

O/790/21

TRADE MARKS ACT 1994

APPLICATIONS 503357 – 503361

BY BRISTOL FIGHTER LIMITED

TO REVOKE THE TRADE MARKS REGISTERED

UNDER NUMBERS 2643558, 120663, 2316295, 2624873 & 2424875

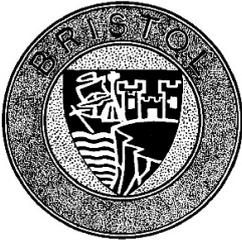
IN THE NAME OF KAMKORP AUTOKRAFT LIMITED

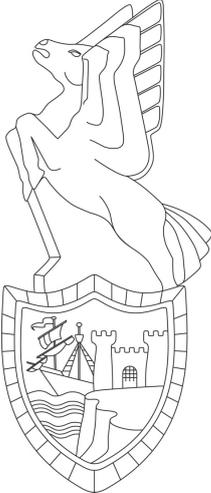
FOR NON-USE

Background and pleadings

1. On 29th September 2020, Bristol Fighter Limited (“the applicant”) applied under section 46(1)(a) and/or (b) of the Trade Marks Act 1994 (“the Act”) to revoke five trade marks registered in the name of Kamkorp AutoKraft Limited (“the proprietor”) for non-use.

2. The marks covered by the applications for revocation are shown in the table below.

<u>Trade mark</u>	<u>Registration date</u>	<u>Period of non-use and revocation date sought</u>	<u>Class(es) of goods/services</u>
<p>2424875</p> <p>Bristol (series of 2 with)</p> <p>Bristol Cars</p>	<p>26th January 2007</p>	<p>15th April 2011 to 14th April 2016</p> <p>15th April 2016</p>	<p>Class 12</p>
<p>2624873</p>  <p>(series of 4 substantially identical script marks)</p>	<p>23rd May 2014</p>	<p>24th May 2014 to 23rd May 2019 and 2nd September 2015 to 1st September 2020</p> <p>24th May 2019 and 2nd September 2020</p>	<p>Class 12</p>
<p>1206663</p> 	<p>7th November 1983</p>	<p>15th April 2011 to 14th April 2016</p> <p>15th April 2016</p>	<p>Class 12</p>

<p>2316295</p> <p>BRISTOL FIGHTER</p>	<p>30th May 2003</p>	<p>15th April 2011 to 14th April 2016</p> <p>15th April 2016</p>	<p>Classes 9 & 12</p>
<p>2643558</p> 	<p>8th March 2013</p>	<p>9th March 2013 to 8th March 2018 and 2nd September 2015 to 1st September 2020</p> <p>9th March 2018 and 2nd September 2020</p>	<p>Classes 3, 6, 9, 12, 14, 18, 21, 22, 24, 25, 28 & 35</p>

3. The proprietor filed counterstatements denying the grounds for revocation and claiming that:

“The Proprietor has licensed and/or has consented to the use by third parties of [the contested marks] in relation to all goods and services during the periods relied upon in the form TM26(N) by the Cancellation Applicant.

The Proprietor will rely on use at least in the following forms:

Goods produced and/or offered for sale by third parties under licence from the Proprietor.

Goods produced and/or offered for sale by third parties affiliated to the Proprietor

Goods produced and/or offered for sale by third parties in collaboration and/or under instruction from the Proprietor.”

Representation

4. The applicant is represented by Gallafents Limited. The proprietor is represented by BDB Pitmans LLP. A Hearing took place on 6th September 2021 at which Mr Michael Edenborough QC appeared (via video link) as counsel for the applicant. Mr Edward Bragiel appeared (also via video link) as counsel for the proprietor.

The evidence

5. The applicant's evidence consist of two witness statements. One by Mr Jason Wharton and one by Mr Richard Gallafent. Mr Wharton is a director of Bristol Fighter Limited, a company set up to revive the long-established Bristol car marque. The relevant parts of Mr Wharton's evidence go to (a) the recent history of Bristol Cars, including that the original company went in administration in 2011, (b) that the current proprietor purchased assets from the administrator with a view to reviving the brand, (c) his own interest in purchasing a new Bristol car from a company associated with the proprietor, and (d) the reasons he did not do so and believes that the proprietor failed in its attempts to bring products to market under the Bristol brand. Mr Gallafent is an attorney at Gallafents, the applicant's legal representatives. His statement is a vehicle through which the applicant puts into evidence the annual returns and accounts of the two companies (Bristol Cars Limited and Bristol Cars Services Limited) the proprietor claims conducted business under the contested marks during the alleged periods of non-use.

6. The proprietor's evidence consists of two witness statements by Mr Sheban Siddiqui, a director of the company. Mr Siddiqui's evidence goes to:

(a) the company acquiring the intellectual property rights of Bristol Cars Limited from the original company's administrators in 2011 with a view to producing a range of electric vehicles under the Bristol marks;

(b) the group of companies of which the proprietor is a member;

(c) the proprietor's role in holding the group's IP whilst other members of the group, including Bristol Cars Limited and Bristol Cars Services Limited (or "BCSL"), traded in land vehicles and replacement parts/fittings, as well as providing maintenance and repair services, under the Bristol marks during and subsequent to the alleged periods of non-use;

(d) third parties being licensed to use the Bristol marks in relation to merchandise.

Mr Siddiqui evidence under (c) above includes the amounts claimed to have been spent promoting the contested marks, and also information about a prototype Bristol car that was developed and shown to the public.

7. On 26th July 2021, the applicant made an application for leave to cross examine Mr Siddiqui on his evidence. The relevant issues put forward as justifying cross examination included:

(a) Whether the witness had first-hand knowledge of the matters about which he had given evidence;

(b) Where the material exhibited to his statements had come from;

(c) A lack of clarity about the relationship between the Proprietor and other companies identified as being part of a "Group";

(d) A lack of clarity about the license structure described in his first witness statement;

(e) The absence of any evidence of actual sales supporting the claimed use of some of the Bristol marks in relation to *"lifestyle merchandising including clothing and other accessories"*, save for a single purchase by a Director of the cancellation applicant, required an explanation.

8. In support of its request for cross examination, the applicant pointed out *“that one of the matters which needs to be decided is the extent to which any alleged use of the marks was with the Proprietor’s consent.”*

9. On 3rd August 2021 the applicant was given permission to cross examine Mr Siddiqui via a videoconference link. Mr Siddiqui was ordered to make himself available for such cross examination.

10. On 3rd September 2021, (i.e. the last working day before the hearing) the applicant withdrew its request to cross examine Mr Siddiqui.

The law

11. 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 is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(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”.

12. Section 100 of the Act is also relevant, which states:

“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.”

13. 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.

14. In *Walton International Ltd & Anor v Verweij Fashion BV*,¹ Arnold J. (as he then was) 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 Bunderversammlung 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];

¹ [2018] EWHC 1608 (Ch)

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].”

Trade mark 2316295 - BRISTOL FIGHTER

16. The proprietor accepted at the hearing that the evidence filed showed no use of Bristol Fighter and therefore the registration of this mark would be revoked for non-use.

Trade Marks 2424875, 2624873, 1206663 & 2643558 in relation to goods in class 12

17. These trade marks consist of the words BRISTOL/BRISTOL CARS - TM2424875, four versions of the word BRISTOL in cursive script (“the script marks”) – TM2624873, a circular badge mark including a shield and the word BRISTOL (“the Bristol badge mark”) – TM120663 and the Pegasus and shield device - TM2643558. All the marks, except the Pegasus and shield device mark, are registered only in class 12 for *Land vehicles and parts and fittings therefor*. As well as I being registered in other classes, the latter mark has a wider class 12 specification, namely;

Vehicles; apparatus for locomotion by land, air or water; wheelchairs; motors and engines for land vehicles; electric cars; electric motors for motor cars; racing cars; racing motor cars; sports cars; vehicle body parts and transmissions; automobiles and structural parts thereof; wheels and tyres for and wheel rims of automobiles; covers (shaped-) for motor cars; car seat covers (shaped or fitted); sun blinds adapted for automobiles; pannier bags.

18. The relevant five year period for trade marks 2424875 and 1206663 is 15th April 2011 to 14th April 2016. Two relevant periods are specified for trade mark 2624873, the later one being 2nd September 2015 to 1st September 2020. However, section 46(3) of the Act requires an application for revocation to be refused if genuine use of the mark “...commenced or resumed after the expiry of the five year period and before the application for revocation is made”, except 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.”

19. In practice, this means that it is sufficient for the proprietor to show genuine use of the contested marks prior to, at the earliest, 28th June 2020 (i.e. three months before the applications for revocation were filed).

20. I find it convenient to examine the evidence of use of these marks together.

21. Mr Siddiqui gives evidence that the proprietor is a member of a group of companies for which it holds the intellectual property, including the marks at issue. The proprietor is a subsidiary of Kamkorp Limited. The group also includes Bristol Automotive Group Limited and its subsidiaries, Bristol Cars Limited and Bristol Cars Services Limited. In early 2020, all these companies, except the proprietor itself, were placed in liquidation.

22. Bristol Cars Limited and Bristol Cars Services Limited were incorporated in 2011. They bear the same names as two companies which were by then in administration under new names (“the original Bristol companies”). The original Bristol Cars Limited was incorporated in 1947. It is common ground that it had a long history of manufacturing premium motors cars under the Bristol marque. The original companies had a longstanding retail showroom on Kensington High Street, London, and a service garage on Great West Road, London. The original company ceased business in March 2011 when the administrators closed its manufacturing facility in Bristol, thereby making its 19 employees redundant.

23. Mr Siddiqui’s evidence is that the proprietor purchased the intellectual property of the original Bristol companies for around £750k, £500k of which was for their trade

marks. There is no dispute that the proprietor purchased the IP of the original companies. Indeed, the applicant's principal witness, Mr Wharton, exhibited to his first statement a copy of administrators' report to the creditors² showing that the proprietor paid £500k for "*Goodwill and Intellectual Property Rights*" and around £250k for "*Trademarks*". I note that the report also records that the proprietor paid £1m for "*Stock, Plant & Machinery, and Spare Parts.*"

Use of the marks in relation to second-hand cars and/or parts and fittings therefor

24. According to Mr Siddiqui, the Bristol showroom on Kensington High Street and the service facility on Great West Road were maintained after the proprietor purchased the IP of the old Bristol companies. A picture of the showroom with the Bristol cursive script mark on the signage, said to date from 2018, is in evidence.³ I also note Mr Wharton's evidence that after joining the Bristol Owners Club in December 2014, he received a copy of a press release issued by Bristol Cars Limited in September 2014. A copy of the document is in evidence.⁴ It bears the Bristol badge mark and includes several references to 'Bristol Cars'. The press release announced, amongst other things, that plans were under way to refurbish the Bristol showroom at 368 Kensington High Street for the sale of restored cars, and open a new showroom at 375 Kensington High Street for the sale of a new Bristol vehicle planned for 2015. The release also stated that a new specialist Parts, Service and Restoration facility in Brentford, West London, opened earlier in 2014 had "*quickly established itself as the leading Bristol centre in the world with hundreds of cherished examples of the marque already passing through the workshop.*"

25. It appears from the Liquidator's report exhibited to Mr Wharton's statement⁵ that Bristol cars maintained a lease on 368 High Street Kensington until it went into liquidation. BCSL appears to have moved its service facility to a location in Surrey in 2016.

² See exhibit 6 to Wharton 1

³ See exhibit SKS4

⁴ See exhibit 19 to Wharton

⁵ See exhibit 34 to Wharton

26. Mr Siddiqui's evidence includes some invoices for goods and services sold under some of the contested trade marks.⁶ At the hearing my attention was drawn to:

(a) An invoice dated 17th March 2016 issued by Bristol Cars Limited bearing the Bristol badge mark (and the company name) for the sale of a Bristol 411 Series 6 for £52k. The customer's details have been redacted. I note the car was "*Sold as seen*" without a warranty, indicating that this was a second hand vehicle.

(b) A 'parts invoice' dated 16th August 2013 issued by Bristol Cars Services Limited bearing the Bristol badge mark (and the company name) for the sale of a condenser for around £17. Again, the customer's name has been redacted.

(c) An invoice dated 3rd May 2016 issued by Bristol Cars Services Limited bearing the Bristol badge mark (and the company name) for the sale of two disc brakes for £240. Again, the customer's name has been redacted.

(d) A 'service invoice' dated 2nd May 2018 issued by Bristol Cars Services Limited bearing the Bristol badge mark (and the company name) for the service and MOT of a car at a cost of around £2k. Again, the customer's name has been redacted.

27. According to Mr Siddiqui, the website bristolcars.co.uk was obtained in 2012 and remained fully operational until the company went into liquidation in 2020. Excerpts from the website obtained from the WayBack Machine archive site are in evidence.⁷ These include the home page from the website at April 2013, which shows use of the Bristol badge (and the company name) with links to further web pages entitled 'sales' and 'servicing'.

28. None of this evidence is seriously challenged. Indeed, the applicant's witness, Mr Gallafent, filed publicly available accounts for Bristol Cars Limited and Bristol Cars Services Limited covering the period 2013 to 2018 showing that:

⁶ See exhibit SKS7 to Siddiqui 1

⁷ See exhibit SKS9 to Siddiqui 1

(a) Bristol Cars Limited principal business was recorded as being *“the restoration, buying and selling of motor vehicles, sale of spare parts and merchandising.”*

(b) The company’s turnover was approximately:

(i) £1.5m in the year ending June 2013;

(ii) £2.3m between June 2013 and December 2014;

(iii) £860k in the year ending December 2015;

(iv) £620k in the year ending December 2016;

(v) £85K in the year ending December 2017.

(c) At the end of 2017 and 2018, the company held stock valued at around £100k and £70k, respectively.

(d) Bristol Cars Services Limited principal business was recorded as being *“the servicing and repair of motor vehicles and the sale of spare parts.”*

(e) The company’s turnover was approximately:

(i) £670k between June 2013 and December 2014;

(ii) £620k in the year ending December 2015;

(iii) £630k in the year ending December 2016;

(iv) £420K in the year ending December 2017.

(f) At the end of 2017 and 2018, the company held stock valued at around £175k and £170k, respectively.

29. Additionally, Mr Wharton filed a copy of a letter dated 1st December 2015 sent to him by Bristol Cars Limited bearing the Bristol badge (and the company name). The letter sought to draw his attention to the fact that the company’s new Brentford based

service facility was fully operational *“offering comprehensive facilities for all Bristol models..”* including *“a routine service, a parts purchase, upgrades or a full restoration.”* I also note that the copy of the Liquidator’s report for Bristol Cars Limited dated March 2021 (also filed by Mr Wharton) states that *“There remains a number of motor vehicles owned by the Company which have not been sold. I have been advised...that in order to achieve maximum value from these sales, we need to await the completion of the sale of ‘Bristol Cars’ trademark.”* As Bristol Cars Limited does not appear to have made any new production cars before it went into liquidation, it seems likely that these were second hand Bristol vehicles made by the original company. It therefore appears that Bristol Cars Limited still owned vehicles bearing one or other of the Bristol trade marks when it went into liquidation.

30. On the basis of the above, I find that there was use of BRISTOL, BRISTOL CARS, the Bristol badge mark, and the cursive script marks in relation to second hand motor cars, and use of the first three of these marks in relation to replacement parts for motor cars and car servicing. Such use occurred both during and subsequent to the relevant periods.⁸

Use of the marks in relation to new cars

31. According to Mr Siddiqui, the Kamkorp group invested a considerable amount to develop the Bristol brand and create new cars, trucks and buses, including new electric and hybrid cars. He says that the advertising and marketing expenditure in the period 2012 to 2018 was between £60k -£80k per annum. As examples of this activity he provides:⁹

- (a) An excerpt from brand guidelines from 2014, including the Bristol badge and one of the cursive script marks.

⁸ Mr Bragiel asked me to infer that the Bristol badge had also been used on the bonnet of the second hand cars sold during the relevant periods. There is no evidence of this and I have not inferred as much.

⁹ See exhibit SKS6 to Siddiqui 1

(b) An excerpt from a specification guide created in 2015 for a Bristol Bullet sports car bearing the Bristol badge (on the guide) and one of the cursive script marks on the bonnet of the 'prototype' car pictured in the guide.

(c) An excerpt from the Bristol Superlight Truck brand guidelines from August 2016 bearing the cursive script marks (it is not clear from the guidelines themselves that the 'Superlight' was intended to be a truck).

(d) An excerpt from the a 'Kamkorp presentation' dated 2016, which includes a picture of a truck said to be the Bristol Superlight.

(e) An excerpt from the Bristol Blenheim Hybrid SUV brochure from 2016 drawn up by F & F Design Studio showing a computer generated image of an SUV bearing (on the radiator grill) the Pegasus and shield device registered under 2643558.

(f) A 'Bristol Bus proposal' dated 2017 showing one of the cursive script marks. It is not clear whether the mark was used in relation to any particular goods. This is because most of the document has been redacted.

32. Mr Siddiqui provides examples of media reports about new Bristol cars.¹⁰ This includes:

(a) An article in the motor publication 'Car and Driver' dated 3rd June 2015 which reported that a new car was being developed in the UK under the codename Project Pinnacle that would be a "*range-extended electric grand tourer.*" The article also noted the involvement of Fraser Nash in the development of the new car.

(b) An article from The Times dated 29th June 2016 reporting that Bristol Cars had produced its first new model for more than a decade. It included a picture of two seater sports car that was to be called the Bullet that would be powered by a BMW V8 petrol engine. Similar articles appeared shortly thereafter in The Telegraph, Top Gear online, the BBC's website, Top Speed, and Autocar

¹⁰ See exhibit SKS5

online. The latter article includes a quote from someone called Noamaan Siddiqui who is reported to have said that the company had already sold “quite a few” of the planned 70 cars to loyal Bristol collectors.

33. The press release issued by Bristol Cars Limited in September 2014 (see paragraph 24 above) announced that the company was to introduce a new car. Mr Wharton says that when he received this in 2015 his interest in acquiring a Bristol car changed from obtaining a second hand model to purchasing a new car. He subsequently received two further press releases dated May 2015 and July 2016 issued on behalf of Bristol Cars.¹¹ The first of these announced that the car would be powered by a BMW engine. The second press release stated that the car was to be called the Bristol Bullet. It included details of the car’s specification, including its dimensions, weight, power output and performance figures. Mr Wharton says that it was accompanied by a brochure showing a photograph of the car.

34. After receiving a letter dated 1st December 2015¹² (bearing the Bristol badge mark and the company name) from the Sales Manager of Bristol Cars telling him that a new model under the name Project Pinnacle was in the phase of pre-launch testing, Mr Wharton says that he met with her in May 2016 and viewed the Bristol Bullet prototype car in an aircraft hangar. He was not allowed to drive the car or look under the bonnet. However, he subsequently received an email covering a letter with an order form, copies of which are in evidence.¹³ The letter states that:

“I am sure that the limited build run of 70 cars will soon be reserved so as an early adopter you can be assured of being high up on the list. At this stage the deposit just guarantees you the build slot and nearer the time we can have the exciting prospect of choosing gearbox, colours, trim etc. You will find attached an order form which, providing you are happy, you should sign and send over a deposit of £20,000. The deposit will secure you the build slot and is refundable up until the specification is agreed and processed.”

¹¹ See exhibits 20 to 22 to Wharton

¹² Exhibit 23 to Wharton

¹³ See exhibit 24 to Wharton

The letter concluded:

“We are now in full on planning for the launch which should be first week September so do keep your diary free and I will be in touch with an invitation in due course.”

The order form included an indicative price of £220k with an estimated delivery date of ‘2017’.

35. Mr Wharton says he was suspicious about whether the car shown to him was really a working motor car with an engine. After taking legal advice about the terms and conditions offered, he decided against completing the order form.

36. In his second witness statement, Mr Siddiqui claims that the decision not to show Mr Wharton the engine of the prototype car was simply due to the company planning events with its proposed engine supplier, which it did not want to pre-empt by showing the engine to Mr Wharton. Mr Siddiqui says that the car shown to Mr Wharton was a working prototype. He claims that it was subsequently driven by the press and that there are multiple videos of the functioning car. He does not provide any such videos. However, Mr Siddiqui does provide a brochure for the Bristol Bullet from 2016 which includes a shot of the engine. I note that the brochure also includes significant detail about the interior and exterior design features and options.¹⁴

37. On the basis of the above, I find that there was external use of the BRISTOL, BRISTOL CARS, Bristol badge and cursive script marks during and subsequent to the relevant periods in relation to motor cars the proprietor was developing and planned to sell under these marks.

38. The only evidence of use of the Pegasus and shield mark in relation to class 12 goods is in the Bristol Blenheim Brochure from 2016, which includes a computer generated image of an SUV bearing the mark on the radiator grill of the vehicle. However, there is no evidence as to who (if anyone) this brochure was shown to.

¹⁴ See exhibit SKS2 to Siddiqui 2

Consequently, there is no evidence of any external use of the Pegasus and shield mark in relation to any goods in class 12.

39. The only evidence of use of any of the marks in relation to trucks is the ‘Kamkorp presentation’ dated 2016, which as I noted above includes a picture of a truck said to be the Bristol Superlight. However, there is no evidence as to who (if anyone) this presentation was shown to. Consequently, there is no evidence of external use of the contested marks in relation to trucks.

40. There is no evidence of any use of the contested marks in relation to buses.

Application of the law on genuine use to the above facts

41. I do not think there is any doubt that use of any one of the four marks registered as a series under 2624873 also counts as genuine use of any one of the other three marks under section 46(2) of the Act. This is because they differ only “...*in elements which do not alter the distinctive character of the mark in the form in which it was registered.*”



42. Further, bearing in mind the ruling of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*¹⁵ that “...*the ‘use’ of a mark, in its literal sense, generally encompasses*

¹⁵ Case C-12/12

both its independent use and its use as part of another mark...”, I do not think there can be any doubt that use of BRISTOL CARS also counts as use of BRISTOL alone, at least in relation to cars and car parts.

43. Use of the Bristol badge mark also counts as genuine use of BRISTOL alone, if such use is “...perceived as indicative of the origin of the product at issue.”¹⁶ I note that registration 1206663 has an associated disclaimer that it “..shall give no right to the exclusive use of the word ‘Bristol’.” On 12 June 2019, the CJEU gave judgment in *Hansson*,¹⁷ and ruled that:

“Article 4(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as precluding national legislation making provision for a disclaimer whose effect would be to exclude an element of a complex trade mark, referred to in that disclaimer, from the global analysis of the relevant factors for showing the existence of a likelihood of confusion within the meaning of that provision, or to attribute to such an element, in advance and permanently, limited importance in that analysis.”

In the light of this judgment it is not appropriate to regard BRISTOL as a non-distinctive element of the BRISTOL badge mark, simply because of the disclaimer. Although it is a geographical name, the evidence indicates that it is perceived by average consumers as distinctive of a particular trade source for motor cars. Indeed, both parties interest in the marks appears to be based on their perception that BRISTOL has long been recognised as a trade mark for motor cars. In these circumstances it would be artificial to treat BRISTOL as non-distinctive for the goods at issue. I find BRISTOL would be perceived as an independently distinctive element within the BRISTOL badge, capable by itself of designating the trade origin of the goods. Therefore, use of the Bristol badge mark also counts as use of BRISTOL alone.

¹⁶ See paragraph 35 of the CJEU's judgment in *Colloseum Holdings*

¹⁷ Case C-705/17

44. In *Ferrari SpA v DU*,¹⁸ the CJEU was asked a series of questions arising from a dispute in Germany relating to the trade mark TESTAROSSA. Ferrari had registered the mark in relation to ‘*Vehicles; apparatus for locomotion by land, air or water, in particular motor cars and parts thereof.*’ DU contended that the registration should be revoked for non-use. Ferrari had used the mark to designate a particular sports car. However, it had not marketed any new cars bearing that mark for many years. Nevertheless, the proprietor continued to resell a small number of second hand cars bearing that mark, to service them, and to supply replacement parts. The referring court asked the CJEU to make a preliminary ruling on the following questions:

“(1) When assessing the question of whether use is genuine in terms of nature and extent within the meaning of Article 12(1) of [Directive 2008/95] in the case of a trade mark which is registered in respect of a broad category of goods, in this case land vehicles, in particular motor cars and parts thereof, but is actually only used in respect of a particular market segment, in this case high-priced luxury sports cars and parts thereof, is account to be taken of the market for the registered category of goods overall or may account be taken of the particular segment? If the use in respect of the particular market segment is sufficient, is the trade mark to be maintained in relation to that market segment in cancellation proceedings due to revocation?”

“(2) Does the sale of used goods which have already been released onto the market by the trade mark proprietor in the European Economic Area constitute use of the trade mark by the trade mark proprietor within the meaning of Article 12(1) of [Directive 2008/95]?”

“(3) Is a trade mark which is registered not only in respect of a product, but also in respect of parts of that product also used in a right-maintaining manner in respect of the product if that product is no longer sold, but there are still sales of trademarked accessory and replacement parts for the trademarked product sold in the past?”

¹⁸ Joined case C-720/18 and C-721/18

(4) When assessing whether there is genuine use, is consideration also to be given to whether the trade mark proprietor offers services which do not use the trade mark but are intended for the goods already sold?

45. In a judgment dated 22nd October 2020, the CJEU responded to these four questions with the following three answers:

1. Article 12(1) and Article 13 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a trade mark registered in respect of a category of goods and replacement parts thereof must be regarded as having been put to 'genuine use' within the meaning of Article 12(1), in connection with all the goods in that category and the replacement parts thereof, if it has been so used only in respect of some of those goods, such as high-priced luxury sports cars, or only in respect of replacement parts or accessories of some of those goods, unless it is apparent from the relevant facts and evidence that a consumer who wishes to purchase those goods will perceive them as an independent subcategory of the category of goods in respect of which the mark concerned was registered.

2. Article 12(1) of Directive 2008/95 must be interpreted as meaning that a trade mark is capable of being put to genuine use by its proprietor when that proprietor resells second-hand goods put on the market under that mark.

3. Article 12(1) of Directive 2008/95 must be interpreted as meaning that a trade mark is put to genuine use by its proprietor where that proprietor provides certain services connected with the goods previously sold under that mark, on condition that those services are provided under that mark.

46. At the hearing, Mr Edenborough submitted that the CJEU's second answer above (about sales of second hand cars under the trade mark) should be construed narrowly. According to Mr Edenborough, the CJEU's second answer in the *Ferrari* case does not apply to the facts in this case. This is because the current proprietor of the Ferrari mark also applied the Ferrari mark to the original cars when they were first placed on the market. The proprietor was therefore reselling goods for which it had been

responsible for first marketing. Mr Edenborough contrasted this with the facts in this case, as follows:

“...the current proprietor bought the trade mark's goodwill and parts from the original proprietor, which in essence fell away. It is not a successor in business in the sense that it is some continuation of those people who were originally responsible for the original product.”

47. During subsequent discussion, Mr Edenborough accepted that a change in legal ownership of a contested trade mark would not necessarily prevent the ruling in *Ferrari* from applying to the sale of second hand cars under that mark. For example, *Ferrari* would still apply where there had been a transfer of ownership of the trade mark within a group of companies, or the registered proprietor had re-incorporated itself as a new legal entity, provided there had been “*a continuation in corporate responsibility*” for the second hand goods. I think Mr Edenborough also accepted that *Ferrari* would apply where the new legal owner of a contested trade mark took over the warranties for the goods first marketed by the previous trade mark proprietor. This too would show the required “*continuation in corporate responsibility*” for the second hand goods.

48. I cannot accept these submissions for the following reasons. Firstly, the CJEU's ruling in *Ferrari* is not qualified in the way that Mr Edenborough contends it should be. Secondly, the suggested qualification has such a substantial effect that one would have expected the court to have included it, if that is what it intended. Thirdly, the CJEU's ruling goes to the issue of whether the use of a trade mark within the period for establishing genuine use counts as use of the mark ‘in relation to’ the second hand goods offered under that mark. The answer to this depends on whether consumers would regard the user of the mark as responsible for the quality of the goods. This does not depend solely on whether the goods are covered by a specific legal warranty. Fourthly, the CJEU has, albeit in other contexts, shown a marked reluctance to distinguish the rights and responsibilities of the current proprietor of a registered trade mark from those of previous proprietor: see *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd.*¹⁹ As the CJEU observed in that case:

¹⁹ Case C-259/04

“44. for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality (see, in particular, Arsenal Football Club, paragraph 48).

45. A trade mark such as ‘ELIZABETH EMANUEL’ may have that function of distinguishing the goods manufactured by an undertaking, particularly where that trade mark has been assigned to that undertaking and the undertaking manufactures the same type of goods as those which initially bore the trade mark in question.”

49. I therefore find that the use shown of the BRISTOL, BRISTOL CARS, the Bristol badge marks and the cursive script marks in relation to second hand motor cars originally placed on the market under those marks by the previous proprietor of the marks is capable of constituting genuine use of the marks in relation to motor cars in class 12.

50. Mr Edenborough further submitted that parts for cars would be regarded as an independent sub-category of goods covered by the term *Land vehicles and parts and fittings therefor*. Consequently, use of the marks in relation to car parts should not be accepted as use in relation to cars or land vehicles as such. The same applied to any use of the contested marks in relation to servicing of cars, which was not use of the marks in relation any of the registered goods.

51. I have some sympathy with these submissions. However, in the light of the CJEU’s judgment in *Ferrari* and its earlier judgment in *Ansul*,²⁰ I do not consider that it is open to me to accept them. The CJEU’s has made its position clear, not only in its formal answers to the questions referred to it, but also in its reasoning in *Ferrari* where it stated that:

²⁰ Case C-40/01

“34. The fact that a mark is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods (judgment of 11 March 2003, Ansul, C-40/01, EU:C:2003:145, paragraph 43).

35. It follows from that case-law that the use, by its proprietor, of a registered trade mark in respect of replacement parts forming an integral part of the goods covered by that mark is capable of constituting ‘genuine use’, within the meaning of Article 12(1) of Directive 2008/95, not only for the replacement parts themselves but also for the goods covered by that mark. It is irrelevant in that regard that the registration of that mark covers not only entire goods but also replacement parts thereof.”

52. These findings of law are binding on the Registrar. The use shown of BRISTOL, BRISTOL CARS, and the Bristol badge mark in relation to replacement parts and servicing for motor cars is, therefore, capable of constituting genuine use of the marks in relation to motor cars and parts for motor cars in class 12.

53. There is only limited specific evidence about sales of individual second hand BRISTOL cars and/or replacement parts for such cars, during or subsequent to the relevant periods. However, having regard to the accounts of Bristol Cars Limited and Bristol Cars Services Limited covering part of the relevant periods and beyond, it appears that these companies conducted a commercially significant trade in such goods. This is consistent with the information in some of the contemporaneous press releases issued on behalf of Bristol Cars Limited and filed by the applicant’s main witness, as well as other documents, including the Liquidator’s report. I therefore find that the use shown of BRISTOL, BRISTOL CARS, the Bristol badge, and the cursive script marks by these companies is, sufficient, in principle, to demonstrate genuine use of the marks for the purposes of maintaining a share of the relevant market for motor cars and parts for motor cars.

54. I will return to the issues of whether this use was with the consent of the proprietor and, if so, how to reflect the use shown in an appropriate specification of goods, after deciding whether the use shown of the marks in relation to the promotion of new motor cars also constitutes genuine use of the marks for the purpose of creating or maintaining a share of the relevant market.

55. There is no evidence of actual sales of new motor cars bearing the contested marks within, or subsequent to, the relevant periods. This part of the proprietor's case is based, essentially, on use of the marks for the purpose of creating a market for new cars through advertising and promotional activities. As recorded in the summary of the case law cited above "*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.*" The applicant submits that there never were any production cars in existence that were "*about to be marketed*" under the contested marks. I was reminded of my decision in the *Allard* revocation case,²¹ which also concerned a heritage motor car brand. As in this case, there was no evidence of actual sales of new cars under the mark during, or subsequent to, the relevant period. Instead, the proprietor relied on promotional activities intended to revive interest in the brand and press releases said to constitute advertising forthcoming motor cars bearing the mark. I held that this did not constitute genuine use of the Allard mark because:

- (i) There were no cars in existence which were 'about to be marketed';
- (ii) On the proprietor's own evidence, it was likely to take at least 6 months to develop a prototype vehicle, let alone offer cars for general sale to the (admittedly niche) public;
- (iii) Although all but the last press release talked about the company "*taking orders*" the specification for the vehicle was not described in any real detail so no one could register a serious interest in buying one, and no one did;

²¹ BL O/214/14

- iv) No one bought a car after the date of the application for revocation either which, if it had happened, might have shown that the earlier use was really advertising goods under the mark and not just market testing.

56. This case followed an earlier revocation case called *Healey Sports Cars Switzerland Limited v Jensen Cars Limited*,²² in which in similar circumstances I revoked a series of Jensen marks for non-use. That decision was the subject of appeal to the High Court.²³ Mr Henry Carr Q.C., then sitting as a Deputy Judge of the High Court, rejected the appeal. On the key issue of whether the use shown qualified as genuine use of the marks for advertising motor cars, Mr Carr stated that:

“26. I agree with the Hearing Officer that the question of whether goods are “about to be marketed” is to be decided in the context of the economic sector concerned, and that some goods will take longer to develop than others. I also agree that the press release and website, which were published a few days before expiry of the five year period and enabled no more than initial interest in a future development to be registered, did not show that the goods were about to be marketed.”

57. It is worth looking more closely at what I had said which prompted Mr Carr to agree that *“whether goods are “about to be marketed” is to be decided in the context of the economic sector concerned.”* This can be gleaned from paragraph 20 of the appeal judgment, which is re-produced below:

“20. The Hearing Officer considered the effect of these uses at paragraph 34 of the First Decision. He stated that “If the requirement is for the use of the marks to be in relation to goods ‘already marketed or about to be marketed’ then the use on the website and in the press release in relation to

²² BL O/488/12

²³ [2014] EWHC 24 (Pat)

a car that did not exist at the time, and was at least a year away from being ‘unveiled’ does not appear to qualify”. He then considered that this might be taking too literal a view of what the CJEU meant by the words ‘about to be marketed’ in the Ansul case. He gave an example of a new aeroplane, which might take many years to develop. He considered that use within a five year period of a trade mark registered for such goods that resulted in provisional orders might well count as genuine use of the mark within the period. That was because such use would probably be viewed as “warranted in the economic sector concerned to maintain or create a share in the market for the goods” even though no-one saw an actual plane carrying the mark for another year or more. He pointed out, however, that two things distinguished that example from the present case. First, neither the press release nor the website provided sufficient information about the specification for the new car to permit potential customers to decide whether to register a serious interest in buying one. Secondly, there was no evidence, despite the passage of time, of anyone expressing any interest in purchasing the new car, as a result of the press release, the website or otherwise.”

58. In my view, the facts in this case can be distinguished from those in the *Jensen* and *Allard* cases on the basis that, in this case:

- (i) There is evidence that a prototype car was developed;
- (ii) Although Mr Wharton disputes that the car shown to him in May 2016 (just after the end of the relevant period in 2 of the 3 applications still under consideration) was a working car, his evidence is that he was shown a prototype and subsequently provided with an order form;
- (iii) Completing the order form and paying £20k would have secured him a ‘build slot’ for a Bristol Bullet;
- (iv) He had therefore shown some interest in purchasing a Bristol Bullet as a result of the promotional activities of Bristol Cars Limited;

- (v) By July 2016 at the latest, a specification for the Bristol Bullet had been published which had sufficient information about the vehicle to enable others to place initial orders for the car.

59. I consider that the facts in this case are closer to the scenario I described in the *Jensen* case, i.e. of an aircraft that was still in development, but for which plans were sufficiently advanced and concrete to enable provisional orders to be taken. I find that use of the contested marks to secure such provisional orders for motor cars constitutes use of the marks in relation to goods which were about to be marketed. In any event, it constitutes genuine use of the marks because it meets the overarching requirement that it would have been viewed as “*warranted in the economic sector concerned to maintain or create a share in the market for the goods.*” It is true that there is no evidence that provisional orders were placed for the car, or that any cars were subsequently manufactured and sold. This is probably because the Kamkorp group started to run into financial difficulty before the new car could be completed and launched. However, although that is a relevant factor, it does not mean that the use shown of the contested marks during 2015 and 2016 was not genuine use for the purpose of creating a market for the vehicle in development. In my view, the evidence indicates that it was a genuine and serious attempt to create a market under the marks. It was not just an attempt to preserve the trade mark registrations, or to maintain interest in the brand in support of tentative plans for a new product to be marketed at some unknown point in the future. It is true that much of the crucial use occurred in mid-2016, just after the end of the relevant period in 2 of the 3 applications still under consideration. However, this sheds light on the nature of the use that occurred during 2015 and shows that it was part of a genuine and serious attempt to create a market under the contested marks. Further, even if the use of the marks in mid-2016 is all that counts as genuine use, such use is, in my view, sufficient to save the related registrations having regard to section 46(3) of the Act. This is because although it occurred after the end of the relevant period, it occurred prior to the applications for revocation, and before the proprietor could have known that these applications would be filed.

Consent

60. Mr Siddiqui gave evidence in his first witness statement that:

“5. The various companies within the Group provided specific goods and services. The main purpose of the Company was to hold the intellectual property including the copyright and trade mark rights. The Company licensed the business intellectual property to Bristol Automotive Group which set up two new subsidiaries: Bristol Cars Limited and Bristol Cars Services Limited. The license was non-exclusive which gave the Company the ability to license the business intellectual property to other entities as well. There is common directorship and common ultimate persons with significant control (PSC) between all the legal entities. Such rights were licensed to the other companies within the Group and for use by third parties to manufacture and sell parts, accessories and merchandising. Now shown at Exhibit SKS 1 are documents from Companies House which show the PSC of the Company, Bristol Automotive Group Limited, Bristol Cars Limited and Bristol Cars Services Limited. Shown at exhibit SKS 2 is a copy of the licensing agreement between the Company and Bristol Automotive Group Limited dated June 2012. This enabled the intellectual property rights held by the Company to be exploited by the companies within the Bristol Automotive Group Limited. Also shown at Exhibit SKS 3 is an excerpt of a copy of a licence between Bristol Cars Limited and [REDACTED FROM ORIGINAL STATEMENT]. Therefore, the Company granted not only intragroup intellectual property licences but also licences to third parties for exploitation of the Trade Marks.”

61. As I noted above, the applicant made an application for leave to cross examine Mr Siddiqui on his evidence. It asserted *“that one of the matters which needs to be decided is the extent to which any alleged use of the marks was with the Proprietor’s consent.”*

62. Although the applicant decided to withdraw the request to cross examine Mr Siddiqui, Mr Edenborough launched a detailed attack at the hearing on the sufficiency

of his evidence that the use of the contested marks shown in the evidence occurred with the proprietor's consent. The main points in relation to the class 12 goods were:

(i) Although Mr Siddiqui states at paragraph 3 of his first statement that "*The Company has been using the Trade Marks since 2011*", in view of paragraph 5 of that statement (re-produced above), his evidence must be understood to mean that the proprietor itself made no use of the marks;

(ii) The copy of the non-exclusive licence in favour of Bristol Automotive Group dated June 2012 in evidence appears to be a draft, is not signed, and is therefore of no effect;

(iii) In any event, clause 2.3 of the draft licence precluded sub-licensing to third parties without the written approval of the licensor, and there is no evidence that the proprietor gave such approval for sub-licences in favour of Bristol Automotive Group's subsidiaries, Bristol Cars Limited and Bristol Cars Services Limited (the apparent users of the marks);

(iii) Although consent can be given without a formal licence, Mr Siddiqui's evidence does not explain how else consent was given to Bristol Cars Limited and Bristol Cars Services Limited to use of the contested marks.

63. Mr Bragiel submitted that the evidence provided by Mr Wharton indicated that the proprietor used the marks itself for the first 8 – 12 months after acquiring the intellectual property during 2011. In this connection, he drew my attention to the proprietor's account for 2011/2012 exhibited to Mr Wharton's statement.²⁴ These indicate that the company had a turnover of around £90k in 2011/2012, held around £650k in stock in 2011, but none by June 2012, and that at some point prior to that date it transferred its tangible fixed assets to Bristol Automotive Group Limited.

64. Mr Bragiel further submitted that the evidence as a whole showed that Bristol Cars Limited and Bristol Cars Services Limited used the contested marks with the

²⁴ See exhibit 12 to Wharton

proprietor's consent and that the deficiencies in the licensing documentation were not such as to undermine this common sense conclusion.

65. Although there is some evidence suggesting that the proprietor himself ran the sales and servicing business for a short period in 2011/12, this is not what Mr Siddiqui says in his statement. Further, there is very little evidence showing what business was conducted during this time and under which marks. Therefore, I find that the evidence of business conducted by the proprietor himself does not demonstrate genuine use of the contested marks during the relevant periods.

66. I accept the deficiencies in the licensing documents identified by Mr Edenborough preclude me from finding that Bristol Cars Limited and Bristol Cars Services Limited used the contested marks under the terms of a formal licence granted by the proprietor. However, I accept Mr Bragiel's submission that the use shown of the contested marks by these companies in relation to sales of second hand cars, servicing such vehicles and providing replacement parts, as well as the use shown in relation to a new vehicle, was use with the consent of the proprietor. My reasons are:

(i) The use shown of the contested marks was either with, or without, the consent of the proprietor;

(ii) The companies concerned were members of the same group of companies as the proprietor and it is inherently more likely that the proprietor knew about and consented to their use than that these companies were infringing the proprietor's rights in the marks;

(iii) This is consistent with Mr Siddiqui's evidence that the proprietor was the company which held the group's IP rights;

(iv) The relative paucity of evidence from Mr Siddiqui about the terms of consent can partly be explained by the fact that the evidence filed by the applicant's witnesses appeared to accept (or at least not to challenge) the evidence in Mr Siddiqui's first statement that companies within the Kamkorp group used the contested trade marks with the proprietor's consent (why else would Mr Gallafent think it relevant to file the accounts of Bristol Cars Limited and Bristol

Cars Services Limited, and why would Mr Wharton recount in detail his interactions with Bristol Cars Limited?);

(v) By failing to challenge Mr Siddiqui's evidence on this matter until asking to cross examine him about it on 26th July 2021, and then withdrawing that request just before the hearing, the applicant has placed itself in a weak position to complain that his previously unchallenged evidence is insufficient.

Outcome - class 12 goods

67. I find that BRISTOL, BRISTOL CARS, the Bristol badge and cursive script marks were put to genuine use within the relevant periods, with the consent of the proprietor, in relation to (second hand) motor cars, and the first three of these marks were also put to genuine use in relation to replacement parts for motor cars in class 12. This is sufficient to defeat the applications to revoke the trade marks registered under TM2424875, TM2624873 and TM1206663 in relation to these goods for non-use.

68. I further find that BRISTOL, BRISTOL CARS, the Bristol badge and cursive script marks were put to genuine use within the relevant periods and/or prior to the date of the applications, with the consent of the proprietor, in relation to (new) motor cars in class 12. This is also sufficient to defeat the applications to revoke the trade marks registered in relation to these goods under TM2424875, TM2624873 and TM1206663 for non-use.

An appropriate specification in class 12

69. Mr Bragiel drew my attention to the parts of the CJEU's judgment in *Ferrari* about how to decide on an appropriate retained specification of goods/services where genuine use is shown for some of the registered goods/services, but not others. The court set out its case law in paragraphs 36 to 38 of its judgment, as follows:

"36. ..according to Article 13 of Directive 2008/95, where grounds for revocation, such as those provided for in Article 12(1) of that directive, exist in respect of only some of the goods or services for which that trade mark has

been applied for or registered, revocation is to cover those goods or services only.

37. With regard to the concept of ‘some of the goods or services’ referred to in Article 13 of Directive 2008/95, it should be noted that a consumer who wishes to purchase a product or service in a category of goods or services that has been defined particularly precisely and narrowly, but within which it is not possible to make any significant sub-divisions, will associate all the goods or services belonging to that category with a mark registered in respect of that category of goods or services, such that that trade mark will fulfil its essential function of guaranteeing the origin of those goods or services. Accordingly, it is sufficient to require the proprietor of such a mark to adduce proof of genuine use of his trade mark in relation to some of the goods or services in that homogeneous category (see, by analogy, judgment of 16 July 2020, ACTC v EUIPO, C-714/18 P, EU:C:2020:573, paragraph 42).

38. On the other hand, with regard to goods or services in a broad category of goods, which may be sub-divided into several independent subcategories, it is necessary to require the proprietor of a mark registered in respect of that category of goods or services to adduce proof of genuine use of his mark for each of those independent subcategories, failing which he will be liable to forfeit his rights to the trade mark in respect of those independent subcategories for which he has not adduced such proof (see, by analogy, judgment of 16 July 2020, ACTC v EUIPO, C-714/18 P, EU:C:2020:573, paragraph 43).”

70. The applicant accepts that this is the law. However, it takes issue with the CJEU’s subsequent application of the law to the facts in the *Ferrari* case, specifically the CJEU’s finding that *sports cars* do not constitute an independent sub-category of motor cars. The relevant part of the CJEU’s judgment is set out below.

“46. Secondly, it is true that cars referred to as ‘sports cars’ are high-performance cars and therefore are capable of being used in motor sports. However, this is only one of the possible intended uses for such cars, which are

also capable of being used, like any other car, for the transport by road of people and their personal effects.

47. Where the goods covered by a mark have several purposes and intended uses – as is often the case – determining whether there exists a separate subcategory of goods by considering in isolation each of the purposes that those goods may have will not be possible, since such an approach does not enable independent subcategories to be identified coherently and has the effect of limiting excessively the rights of the proprietor of the mark (see, by analogy, judgment of 16 July 2020, ACTC v EUIPO, C–714/18 P, EU:C:2020:573, paragraph 51).

48. It follows that the mere fact that the cars in respect of which a mark has been used are referred to as ‘sports cars’ is not sufficient to consider that they belong to an independent subcategory of cars.”

71. Mr Edenborough submitted that this was a finding of fact which did not bind the tribunal. I accept this submission, although the judgment of the CJEU on this matter is clearly of persuasive value. Mr Edenborough submitted that the CJEU was wrong. He argued that, at least in the UK, consumers and traders recognise sports cars as a distinct sub-category of motor cars. He pointed out that TM2643558 is registered for, inter alia, *sports cars*.

72. I have some sympathy with this submission. I think it likely that most consumers would identify the term with a particular kind of motor car, typically an open top, high performance two seater. Having regard to the requirement for legal certainty, the difficulty arises when it comes identifying the boundaries of the description. Is a hard top two seater a sports car? What about a 2 + 2? Or a high performance four seater? Or an open top two seater with only average performance characteristics? In my view, there is sufficient room for doubt as to the precise meaning of the description *sports cars* to justify a finding that it is not a readily identifiable sub-category of motor cars. Therefore, if it had mattered, I would probably have come to the same conclusion as the CJEU (albeit for different reasons). Fortunately, I find I do not have to decide the point. This is because the evidence of sales of second hand BRISTOL

cars goes beyond open top two seaters and extends to cars that many would describe as grand tourers. The boundaries of that description are no easier to define than *sports cars*. I therefore consider that an average consumer would regard the use shown as relating simply to the category *motor cars and parts and fittings therefor*. Consequently, TM2424875, TM2624873 and TM1206663 should remain registered in relation to these goods. There is no evidence of genuine use of the marks in relation to any other categories of land vehicles, so the applications for revocation succeeds in narrowing the scope of these registrations to *motor cars and parts and fittings therefor*.

73. As the proprietor has been unable to show any genuine use of the Pegasus and shield mark - TM2643558 – in relation to goods in class 12, it follows that the registration of this mark must be revoked in that class.

Use of the Pegasus and shield device (TM2643558) in relation to goods/services in classes 3, 6, 9, 14, 18, 21, 22, 24, 25, 28 & 35

74. The goods and services for which the Pegasus and shield mark is registered (other than class 12) are shown in Annex A below.

75. In his first statement, Mr Siddiqui gives evidence that:

“Although the core purpose of the business was to sell cars, as is the case with all luxury car manufacturers, the Group also advertised lifestyle merchandising including clothing and other accessories produced under licences granted by the Company. Now shown at Exhibit SKS 8 are samples of use of some of the Trade Marks for the following goods and services during the relevant period on merchandising found on the website www.bristolcars.co.uk as well as third party websites:

Badges – Class 6

USB Sticks – Class 9

Vehicles – Class 12

Key rings, tie-pins, cuff-links – Class 14

Manuals – Class 16

Leather bags, backpacks, wallets – Class 18

Mugs – Class 21

T-Shirts – Class 25

Model Cars – Class 28

Advertising, online retail services – Class 35

Mr Siddiqui states that the Pegasus and shield mark was one of the marks used in relation to such merchandise.

76. There are a number of deficiencies in this evidence, the most obvious ones being:

(i) The only instance of use of anything approaching the registered Pegasus and shield mark is in the historical webpages at SKS 8 which include a page from the bristolcars.co.uk website dated 26th January 2016 showing a Pegasus and shield figure as an attachment to a key ring;²⁵

(ii) The shield element of this figure bears no relation to the shield in the registered mark, which clearly alters the distinctive character of this sign and therefore prevents the use qualifying as use of the registered mark under section 46(2) of the Act.

77. Further, although Mr Siddiqui claims that a third party was licensed to sell merchandise products bearing the contested marks, the non-exclusive licence he exhibits:²⁶

(i) Shows the licensor as Bristol Cars Limited, not the registered proprietor;

²⁵ See page 89 of the evidence

²⁶ As SKS 3

- (ii) Has the name of the licensee redacted;
- (iii) Is unsigned;
- (iv) Only covered bags and wallets;
- (v) Was to be for two years ending 31st December 2015.

The last point means that even if the licence was executed and effective, none of the use shown on the five historical webpages included as exhibit SKS 8 would have been covered by the licence.

78. Mr Siddiqui says that the applicant is in no position to dispute that it sold merchandise under the contested marks because:

“... the Managing Director of the Applicant, Mr Jason Wharton, himself has purchased merchandising from the Bristol Cars website www.bristolcars.co.uk on several occasions. Shown at SKS 10 are copies of invoices which also include a copy for the receipt of a mug with the [Bristol badge] device mark purchased by Mr Jason Wharton dated 15 October 2018.”

79. Having examined exhibit SKS 10, I note that:

- (i) None of the three invoices/transaction documents dated in 2017 and 2018 in that exhibit indicate that any of the three products sold to Mr Wharton carried the Pegasus and shield mark;
- (ii) The documents show the sale of a *“Bristol Cars Tan Leather Keyring”*, a *“Bristol Cars – Black LED torch”* and a *“Mug branded with the Historic Bristol Scroll”*.

80. I conclude that none of this information precludes the applicant from contesting whether the Pegasus and shield device mark was put to genuine use during the relevant periods. Moreover, the proprietor’s apparent ability to identify individual sales of merchandise makes it all the more striking that it has not been able to provide a single example of sales of merchandise marketed under the Pegasus and

shield device mark. As Mr Daniel Alexander Q.C., as the Appointed Person, pointed out in *Awareness Limited v Plymouth City Council*:²⁷

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

81. I find the evidence of use of the Pegasus and shield device mark insufficiently solid to establish genuine use of that mark during the relevant periods. The application to revoke TM2643558 in relation to goods/services in classes 3, 6, 9, 14, 18, 21, 22, 24, 25, 28 & 35 therefore also succeeds.

Overall outcome

82. The trade marks registered in class 12 under TM2424875 and TM1206663 shall be revoked with effect from 15th April 2016, except in relation to *motor cars and parts and fittings therefor*.

83. The trade marks registered in class 12 under TM2624873 shall be revoked with effect from 24th May 2019, except in relation to *motor cars and parts and fittings therefor*.

²⁷ Case BL O/236/13

84. The trade mark registered under TM2643558 in class 3, 6, 9, 12, 14, 18, 21, 22, 24, 25, 28 & 35 shall be revoked in its entirety with effect from 9th March 2018

85. The trade mark registered in classes 9 and 12 under TM2316295 shall be revoked in its entirety with effect from 15th April 2016.

Costs

86. Both parties have achieved a roughly equal measure of success and failure. I therefore direct the parties to bear their own costs.

Dated 21st October 2021

Allan James
For the Registrar

Annex A

Class 3

Soaps; perfumery; essential oils; cosmetics; hair lotions; toiletries; hair conditioners; hair shampoos; depilatories; artificial eyelashes and nails; bleach; bleaching agents; hair colourants; fragrances for automobiles; temporary tattoos for cosmetic purposes.

Class 6

Common metals and their alloys; metal building materials; transportable buildings of metal; non-electric cables and wires of common metal; ironmongery; small items of metal hardware; badges of metal for vehicles; model cars [ornaments]; locks; keys; key rings; key fobs made of common metal; pins of metal for wheels; safes; pipes and tubes of metal; goods of common metal not included in other classes; ores; parts and fittings for all the aforesaid goods.

Class 9

Apparatus for recording, transmission or reproduction of sound, vision, or images; recording discs; DVDs; videos; MP3s; MP4s; CDs; audio and/or visual tapes; cassettes; audio cassette decks for automobiles; discs; records; cases for music, audio and related electronic equipment, namely, cases for audio tuners, audio receivers, amplifiers, tape players, compact disc players, MP3 controllers/players, audio mixers, audio speakers in the nature of music studio monitors, microphones, audio speakers, compact discs, audio tapes, portable computers, antennas, phonographic record players, audio recording equipment and the cables associated with all of the foregoing equipment; digital music (downloadable from the Internet); podcasts; film, sound and video recordings; downloadable electronic publications; sound and video recordings and publications in electronic form supplied on-line, from databases or from facilities provided on the internet; cinematographic, photographic, teaching and optical apparatus and instruments; electronic telephones; domestic telephones; telephone ring tones (downloadable); bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; mobile telephones; magnetic discs; magnetic data media; magnetic data carriers;

databases; sunglasses; frames for sunglasses; straps for sunglasses; spectacles; spectacle frames; eyeglasses; frames for eyeglasses; cases adapted for sunglasses, spectacles, eyeglasses, lenses; carrying cases for electronic equipment; computers; mobile computers; portable electronic devices; cameras; photographic equipment, apparatus and instruments; fire extinguishing apparatus for automobiles; parts and fittings for all the aforesaid goods.

Class 14

Jewellery; articles of imitation jewellery; watches; bracelets; brooches; ear ornaments in the nature of jewellery; jewellery cases; rings [jewellery]; cuff-links; tie-pins; lapel badges; precious stones; badges of precious metals; key rings; fobs; ornamental pins.

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; articles of luggage; purses; attache cases; backpacks; baby carriers; briefcases; handbags; sports bags; gym bags; leather bags; beach bags; bags for clothing; casual bags; clutch bags; cosmetic bags; credit card holders; holdalls; hip bags; pouches; rucksacks; satchels; school bags; shoulder bags; shopping bags; shoe bags; sling bags; suitcases; toiletry bags; tote bags; trunks and travelling bags; belts; key cases; key fobs; billfolds; card cases; wallets; beauty cases; umbrellas; parasols; parts and fittings for all the aforesaid goods.

Class 21

Household or kitchen utensils and containers; glasses; mugs; drinking cups; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.

Class 22

Covers [not shaped] for motor cars; ropes; string; nets; tents; awnings; tarpaulins; sails; sacks for transporting bulk materials.

Class 24

Textiles and textile goods; bed and table covers; travellers' rugs; textiles for making articles of clothing; towels; bath towels; beach towels; face towels; tea towels; golf towels; bed sheets; bed covers; bedspreads; covers for cushions, duvets and pillows; textile covers (loose) for furniture.

Class 25

Clothing; footwear; headgear.

Class 28

Games, toys and playthings; model cars and scale model cars; kits of parts for making toy model cars; gymnastic and sporting articles; balls for sport; teddy bears; playing balls; balloons; gymnastic and body training apparatus; bags adapted to carry sports implements; body building apparatus; gloves for games; hand held computer games; playing cards; decorations for Christmas trees; toy cars; model cars; trading cards (card games).

Class 35

Advertising; business management; business administration; office functions; advertising and marketing services; promotion services; market surveys; analysis of advertising response and market research; arranging of demonstrations for advertising, business and trade purposes; shop retail services, on-line retail services and electronic shopping services all connected with soaps, perfumery, essential oils, cosmetics, hair lotions, toiletries, hair conditioners, hair shampoos, depilatories, artificial eyelashes and nails, bleach, bleaching agents, hair colourants, fragrances for automobiles, temporary tattoos for cosmetic purposes, common metals and their alloys, metal building materials, transportable buildings of metal, non-electric cables and wires of common metal, ironmongery, small items of metal hardware, badges of metal for vehicles, model cars [ornaments], locks, keys, key rings, key fobs made of common metal, pins of metal for wheels, safes, pipes and tubes of metal, ores, apparatus for recording, transmission or reproduction of sound, vision, or images,

recording discs, DVDs, videos, MP3s, MP4s, CDs, audio and/or visual tapes, cassettes, audio cassette decks for automobiles discs, records, cases for music, audio and related electronic equipment, namely, cases for audio tuners, audio receivers, amplifiers, tape players, compact disc players, MP3 controllers/players, audio mixers, audio speakers in the nature of music studio monitors, microphones, audio speakers, compact discs, audio tapes, portable computers, antennas, phonographic record players, audio recording equipment, and the cables associated with all of the foregoing equipment, digital music (downloadable from the Internet), podcasts, film, sound and video recordings, downloadable electronic publications, sound and video recordings and publications in electronic form supplied on-line, from databases or from facilities provided on the internet, cinematographic, photographic, teaching and optical apparatus and instruments, electronic telephones, domestic telephones, telephone ring tones (downloadable), bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories, mobile telephones, magnetic discs, magnetic data media, magnetic data carriers, databases, sunglasses, frames for sunglasses, straps for sunglasses, spectacles, spectacle frames, eyeglasses, frames for eyeglasses, cases adapted for sunglasses, spectacles, eyeglasses, lenses, carrying cases for electronic equipment, computers, mobile computers, portable electronic devices, cameras, photographic equipment, apparatus and instruments, fire extinguishing apparatus for automobiles, jewellery, articles of imitation jewellery, watches, bracelets, brooches, ear ornaments in the nature of jewellery, jewellery cases, rings [jewellery], cuff-links, tie-pins, lapel badges, precious stones, badges of precious metals, key rings, fobs, ornamental pins, vehicles, apparatus for locomotion by land, air or water, wheelchairs, motors and engines for land vehicles, electric cars, electric motors for motor cars, racing cars, racing motor cars, sports cars, vehicle body parts and transmissions, automobiles and structural parts thereof, wheels and tyres for and wheel rims of automobiles, covers (shaped-) for motor cars, car seat covers (shaped or fitted), sun blinds adapted for automobiles, leather and imitations of leather, articles of luggage, purses, attache cases, backpacks, baby carriers, briefcases, handbags, sports bags, gym bags, leather bags, beach bags, bags for clothing, casual bags, clutch bags, cosmetic bags, credit card holders, holdalls, hip bags, pannier bags, pouches, rucksacks, satchels, school bags, shoulder bags, shopping bags, shoe bags, sling bags, suitcases, toiletry bags, tote

bags, trunks and travelling bags, belts, key cases, keyfobs, billfolds, card cases, wallets, beauty cases, umbrellas, parasols, household or kitchen utensils and containers, glasses, mugs, drinking cups, combs and sponges, brushes, brush-making materials, articles for cleaning purposes, steel wool, electric and non-electric toothbrushes, covers [not shaped] for motor cars, ropes, string, nets, tents, awnings, tarpaulins, sails, sacks for transporting bulk materials, textiles, bed and table covers, travellers' rugs, textiles for making articles of clothing, towels, bath towels, beach towels, face towels, tea towels, golf towels, bed sheets, bed covers, bedspreads, covers for cushions, duvets and pillows, textile covers (loose) for furniture, clothing, footwear, headgear, games, toys and playthings, model cars and scale model cars, kits of parts for making toy model cars, gymnastic and sporting articles, balls for sport, teddy bears, playing balls, balloons, gymnastic and body training apparatus, bags adapted to carry sports implements, body building apparatus, gloves for games, hand held computer games, playing cards, decorations for Christmas trees, toy cars, model cars and trading cards.