2015 (first relevant period only) - SIGNATURE TORCH ON SYSTEM SIGnature AA Cap	- SIGnature Underlay25 12x1mtr - SIGnature AA Cap Sheet Black 8x1mtr	-SIGnature underlay20 Film-on-film 16x1 black upper film - SIGnature Underlay25 12x1mtr	- SIGnature AA Cap Sheet Black 8x1mtr -SIGnature Underlay25 12x1mtr	- SIGnature Underlay25 12x1mtr - SIGnature AA Cap Sheet Black 8x1mtr	Invoices from 1st June 2015 to and including 31st February 2020 -SIGnature Film on Film torch on underlay

² The “invoice to” details including the address are redacted entirely on the initial invoice from 2015

Sheet Black 8x1mtr	- SIGNature Underlay25 12x1mtr	- SIGNature AA Cap Sheet Black 8x1mtr	- SIGNature Underlay20 16x1mtr	AA Cap sheet -Underlay	- SIGNature AA Cap Sheet Black 8x1mtr
Invoices dated within both relevant periods	- SIGNATURE TORCH ON SYSTEM SIGNature AA Cap SIGNATURE TORCH ON SYSTEM SIGNature Underlay20 16x1mtr -SIGNature SA VCL 15x1mtr	-SIGNature SA VCL 15x1mtr SIGNATURE TORCH ON SYSTEM SIGNature AA Cap Sheet Black 8x1mtr			Invoices between 21 February 2020 and up until and including 23 July 2020
- SIGNATURE TORCH ON SYSTEM SIGNature AA Cap Sheet Black 8x1mtr	- SIGNATURE TORCH ON SYSTEM SIGNature Underlay20 16x1mtr				- SIGNature AA Cap Sheet Black 8x1mtr
- SIGNature Underlay20 16x1mtr					- SIGNature Underlay25 12x1mtr
-SIGNature SA VCL 15x1mtr					
- SIGNATURE TORCH ON SYSTEM SIGNature Underlay25 12x1mtr					
- SIGNATURE TORCH ON SYSTEM SIGNature					

SA VCL 15x1mtr - SIGnature Underlay20 16x1mtr - SIGnature AA Cap Sheet Black 8x1mtr					
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23. Exhibit AW09 comprises several purchase-order documents. Five purchase orders are provided in respect of each year for the period of 2016 to 2020. Of the purchase orders provided in 2020, 2 of these are dated outside of the second relevant period and all five of these are dated outside of the first relevant period. As with the invoices provided at Exhibit AW08, the purchase orders are headed with SIG ROOFING trade mark and not the mark as registered. They make reference the following products using the word 'SIGnature' in the body of the same:

2016	2017	2018	2019	2020
SIGnature AA Cap Sheet Black 8x1mt SIGnature Underlay25 12x1mtr SIGnature Underlay20 16x1mtr SIGnature T/on VCL 12x1mtr	SIGnature Approved Lightning Conductor Clip – Bituminous SIGnature Approved Overlay Cap Sheet 8m Black Mineral SIGnature Underlay20 Film-on-Film	SIGnature Approved Parapet Outlet 75mm - Bituminous Flange SIGnature Approved SVP Cover 110mm - Bituminous Flange SIGnature Approved Leaf	SIGnature AA Cap Sheet Black 8x1mt SIGnature Underlay20 Film-on-Film 16x1m Black Upper Film SIGnature Torch on Vapour Control Layer 12m x 1m	SIGnature AA Cap Sheet Black 8x1mt SIGnature Underlay20 16x1mtr SIGnature Approved Leaf Guard – Uni powder coated red – dated 11 June 2020

SIGNature SA VCL 15 x 1mtr	16x1m Black Upper Film	Guard – Parapet	SIGNature Underlay25 12x1mtr	SIGNature AA Cap Sheet Black 8x1mt – dated 23 July 2020
SIGNature AA Cap Sheet Green	SIGNature Underlay25 12x1mtr	SIGNature AA Cap Sheet Black 8x1mt	SIGNature Underlay20 16x1mtr	SIGNature Underlay25 12x1mtr – dated 23 July 2020
	SIGNature Underlay20 16x1mtr	SIGNature Underlay25 12x1mtr	SIGNature Underlay20 16x1mtr	SIGNature Approved Rooflights & Domes – dated 31 July 2020 outside relevant period
	SIGNature T/on VCL 12x1mtr	SIGNature Underlay20 16x1mtr	SIGNature Underlay20 16x1mtr	
	SIGNature AA Cap Sheet Blac 8x1mtr	SIGNature Approved Rainwater Outlet 95mm – Bituminous Flange	SIGNature VAR Approved Bitumen GRP	

Decision

The principles of genuine use

24. 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].”

25. The relevant period for considering the use made of the mark under 46(1)(a) of the Act is the five year period falling directly after the registration of the mark, namely 21 February 2015 to 20 February 2020. The relevant period for consideration under section 46(1)(b) of the Act is the five year period from 24 July 2015 to 23 July 2020. At the hearing, Mr Traub submitted for the proprietor that the two periods for proving use overlap significantly, and that he would therefore be making his submissions in respect of the 46(1)(a) and 46(1)(b) grounds together. Whilst I note the difference of approximately five months between the relevant periods, I find it appropriate to take the same approach, although I will keep in mind the differences between the relevant periods and factor these differences into my decision should it be appropriate to do so.

Form of the mark

26. Prior to conducting an analysis of the evidence filed in order to determine if there has been genuine use of the registered marks, it is necessary to review

the instances where the proprietor has used the mark in conjunction with additional elements, or in a varying form to the mark as shown on the register, in order to determine if these instances should be classed as use 'of the mark' for the purpose of the assessment. Within its written submissions, the cancellation applicant has accepted that the following representations of the mark are acceptable variants of the mark in respect of the specific goods for which they are used:



SIGNATURE^S
CLAY TILES



THE
SIGNATURE^S
TORCH ON SYSTEM RANGE

27. However, the cancellation applicant has submitted that firstly, it is the word version of the mark namely 'SIGNature' that has been shown in the majority of the evidence, and secondly, that this is not an acceptable variant of the mark as registered in line with *Nirvana Trade Mark*, BL O/262/06. The cancellation applicant has submitted on this basis that reference to SIGNature as a word should be disregarded in the evidence.

28. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to

establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, 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.


33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade 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' within the meaning of Article 15(1)".

29. It is clear that mark as registered is present within the different stylised variations, and that it continues to act as an independent indication of origin within the same. I agree with the cancellation applicant that the two stylised marks referenced in its submissions as shown above, as well as the other



versions in the same format such as  are all acceptable variants of the mark in line with *Colloseum*.

30. Whilst I acknowledge there are references to the word 'SIGnature' in the text, I do not find this forms the majority of the use as is submitted. Generally, the use of the word mark 'SIGnature' is made within the text of documents headed with the stylised mark, or an acceptable variant of the same. Whilst I note the invoices, the purchase orders and some of the articles and article submissions make reference to products using the word 'SIGnature', the products referenced can generally be matched with those found in the brochures, data sheets and advertisements clearly showing the products under the mark as registered, or an acceptable variant of the stylised mark. Further, where a mark is stylised, I find it is common for the reference made to that mark in invoices to be in word format due to the nature of the documents. I do not therefore, agree with the cancellation applicant's submission that references to the word 'SIGnature' should be discounted in the evidence, rather it is my view that the sum of the evidence should be considered, and the picture of use it creates. In this case, when considering the evidence as a whole, I find that references to products sold and promoted under the word SIGnature can be related back to the consistent use of the mark as registered or an acceptable variant found.

Use of the mark

31. Before I begin my assessment on the use of the mark from the evidence, I note firstly that at the hearing, Mr Traub submitted in respect of a number of the challenged goods in class 19 that the proprietor had not made use in of the mark in respect of the same, or that evidence of such use could not be found by Mr Traub in the papers filed. In addition to these admissions at the hearing, I also note the following statement made by Mr Williamson at paragraph 4 of his witness statement:

“When I say in this statement that we have made use for “the Relevant Goods”, then I include in this definition also specifications which may not

be part of our current product list, but which are closely related to the building materials branded under the Trade Mark.”

32. However, despite the apparent acknowledgement on behalf of the proprietor that some of the goods in class 19 are not in use, or that no evidence has been filed showing such use (or at least the admission that Mr Traub himself had not been able to find use shown within the evidence), Mr Traub submitted that these goods should nonetheless be maintained on the register. I will consider Mr Traub’s submissions on this point in more detail later in this decision, but I reference these submissions at this stage in order to clarify that I find it appropriate to consider firstly whether there is evidence that the mark (or an acceptable variant) has been used in respect of the goods and within the relevant timeframe, and not whether the goods are closely related to goods in use, or if they fall under terms listed elsewhere in the specification.

non-metallic transportable buildings; non-metallic monuments; non-metallic framed conservatories, doors; non-metallic transportable buildings; monuments, not of metal;

33. In respect of the goods above, Mr Traub submitted he cannot point to any use of the mark in respect of the same in the evidence, and that I will need to come to my own decision on whether these fall under the general category of building materials. I too cannot see any use of the mark in respect of the above goods in the evidence filed, and as mentioned above, I do not find it necessary to consider if these items fall under the category of building materials.

bricks; natural and artificial stone, cement, lime, mortar, whiting, plaster, gravel; cement; building materials made of plaster; plaster and plaster compositions for use in building construction; aggregate materials for use in concrete; concrete; building elements of concrete; building elements made of concrete; concrete building elements; concrete building materials; concrete panels; concrete piles; concrete pipes; polymer concrete; reinforced concrete; synthetic concrete; trench drains [concrete drainage structures]; fibre cement; spacers being building elements made of fibre reinforced cement;

34. Mr Traub submitted that although there may not be specific evidence in respect of the goods *bricks; natural and artificial stone, cement, lime, mortar, whitening, plaster, gravel*; or any evidence in relation to *concrete*, these are so closely related to roofing materials they will fall under the wider category. I can confirm that I also have not found any evidence relating to the use of the mark in respect of the goods above.

non metallic boards for use in buildings; wall boards; boards for use in building and construction; wall boards; plastic wallboards; waterproofing boards (non-metallic-); building boards of plastics materials;

35. At the hearing, Mr Traub submitted he had not seen any evidence on boarding solutions, and he can only imagine that a timber roof structure would have boarding on it. Clearly, I cannot take the suppositions of Mr Traub as evidence the proprietor uses the mark for these goods. Mr Traub submitted that these are closely related materials, but they may be more debatable than some other products in the specification. I also fail to see any use of the mark in relation to the goods above. Whilst I note reference to ‘underlay’ in the evidence, these are described as polyester and glass coated “carriers” and appear to be supplied in rolls. These do not appear to be to be boards as mentioned above. Further, the cap sheets mentioned in the evidence also appear to be supplied in rolls, and it is my view that these are not boards as described above.

non metallic plugs; small items of non metallic hardware used in building and construction; clips; non-metallic clips;

36. Mr Traub submitted it is only natural that these items are offered with the other items offered with the applicant’s goods, however, he did not point me to any evidence, or make any submission that these items were offered under the mark. I see no evidence that there is use of the mark in respect of these goods. I note there is a reference to a “SIGnature Approved Lightning Conductor Clip – Bituminous” on a purchase order from 3 January 2017, but I cannot match this with any evidence showing what this refers to, in order to determine if it is reference to use of the goods above.

door fittings and door stops not of metal;

37. Again, Mr Traub submitted that whilst there was no evidence of the mark being used in connection with these goods, windows are closely connected to these. I see no evidence of the mark being used in relation to these goods.

fittings not of metal for buildings; non-metallic mouldings; timber mouldings; non-metallic extrusions; blinds not of metal or textile; blinds of wood; blinds of plastic; non-metallic partitions; non-metallic partition installations; non-metallic ceiling installations; non-metallic ceiling panels; non-metallic wall claddings; non-metallic wall panels; non-metallic doors; timber doors; non-metallic exhibition stands; signs not of metal; signs of wood; signs of plastic; timber wall panels; wood, namely construction timber, lumber, profiled wood, boards of wood; non metallic partitioning and non metallic partitioning materials; non metallic partitions; doors [...]; movable partitions [walls] of non-metallic materials; moveable walls made of non-metallic materials; cladding panels (non-metallic-) for walls; wall panels (non-metallic-); wall panels not of metal; drainage installations (non-metallic-); venting (non-metallic-); roof vents (non-metallic); internal walls, ceilings and partitions; facades, not of metal, in particular facade claddings, including slate, fibre cement, hardboard, plastic components; internal partitioning made of non-metallic materials; partitioning materials (non-metallic-); fillers for repairing walls; transparent plastic panels for building construction purposes; transparent plastic panels for building purposes; transparent plastic roof tiles; levelling preparations [cement or mortar]; ties (non-metallic-) for use in building; ties (non-metallic-) for retaining insulation between the internal and external walls of buildings; non-metallic ceiling tiles having sound insulation properties; attic stairs; fascias, cladding; studs; composite structures (non-metallic-); expanded plastics for use in construction; expanded plastics for use in building;

38. I can find no evidence of use of the mark in respect of the goods above. In respect of the timber products, Mr Traub suggested it was borderline whether the use the proprietor had made use of these, but I can see no evidence of use in respect of the same. I also note that Mr Traub submitted that the mark is

clearly used for insulation materials, but I find no evidence that the above mentioned goods relating to or holding insulating properties are in use by the proprietor.

windows; flat roof fittings, not of metal, in particular dome lights and fittings, [...]; window fittings and window stops not of metal;

39. The evidence provided shows the mark in use in respect of rooflights, including within a catalogue provided within Exhibit AW04. No date is given to the brochure, but Mr Williamson makes a broad statement within his witness statement that where the documents provided at Exhibit AW03-AW06 are undated, the documents were used and available to the proprietor's customers during the relevant period. However, I also note that the products are discussed in a newsletter submission to 'Insight'. The submission is dated 12 August 2020, and the submission highlights "new products from SIG Design & Technology". There is also a mention of the rooflights in an article dated 27 July 2020 which discusses the new products on the SIG Design and Technology website stating there are "new sections" on rooflights and clay tiles. An order for a rooflight shows on a purchase order dated 31 July 2020, but there is no mention of these on the invoices or purchase orders before this date. In the witness statement, Mr Williamson states:

"The Trade Mark was established in late 2014 / beginning of 2015 to provide our customers with quality products and accessories around clay tiles, PU Liquids, Rooflights and so-called "torch on" roofing systems. The use has been continuous throughout the UK since then".

40. Whilst I do not doubt the genuineness of the statement above, it is not clear from this when the mark was first used in respect of the rooflights mentioned, and it is not clear which, if any of the turnover figures relate to the sale of the same, and if any of these goods were sold within either of the two relevant time periods. There is no mention of the rooflights on the website print out provided at AW07, which although dates from 18 December 2020, Mr Williamson has confirmed was as shown within the relevant timeframe. The mention of these as new products in the article of 27 July 2020 and the newsletter submission

from August 2020, along with the only order shown on the documents being dated 31 July 2020 makes it appear likely these products were launched following the relevant period. Whilst it is possible there was use of the mark for these goods within the relevant period, I am unable to find this from the evidence provided.

non-metallic glazing units; non-metallic glazing panels; glass for use in buildings; printed glass for use in buildings; routed glass for use in buildings; etched glass for use in buildings; architectural glass elements; architectural glass installations; decorative glass elements; decorative glass installations; insulation glass for building;

41. At the hearing, Mr Traub stated that whilst he had not identified any evidence showing that glazing is sold separately, as the proprietor offers rooflights, and there is a close connection between these and glazing, the customer would expect them to be offered by the same undertakings. As mentioned above, I have not been able to identify that the mark was used on rooflights within the relevant period, and I am unable to find any evidence of the mark in use in respect of the goods above.

tree guards (non-metallic-) [[structures]; lawn guards (non-metallic-) [[structures]; non-woven fabrics for land stabilisation; non-woven fabrics for soil stabilisation; stabilisation fabrics [geotextiles] (non-metallic-) for use in construction; stabilisation fabrics (non-metallic-) for use in construction; green roofs, not of metal; erosion control fabric, mats and sheeting, not of metal [geotextiles]; fabrics for use in civil engineering (geotextiles); stabilisation fabrics [geotextiles] (non-metallic-) for use in construction; erosion control fabric [construction]; erosion control fabric, mats and sheeting, not of metal [geotextiles]; erosion control sheeting or fabric for construction use; non-woven fabrics for land drainage; geotextiles

42. In respect of the good above, Mr Traub submitted that these goods may be used in relation to green roofs. Mr Traub also submitted that “geotextiles” are used as part of the torch on roofing system. I see very little mention of green roofs being offered by the proprietor, and none that these are offered under the

mark, nor that these individual goods above are provided. Further, I do not see any reference to geotextiles in relation to the torch on system, and without further evidence on this, I am unable to find that use of the mark in relation to the torch on roofing system is use of the mark in respect of geotextiles.

Paving products (non-metallic-); paving; synthetic paving composites; blocks (non-metallic-) for use in flooring construction; ceramic tiles for flooring and facing; ceramic tiles for flooring and lining; ceramic tiles for flooring of building; flooring made of wood; hardwood flooring; tile floorings, not of metal; wooden flooring; flooring tiles (non-metallic-);

floors; flooring materials (non-metallic-); flooring (non-metallic-); synthetic flooring materials or wall-claddings

43. At the hearing, Mr Traub submitted that whilst the trade mark is not used by the applicant in respect of classic flooring, as the materials are used to provide a roof for balconies, the consumer would think that the roofing was also a flooring, and would not make the distinction between them. This point is also made in the evidence at paragraph 4 of the witness statement, in which Mr Williamson states:

“We do not offer flooring products in the sense of parquet or laminate, but our Signature PU liquids range includes materials that are, for example, used on outside balconies. In one way, these are roofing materials in the sense that they protect the balcony below from the elements; in another way, these are flooring materials in the sense that they cover the flooring of the balcony from above.”

44. It is clear from the statements made by Mr Williamson, the submissions from Mr Traub, and the evidence provided, that there has been no use of the flooring products outlined covered by the first group of goods above. I therefore consider the evidence provided in relation to the use of the goods under the mark as flooring or flooring materials broadly. The most persuasive of the exhibits provided on this point is Exhibit AW04. This exhibit includes an undated brochure discussing ‘PU Terraces’, and it describes ‘Polyurethane surface

protection for balconies and walkways' and 'a single component, rapid curing polyurethane coating intended for application as a traffic coating over SIGnature PU-10 and PU-20 Liquid Coatings and other surfaces'. It also references the application of this product for a 'non-slip walkway'. Elsewhere it confirms it may be used as a hard wearing surface over 'concrete surfaces, even garage floors' amongst other applications. The PU Terrace product is referenced in brochures on which the registered mark (or an acceptable variant) is displayed clearly on the cover page. Reference to the product is also provided under Exhibit AW04 on the BBA Approval Inspection Testing Certification on which the date of first issue is given as 31 October 2019. More information is provided about the product as below:

4 General

4.1 SIGnature PU-20, when used with SIGnature PU Terrace, is satisfactory for use as a waterproofing system on new and existing, flat and pitched, limited access roofs. When installed without the SIGnature PU Terrace, the system is only suitable for non-accessible areas or under protection.

4.2 The system is suitable for use on the following substrates:

- concrete
- mortar
- fibre cement.

4.3 Limited access roofs are defined for the purpose of this Certificate as those subjected only to pedestrian traffic for maintenance of the roof covering, cleaning of gutters, etc. Where traffic in excess of this is envisaged, additional protection to the membrane must be provided, as specified by the Certificate holder.

4.4 Flat roofs are defined for the purpose of this Certificate as those with a minimum finished fall of 1:80. For design purposes, twice the minimum fall should be assumed, unless a detailed analysis of the roof is available, including overall and local deflection, direction of falls, etc. Pitched roofs are defined for the purpose of this Certificate as those having a fall in excess of 1:6.

4.5 Decks to which the system is to be applied must comply with the relevant requirements of BS 6229 : 2018, BS 8217 : 2005 and, where appropriate, *NHBC Standards* 2019, Chapter 7.1.

45. It is clear that there is reference to this product falling within both of the relevant periods, although I note this is near the end of both. However, I question whether this product can reasonably be described as 'floors' or 'flooring materials'. I note that the system is designed to help withstand what is described above as pedestrian traffic, and this product is not required in respect of roofs with no access as discussed elsewhere in the evidence. Further, I note the reference that it may be used over garage floors. However, it is still clearly described as being for use with roofs primarily, as a traffic coating to help withstand roof access. Whilst I therefore note that the product itself helps

withstand footfall on a roof, and that it has a possible application over all types of concrete 'even' a garage floor, this does not, in my view, make the product, which is ultimately a hard-wearing liquid sealant for use primarily on roofing, flooring or flooring material. In the absence of further evidence that the proprietor provides flooring materials, I find no use of the mark in respect of the same.

non-metallic rigid pipes for building; guttering; guttering, not of metal, in particular gutters, down pipes;

46. At the hearing, Mr Traub submitted that guttering will be supplied with a roof, although he pointed me to no evidence of the mark actually being used in respect of the same. I can see limited references to leaf guards for parapets and to the 'SIGnature Approved Rainwater Outlet 95mm – Bituminous Flange' and 'SIGnature Approved Parapet Outlet 75mm - Bituminous Flange' from the purchase order documents dating from 2018. These references may indicate use in respect of the goods above, but the evidence is very limited.

roofing materials, not of metal; roofs and roofing materials; non-metallic roofing materials; roofing underlayment; roofing membranes

47. At the hearing, Mr Traub submitted that the categories of goods above comprise the proprietor's core goods. It is clear from the evidence, particularly the combination of the brochures, the invoices and purchase orders, and the sales figures, that the mark has been used in respect of goods falling within these categories. This includes use in respect of flat roofing systems and materials such as underlay and membranes, as well as clay tiles and liquid waterproofing treatments for roofs, all of which will fall within the categories above. I find there has been use of the mark in respect of the above goods during both the relevant time periods.

Non-metallic building materials; non-metallic waterproofing materials; non-metallic building materials having insulation properties; building materials of plastics material; construction elements of plastic

48. From the evidence provided, I am able to identify the use of the mark or an acceptable variant in respect of goods including clay roof tiles, roofing systems and waterproofing and sealing goods and roofing felts, which include those made of polyurethane and plastic films. I find these goods will fall within the categories of goods outlined above, and as such I find use of the mark in respect of the same within both of the relevant time periods.

asphalt, pitch and bitumen; asphalt, pitch, bitumen and preparations made from these materials (other than paints) for use in building and construction; flat roofs, not of metal, in particular flat sealings, namely bitumen webs, liquid sealings, plastic sealings; roof coverings, not of metal, in particular clay roof tiles, concrete roofing tiles, slate, fibre cement, double web panels, bitumen; fittings, not of metal, for high pitched roofs, in particular underfloor webs, insulating membranes; tiles; bituminous sealing membranes; sealants; roofing felt; tarred felts; felt roof coverings; asphalt roofing felt; liners of plastic material; pvcu roofing products

49. At the hearing, Mr Traub submitted that although he was no expert, he believed that bitumen was used for binding felt, and that asphalt falls under the broader category of bitumen. I accept that asphalt may also be referred to as bitumen. Having no submissions on 'pitch' and being unable to find reference to this in the evidence, I am unable to find that use has been made in respect of the same. I find from the evidence that bitumen roofing felts are offered under the mark or an acceptable variant within the first relevant time period in the dated brochure from May 2015, and I note the continuing turnover figures, and I therefore accept there has been use of the mark in respect of these goods. I also accept that there has been use of the mark in respect of the clay tiles referenced, but I can find no use of the mark in respect of *concrete roofing tiles, slate or fibre cement* and without further evidence it is unclear what would constitute use of *double web panels* or *underfloor webs* as listed. Further, I cannot find evidence of the mark being used in respect of items made from 'pvcu' in particular. As I have found use in respect of bitumen roofing felts, I also find use of the mark in respect of the broader categories of roofing felt, felt roofing covers and asphalt roofing felt.

flat roof fittings, not of metal, in particular [...] roof edging systems, covers for terraces;

50. From the evidence provided, it appears that the use of the mark in respect of the PU terrace products, as well as the *Edge Corrosion and coating systems*, both of which are offered under the mark, or an acceptable variant of the same, would fall under the categories of goods above. Whilst the evidence is less precise than it could be in respect of the edging systems, and whilst I note that some of these appear to be metal and as such do not fall into the category above, it also appears that a SIGnature cut edge protection is offered under the SIGnature liquid waterproofing systems. On balance, it appears likely that at least limited use of these were made during the two relevant periods.

rendering compositions for use in building; rendering compositions for use in construction; renderings; adhesive mortar for building purposes;

51. At the hearing, Mr Traub submitted that rendering is the process by which the roof is formed, and as such there is use of the goods relating to render. However, I see no evidence that this is the case, and without further evidence on this I am unable to accept this submission. I see no evidence that these goods are supplied under the mark. Further, I see no reference to adhesive mortar being supplied under the mark.

parts, fittings and accessories for all the aforesaid goods; but not including pipes, tubes, couplings, joints for all the aforesaid goods; parts and fittings for the aforesaid goods.

52. All of the above goods are followed either by the term *parts, fittings and accessories for all the aforesaid goods; but not including pipes, tubes, couplings, joints for all the aforesaid goods*; or alternatively, by parts and fittings for the aforesaid goods. As the majority of the goods are subject to repetition within the specification, most are included without the additional limitation in respect of pipes, tubes, couplings and joints at least once. Whilst I understand that use of the goods themselves do not need to be found in order to find use of the parts and fittings of the same, where I have found no use of the mark in

respect of the goods above, I have also found no use of the mark in respect of the parts and fittings as described.

Genuine use

53. Where I have found no use of the mark in respect of the goods within the relevant timeframe, it follows that there has been no genuine use in respect of the same. Where I have found there to be some use of the mark in respect of the goods and within the relevant timeframe, I will now consider if I find that use to be genuine use sufficient to maintain the protection held under the mark.

54. The goods for which I have found there has been some use of the relevant mark within the relevant timeframe are as follows:

Class 19: Non-metallic building materials; non-metallic waterproofing materials; non-metallic building materials having insulation properties; building materials of plastics material; construction elements of plastic; roofing materials, not of metal; roofs and roofing materials; non-metallic roofing materials; roofing underlayment; roofing membranes; asphalt, [...] and bitumen; asphalt, [...] bitumen and preparations made from these materials (other than paints) for use in building and construction; flat roofs, not of metal, in particular flat sealings, namely bitumen webs, liquid sealings, plastic sealings; roof coverings, not of metal, in particular clay roof tiles, [...] bitumen; fittings, not of metal, for high pitched roofs, in particular [...] insulating membranes; tiles; bituminous sealing membranes; sealants; roofing felt; felt roof coverings; asphalt roofing felt; liners of plastic material; non-metallic rigid pipes for building; guttering; guttering, not of metal, in particular gutters, down pipes.

55. As I have mentioned, I found only very limited use of the mark in respect of the goods *non-metallic rigid pipes for building; guttering; guttering, not of metal, in particular gutters, down pipes*; by way of references on 2 purchase orders in 2018, and it is not entirely clear that even this is use of the mark in respect of

the goods. Whilst it is possible that there have been extensive sales in respect of these goods, I am unable to determine this from the evidence that has been provided. I remind myself that there is no de minimus rule when it comes to establishing genuine use, and I note that the sale of these goods appears entirely consistent with the proprietor's business, and as such I do not find this to be token use for the sake of preserving their rights only. However, I also note that not every case of commercial use can also be found to be genuine use, and it is my view that in this instance and from the sum of the evidence, even if this is use in respect of the goods, I cannot determine the scale, frequency or extent of the use in respect of the same, and I cannot determine that the use has been made for the purpose of creating and maintaining a real market share in respect of these goods. I therefore do not find genuine use in respect of the same.

56. In respect of the goods including tiles and clay tiles, I find the sum of the evidence provides a much clearer picture of the use made of these. I note in particular the brochure showing clearly the use of the mark or an acceptable variant in respect of the handmade and machine-made clay tiles provided. In addition, I note the UK turnover figures provided in respect of these goods under the mark for the years 2014 to August 2020. These figures are fairly substantial, with a turnover of over 1 million GBP achieved in respect of these goods in 2015 and 2016, and over 2 million in 2017, 2018 and 2019. Whilst it is clear that only a portion of the 2020 figures provided fall inside of the 2020 turnover figures of just over 1.7 million up to August that year, it is reasonable to assume at least a portion of this figure may be attributed to each. Considering the sum of the evidence provided, it is my view that there has been genuine use of the mark in respect of the tiles and clay tiles.

57. In respect of the goods *asphalt, [...] bitumen and preparations made from these materials (other than paints) for use in building and construction and roofing membranes*, I note these products are provided as part of the torch on systems offered under the mark, including the SIGnature bitumen roofing felts. A material data sheet for this product is provided dating back to May 2015, and

UK turnover figures for 'Signature felt' are provided between 2015 to 2020. The figures begin at over 400,000 GBP in 2015, increasing steadily to approximately 1.4 million in 2018 and 2019. Whilst again, the 2020 figures provided up until August will include turnover falling outside of the relevant timeframe, it is reasonable to assume again from the previous years figures that at least a portion of the 2020 turnover which is given at just over 700,000 GBP up until August that year, will fall within both relevant time periods. I note in addition, that consistent reference is made to the goods the *roofing underlayment* in the invoices provided. Whilst the specific turnover figures for these goods do not appear to be defined, from the sum of the evidence, including clear use of the mark in respect of the underlay options shown in Exhibit AW04, as well as the consistent reference to these goods in the invoices and purchase orders, in addition to the SIGnature underlay data sheet dating from May 2015, within the first relevant period and predating the second, on balance I find there has been genuine use of the mark in respect of these goods. Further I note from the evidence at Exhibit AW04 that the SIGnature underlay²⁵ is described as a "a polyester carrier coated with SBS rubber modified bitumen". It is my view these products may also be reasonably described as *liners of plastic material* and I therefore also find genuine use has been made in respect of goods falling under this category.

58. In respect of the sealings, including the liquid and plastic sealings, I note the evidence provided at Exhibit AW04 detailing the SIGnature PU Joint Sealer. This is described as a "low modulus expansion joint sealant, formulated to contain both polyurethane (PU) and silylated-PU technology, and modified to provide enhanced thixotropic properties." Whilst the brochure itself is undated, reference to this product is also made in the BBA Approval Inspection Testing Certification dated 31 October 2019, where this product is named as a product that may be used with the product being tested. Further, I note there is reference to sealants provided under the SIGnature corrosion and coating system, stating:

"The SIGnature Edge Corrosion and Coating System comprises fast curing polyurethane liquid joint sealants, primers and fibrous coatings,

which are applied over existing roofing systems to create a durable and seamless waterproofing layer.”³

59. Further, I find the SIGnature PU liquid waterproof also provides a waterproof seal over the flat roofs fitted, and these goods may also be considered as the sealings and sealants referenced. These are referenced in a brochure dated 31 October 2019, which falls within both relevant periods. I note that the SIGnature PU Edge and corrosion application guide as provided within Exhibit AW04 has been dated 3 December 2018 by Mr Williamson in witness statement,⁴ which falls inside of both relevant periods. In respect of the extent of the use made of these goods, Mr Williamson has provided turnover figures for what are described as “Signature PU”. It appears that the turnover figures for the full ‘PU’ range under the mark has been grouped together. I can see from the evidence that this includes a number of different products in addition to those I have mentioned. However, as I am able to date the use of the sealants back to at least December 2018, I find it is reasonable to assume at least a portion of the just over 487,000 GBP turnover from 2019 and a portion of the just over 150,000 turnover from the first part of 2020 may be attributed to the sale of the sealant products. Whilst I find that the use may not therefore be of a high volume, and although it appears to be weighted towards the end of the relevant period, with consideration to all of the evidence provided, on balance I find there has been genuine use of the mark in respect of sealants, as well as liquid and plastic sealings in respect of the two relevant time periods.

60. The terms *Non-metallic building materials; non-metallic waterproofing materials; non-metallic building materials having insulation properties; building materials of plastics material; construction elements of plastic; roofing materials, not of metal; roofs and roofing materials; non-metallic roofing materials*; cover goods for which I have found there has been genuine use above, and I therefore find genuine use of the mark within the relevant time frames in respect of these broader terms.

³ Page 38

⁴ See table at paragraph 9

Fair specification

61. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

62. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), the late Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

63. As I have mentioned, Mr Traub submitted that the specification of goods in class 19 should be retained in full, even where no use of the mark has been made in respect of the goods. He referred me to *Titanic*, submitted as follows:

- (1) On the basis of the use in respect of the different roofing solutions including clay tiles, PU liquids, roof lights and the torch on roofing system, all of which fall under the category of building materials, the proprietor should retain its protection for the broader categories of building materials covered in the specification. Although the main use of the mark is in respect of roofing, the consumer would not make this distinction; and
- (2) The proprietor should retain its protection within its specification for the specific goods listed which are closely related to those for which they are using, even though they have not made use of the mark for those goods, on

the basis that they either broadly shared a purpose, or on the basis that the consumer would expect these to be provided from by the same undertaking as the proprietors goods and/or they fall within the category of building materials.

64. In respect of the second point above, Mr Traub used the example of windows and doors. He submitted that the proprietor provided windows in the form of rooflights, and if these opened, they may be used like doors. He also submitted that the consumer would expect windows and doors to be offered by the same provider. I find the reasoning given by Mr Traub on this point, based apparently on his interpretation of *Titanic*, to be incorrect. The late Mr Justice Carr did not set out in *Titanic* that protection should be maintained for the specific goods for which the proprietor has not made use of the mark, but that the consumer may assume would derive from the same economic undertaking. Whilst the perception of the consumer is undoubtedly important to this assessment, this relates to instances where a broader category of goods has been registered, and genuine use has been made of the mark within that broad category. It is then that I must ask, in line with *Thomas Pink* and as reiterated in *Titanic*, how the consumer would fairly describe the goods that have been used. Although this will therefore clearly be a consideration in respect Mr Traub's first point above, there is no basis on which I should consider whether 'doors' should be maintained within the specification despite there being no use of the same, even if I were to have found genuine use for windows had been shown, for example. I also do not need to consider if doors, for example, as included as an individual term within the specification and for which no use has been found, fall under the separate term of non-metallic building materials. I do not, therefore, need to revert back to the full class 19 specification and re-examine this for goods which are close to the other goods for which use have been made. However, I do need to determine a fair specification in relation to the goods for which there has been genuine use of the mark.

65. I therefore consider Mr Traub's first point above. The terms *Non-metallic building materials; non-metallic building materials having insulation properties; building materials of plastics material; construction elements of plastic;* may

cover a huge array of goods. It is my view that these terms are capable of being broken down into a vast number of subcategories. I note the proprietor has made use of the mark in respect of roofing items such as clay tiles, flat roofing systems and waterproofing liquids for roofs. Whilst, with consideration to the case law set out, I do not feel it is appropriate to reduce the protection to these specific goods only, it is my view that the categories *Non-metallic building materials; non-metallic building materials having insulation properties; building materials of plastics material; construction elements of plastic* offer protection that is too broad for the use made. It is my view that the consumer of the goods, those being mainly professionals in the trade but also DIY enthusiasts, would fairly describe the goods as *roofs* where the full systems are provided, and *roofing materials* where it is not. I therefore find the wording included elsewhere in the proprietor's specification offers a fair level of protection in place of these broad categories, namely *roofs and roofing materials*.

66. Whilst I note the proprietor may fairly maintain the narrower categories of *roofing materials, not of metal; non-metallic roofing materials; as well as non-metallic roofing materials having insulation properties* (limited from *non-metallic building materials having insulation properties*) and *roofing materials of plastics material* (in replacement of *building materials of plastics material; construction elements of plastic*) these will simply offer identical but more limited protection to the *roofs and roofing materials* as set out previously.

67. In respect of the goods *non-metallic waterproofing materials* I note these will also cover a fairly broad range of different goods within this class. Again, I do not feel it would be appropriate to limit the specification only to the specific liquid waterproofing items offered, but I do find that the average consumer, often being a member of the trade or a DIY enthusiast, would fairly describe these products as waterproofing materials for roofs. I note the limitation of 'non-metallic' on this term, and I find it would be inappropriate to broaden the protection under this term, and so I find *non-metallic waterproofing materials for roofs* to be a fair description of the goods.

68. The remaining terms including under the proprietor's specification and for which genuine use has been found are more specific, and I find the proprietor may retain its specification for the goods as described.

Final remarks

69. The cancellation applicant has achieved partial success under section 46(1)(a) and 46(1)(b), resulting in partial revocation of the proprietor's class 19 specification. In addition to the unchallenged goods in classes 6 and 17, the proprietor may retain its protection for the following goods in the challenged class 19:

non-metallic waterproofing materials for roofs; roofs and roofing materials; non-metallic roofing materials; non-metallic roofing materials having insulation properties; roofing materials of plastics material; roofing underlayment; roofing membranes; asphalt and bitumen; asphalt and bitumen and preparations made from these materials (other than paints) for use in building and construction; flat roofs, not of metal, in particular flat sealings, namely bitumen webs, liquid sealings, plastic sealings; roof coverings, not of metal, in particular clay roof tiles, bitumen; fittings, not of metal, for high pitched roofs, in particular insulating membranes; tiles; bituminous sealing membranes; sealants; roofing felt; felt roof coverings; asphalt roofing felt; liners of plastic material; parts and fittings for all of the aforesaid goods.

70. The remaining goods in class 19 will be revoked from the earliest date requested under section 46(1)(a), that is from 21 February 2020.

Costs

71. Both parties have achieved a measure of success in these proceedings. However, I find the cancellation applicant has achieved more success than the proprietor, and in the circumstances the cancellation applicant entitled to a contribution towards its costs. I award therefore award the cancellation applicant the sum of £875 as a contribution towards the cost of the proceedings.

This figure is inclusive of a 30% discount of the total costs to account for the success of the proprietor. A figure of under the £500 scale cost is attributed to the evidence in this instance, as I note the cancellation applicant did not file any of its own but has undoubtedly incurred costs for considering proprietor's extensive evidence filed. The sum is calculated as follows:

Official fees:	£200
Preparing statement and considering counterstatement	£300
Considering the proprietor's evidence	£350
Preparing and filing written submissions	£400
30% reduction for proprietor's success	-£375
Total	£875

72. I therefore order SIG Trading Limited to pay The Amtico Company Limited the sum of £875. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of July 2021

**Rosie Le Breton
For the Registrar**