

O/896/21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003443350

BY HORSEGUARDS LONDON DRY GIN LIMITED

FOR THE FOLLOWING TRADE MARK:

INNOVATUS

IN CLASSES 16, 32, 33, 35 AND 42

AND

AN APPLICATION FOR REVOCATION

UNDER NO. 503306

BY RICHARD ARTHUR CHIVERTON

BACKGROUND AND PLEADINGS

1. The trade mark shown on the cover page of this decision (“the Contested Mark”) stands registered in the name of Horseguards London Dry Gin Limited (“the proprietor”). The application for the Contested Mark was filed on 17 July 2014 and registered on 26 June 2015. The Contested Mark stands registered for the following goods and services:

- Class 16 Paper, cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
- Class 32 Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.
- Class 33 Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.
- Class 35 Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services and online retail services connected with the sale of household heating appliances, household audio visual equipment, computing equipment, telephony equipment, kitchen appliances and utensils, cabling, boiler equipment, washing machines, dish washers.

Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services.

2. On 24 August 2020, Richard Arthur Chiverton (“the applicant”) sought revocation of the Contested Mark on the grounds of non-use. Under section 46(1)(a) the applicant claims non-use in the five-year period following the date on which the mark was registered, i.e. 27 June 2015- 26 June 2020. The applicant requests an effective date of revocation of 27 June 2020.

3. Under section 46(1)(b) the applicant claims non-use in respect of the Contested Mark for two periods: between 12 August 2015 to 11 August 2020 claiming an effective date of revocation of 12 August 2020 and between 24 August 2015 to 23 August 2020 claiming an effective date of revocation of 24 August 2020.

4. The proprietor filed a counterstatement defending its registration for all the goods and services for which the Contested Mark is registered.

5. The applicant is represented by London IP Limited and the proprietor is represented by Fieldfisher LLP. Both the applicant and proprietor filed evidence in chief. Neither party requested a hearing, but the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

6. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE AND SUBMISSIONS

7. The proprietor's evidence consists of the witness statement of Mr Simon Rendell, which is dated 9 June 2021. Mr Rendell is the Director of the proprietor. Mr Rendell's statement was accompanied by 9 exhibits (exhibit A and exhibits 1-8).

8. The applicant's evidence consists of the witness statement of Ms Francesca Ifechukwunyem Maria Nwaegbe, which is dated 18 August 2021. Ms Nwaegbe is the Head of Trade Marks at London IP Limited, the appointed representative of the applicant. Ms Nwaegbe's statement was accompanied by 2 exhibits (FIMN1-2).

9. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to it where necessary below.

DECISION

10. 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”.

11. 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.”

12. 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 I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken 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].”

Form of the mark

13. 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 (my emphasis):

“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)". (emphasis added)

14. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

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

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

15. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as required. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

16. Where the opponent's mark has been used as registered this will, clearly, be use upon which the opponent can rely. As the mark filed is a word mark, it may also be used in a range of standard fonts and colours, as well as in upper or lower case.

17. The opponent has used its mark in the following variants for its class 33 spirit and liquor goods:

a) INNOVATUS
DRINKS™

b) 

c) 

18. Example a) is the earlier mark as registered, in a slightly stylised black font, combined with the additional word 'DRINKS', with the letters TM in a smaller font besides the top of the letter S. I do not consider the additional text to alter its distinctive character as per *Nirvana* because the word 'DRINKS' is descriptive of the proprietor's goods, and TM indicates that the mark is intended to function as a trade mark. I note that example b) and c) are of the same mark, but in a slightly stylised white font so it can be presented against coloured or picture backgrounds. As with example a), I do not consider use in this manner to alter the distinctive character of the mark. Consequently, these examples are use upon which the proprietor can rely.

Section 46(1)(b)

19. The relevant period within which use of the mark has been challenged under section 46(1)(b) are the five year periods of 12 August 2015 to 11 August 2020 and 24 August 2015 to 23 August 2020.

20. I am mindful that the applicant is relying upon two different section 46(1)(b) periods (which it is entitled to do so). However, I note that there is only a 12 day difference between them. Consequently, with the majority of the two periods significantly overlapping, meaning that the majority of the same evidence will apply to both, I will deal with both periods as a collective.

21. I note that from the evidence provided by Mr Rendell that the trade mark INNOVATUS was acquired by the proprietor from the original owners London IP Exchange Limited (the assignor). Exhibit 1 contains the assignment agreement between the proprietor and the assignor of the INNOVATUS mark. Despite there being a handwritten date of 27 March 2019 at the top of this document, the agreement specifically states that "this agreement is made the 27th March 2017". Whilst there is this discrepancy, nothing turns on this point because they are both within the relevant periods.

22. The proprietor incorporated Innovatus Drinks Limited at Companies House on 6 March 2019. The official documentation is contained within exhibit 2. I note that Mr

Rendell provides evidence that Innovatus Drinks Limited is a subsidiary of the proprietor.

23. Exhibit 3 consists of internal emails, which contain the subject line 'Innovatus website is live'. I note that the only other reference to Innovatus, bar from the subject line, is in an email dated 15 March 2019 which asks to "also change Tm to the r next to Innovatus". These emails are all dated between the 15 March and 19 March 2019. Alongside exhibit 3, Mr Rendell provides supporting evidence that the domain innovatusdrinks.com was launched on the 15 March 2019. However, I note that I have not been provided any exhibits or screenshots of the website to demonstrate use of the INNOVATUS mark on the proprietor's goods and services.

24. Exhibit 4 consists of an investment memorandum dated the 29 March 2019. It states that Innovatus Drinks Limited entered into an agreement with Growthdeck Limited in order to raise capital for the business and obtain investment opportunities. From what I understand, an investment memorandum is a legal document which highlights the risks of investing in a business. Therefore, the proprietor's investment memorandum includes an introduction to the brand, its sub brands and its team, its growth strategy, a background in the spirits market, financial information including projected profit and loss, a cashflow forecast, historic profit and loss figures, investment terms, target returns and use of funds.

25. The majority of this document provides predictions of sales under the brand INNOVATUS and its 6 spirit/liquor sub-brands with the help of investment. I note that at the time this document was created, only their Horse Guards gin was for sale, with the brands Cuban Smoke being planned for release in 2019, and Blue Whiskey and Black Ricer being planned for release in 2020.

26. Although, as noted above, the majority of the investment memorandum provides predictions of sales and profits to be made under the INNOVATUS mark, on page 15 they highlight that they spent £55,000 on marketing costs in 2018. However, no examples of marketing has been provided before me. I also note that the following historic profit and loss figures were provided on page 16:

FYE (£)	10 months to YE 2018
Sales	37,904
Cost of Sales	(22,132)
Gross Profit	15,771
GP %	41.6%
Salaries	(61,367)
Overheads	(69,894)
Operating Expenses	(131,261)
EBITDA	(115,490)

27. The above figures are for the first 10 months of trading to 31 December 2018. I note that there is not a breakdown of the above figures as to what goods these sales pertain to. Although, I acknowledge that Horse Guards gin would have been for sale at this point.

28. There is no evidence from the proprietor as to how many copies of the investment memorandum were made and distributed to potential investors. However, regardless, this document does not show use of the INNOVATUS mark being used on the proprietor's goods and services, it only demonstrates the potential numbers which could be made with investment.

29. Exhibit 5 includes an image of the proprietor's Horse Guards gin label. On the back label it states that "Horse Guards London Dry Gin is a brand of Innovatus Limited". The proprietor provides evidence that this label appears on all of their gin products from 3 September 2020. However, this is after the relevant period.

30. Exhibit 6 consists of an image of the proprietor's Wing Walker spiced rum label. The back label states that "Wing Walker Rum is a brand of Innovatus Drinks Ltd". This screenshot is dated 18 March 2021. Again, this is after the relevant period.

31. Mr Rendell provides evidence that "the business switched all systems to the 'Innovatus' domain on the 18 September 2020". This is supported by exhibit 7. However, it does not demonstrate genuine use of the mark on the proprietor's goods and services. It also falls after the relevant period.

32. I note that the proprietor has the LinkedIn page, headed Innovatus Drinks. Mr Rendell provides evidence that this page has been live since April 2019. An undated screenshot of this page is shown in exhibit 8. I note that it describes the company as an “international drinks business”.

33. Lastly, Mr Rendell claims that the evidence filed under exhibit A are “emails and correspondence relating to the use of the INNOVATUS mark during the specified period”. The exhibit consists of a chain of correspondence between the CEO of Horse Guards gin and the employees at Buzzbar regarding the INNOVATUS website and the creation of “the designs for the house of Innovatus”.¹ It includes references to the designs for its sub-brands logos such as Blues Whiskey, Glen Regal and Cuban Smoke. It is clear that the emails and correspondence is internal use by the proprietor which is not sufficient² to demonstrate use of the INNOVATUS mark.

34. Ms Nwaegbe also submits exhibits FIMN1 and FIMN2. Both are independent investigation reports which were carried out by Cerberus IP in relation to use of the mark INNOVATUS by the proprietor, and the assignor, in the past 5 years. Both of the reports are dated 24 June 2020. Exhibit FIMN1 provides information on Horseguards London Dry Gin Limited and reiterates a lot of the above evidence which was provided by Mr Rendell. However, it does provide me with screenshots of use of the INNOVATUS mark on the proprietor’s website. I note that the website also describes the company as an “international drinks business”.

35. Exhibit FIMN2 provides information on London IP Exchange Limited, who as noted above, sold the INNOVATUS mark to the proprietor and “owns 50% shareholding of Horseguards London Dry Gin limited”. In both exhibits, it is established that the company’s logo, the stylised INNOVATUS DRINKS mark, was published online in March 2019. However, no further use of the mark was found, and no specific products or product packaging was found to feature the INNOVATUS mark. This correlates with Mr Rendell’s above evidence that the use of the mark on the proprietor’s goods

¹ Page 20, exhibit A, email dated 11 March 2019 from Nickque Patterson

² *Ansul* at 37

including its Horse Guards gin and Wing Walker rum was from 3 September 2020 and 18 March 2021.

Sufficient/genuine use

36. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

37. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

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

38. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

39. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³

40. I note that the proprietor provides the following evidence:

“The Registered Proprietor was initially formed in 2017 to be a single product spirits company. As the business grew it became clear that it would be difficult to grow the business just having one product in the gin market that was becoming saturated [...] As we were developing multi spirits and not just gin we decided to acquire a trade mark which we could use as a Topco brand (similar to other spirit companies like Diageo). We entered an agreement to acquire UK Trade Mark Registration No. UK00003443350 INNOVATUS [...] We then incorporated Innovatus Drinks Ltd [...] Innovatus Drinks Limited is a wholly owned subsidiary of the Horseguards London Dry Gin Limited”.

41. It is clear from the above, and the evidence provided, that INNOVATUS is a parent company of various drinks brands, specifically spirits, such as Horse Guards London Dry Gin and Wing Walker Rum. Therefore, none of the evidence provided shows use (if any) in respect of the goods and services protected under classes 16, 32, 35 and 42, and only limited use of its class 33 goods.

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

42. For the relevant periods, I have not been provided any evidence that the mark was actually used on the goods themselves. I also have no actual evidence of sales, for any of the proprietor's goods and services, under the INNOVATUS mark.

43. For the evidence that has been provided, I find that it demonstrates that the use of the word INNOVATUS serves the purpose of identifying the proprietor's business. The question therefore arises as to whether the established uses of INNOVATUS during the relevant period counts as trade mark use in relation to its spirits and liqueurs in class 33.

44. In *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11), Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“17. unless it is obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of “use in relation to” goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:

“...even where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.”

19. The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in what is now Article 42 of the European Union Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/091, the General Court said:

“23. In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being ‘in relation to goods or services’ (*Céline*, paragraph 21).

24. Conversely, there is use ‘in relation to goods’ where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use ‘in relation to goods or services’ within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.

45. In *Euromarket Designs Inc. v Peters* [2001] F.S.R. Jacob J. (as he then was) stated that:

“56. That is not all on the question of non-use. If one looks at the advertisements they are essentially for the shops. True it is that some of the goods mentioned in the advertisements fall within the specification, but I doubt whether the reader

would regard the use of the shop name as really being “in relation” to the goods. I think this is an issue worthy of trial in itself. The argument is that there is an insufficient nexus between “Crate & Barrel” and the goods; that only a trade mark obsessed lawyer would contend that the use of “Crate & Barrel” was in relation to the goods shown in the advertisement.

57. In this connection it should be borne in mind that the Directive does not include an all-bracing definition of “use”, still less of “use in relation to goods”. There is a list of what may *inter alia* be specified as infringement (Article 5(3), corresponding to section 10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Article 10(2), equivalent to section 46(2)). It may well be that the concept of “use in relation to goods” is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled “Boots”, only a trade mark lawyer might say that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign “in relation to” the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel United States shops to the United Kingdom in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.”

46. In *Cactus SA v OHIM*, Case T-24/13, EU:T:2015:494, the General Court held that the owner of what was then a CTM (now an EUTM) who used the mark only as the name of a shop had used the mark “in relation to” the natural plants, flowers and grains sold in the shop (as well as in relation to retail services for those goods). This is because it had demonstrated that the public would link the (otherwise unbranded) goods to the mark used for the shop and regard the user of that mark as being responsible for the quality of the goods. The court stated that:

“69 Accordingly, in view of the context of the present case, as described in paragraphs 66 to 68 above, and, in particular, the applicant’s specific

expertise in the plants and flowers sector, which it publicises, it must be considered that the documents submitted by the applicant which show the earlier marks establish to the requisite standard that there is a link between those marks and plants, flowers and seeds which bear no mark. Those documents show that the applicant offers for sale or sells those goods with the earlier marks as the only indication of a trade mark, with the result that those marks are the only signs that provide an indication of the commercial origin of the goods in question.

70 That conclusion is not affected by the consideration referred to by the Board of Appeal and OHIM that, in the light of the registration of the earlier marks in relation to retail services in Class 35, the earlier marks must be regarded as designating the applicant's stores which retail plants, flowers and seeds, not those goods themselves. Although the earlier marks are also registered to designate retail services in respect of the sale of plants, flowers and seeds, as is apparent from paragraphs 31 to 39 above, that does not mean, given the context of the present case described in paragraphs 66 to 68 above, that those same marks may not also designate plants, flowers and seeds which bear no mark and which are offered for sale in shops operated by the applicant.

71 In those circumstances, it must be concluded that the Board of Appeal erred in deciding that the applicant had not proved genuine use of the earlier marks in relation to 'natural flowers and plants, grains' in Class 31."

47. As highlighted above, Innovatus Drinks Limited is a subsidiary of the proprietor. This company name is used in their domain name and on their LinkedIn page. This name is also used throughout the proprietor's investment memorandum as their company name, with the introduction stating that "Innovatus Drinks Limited (Innovatus) has acquired a portfolio of heritage drink brands which the company is planning to revive and roll out sequentially to domestic and export markets". The document also explains that the company owns the following 5 brands: Horse Guards, Cuban Smoke, Blues Whiskey, Black River and Glen Regal. Although there is the following evidence of the mark being used, for example, on the back of its Horse Guards gin and Wing

Walker spiced rum labels, these examples appear to be dated after both of the relevant periods:

HORSE GUARDS
PREMIUM LONDON DRY GIN

Horse Guards London Dry Gin is a modern blend with its roots in a traditional recipe dating back to the 1890's.

Sophisticated, smooth, elegant and quintessentially British, this is Gin as it's meant to be: perfect for your classic G&T.

Distilled with precision and passion, our award-winning blend has a subtle citrus undertone, tangy notes of grapefruit and hints of spice - no overpowering botanical preserving its essence as your perfect cocktail base.

Charge your glass!

Distilled and bottled in London
www.horseguards.london

Horse Guards London Dry Gin is a Registered Trademark
Horse Guards London Dry Gin is a brand of Innovatus Limited
Horse Guards London Dry Gin Limited
12 Orchard Court, Heron Road, Exeter EX2 7LL, England

UK Units 1 Per 25ml	Please drink responsibly	5 060406 576207
Please recycle		



WING WALKER
PREMIUM SPICED RUM

Wing Walker is a premium spiced rum from the Caribbean coasts of Venezuela and Dominica, distilled in copper pot stills and aged in vintage oak barrels.

An exceptionally smooth and silky rum which can be enjoyed on its own. Add ice and the flavours open and the incredible character bursts into life, bringing the warmth of the Caribbean to your glass.

With subtle orange peel, vanilla and smooth caramel notes, Wing Walker soars above other rums. These flavours take off through the spirit, making Wing Walker rum a perfect cocktail base.

Wing Walker Rum is a brand of Innovatus Drinks Ltd.
www.wingwalker.com

UK Units 1 Per 25ml	Please drink responsibly
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5 060580 930093 >

Wing Walker Rum is a registered trademark
Horseguards London Dry Gin Limited
12 Orchard Court, Heron Road, Exeter EX2 7LL

WING WALKER
PREMIUM SPICED RUM

48. Therefore, taking all of the above into account, I consider that the goods will be selected on the basis of the brands which they are marketed, rather than the proprietor's company name which appears only on the back of their labels. Consequently, use cannot be viewed as being consistent with the essential function of a trade mark which acts as a guarantee of trade origin.

49. In the event I am wrong in my above finding, I do not find the evidence provided to be sufficiently solid and specific to show genuine use of the proprietor's mark. From the evidence provided, the proprietor has failed to discharge the burden placed upon it under section 100 and the case law cited above. A registered proprietor must show sufficiently solid and dated evidence, within the relevant period(s) of alleged non-use, and in this instance, it has failed to do so.

50. The relevant period within which use of the mark has been challenged under section 46(1)(a) is the five-year period following the date on which the mark was registered, i.e. 27 June 2015- 26 June 2020. Whilst the 46(1)(a) is separate to the 46(1)(b) periods, they do significantly overlap. I have reviewed all of the evidence, which has been detailed above, and I am satisfied that the mark has not been genuinely used in this period either.

CONCLUSION

51. The application for revocation on the grounds of non-use therefore succeeds under both section 46(1)(a) and 46(1)(b). The registration will be revoked in respect of all goods and services for which it is registered.

52. The effective date of revocation is 27 June 2020, the earliest date claimed.

COSTS

53. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,650** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement	£200
Preparing and filling witness statement and exhibits	£550
Considering the proprietor's evidence	£350
Filing written submissions	£350
Official Fee	£200
Total	£1,650

54. I therefore order Horseguards London Dry Gin Limited to pay Richard Arthur Chiverton the sum of £1,650. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of December 2021

L FAYTER

For the Registrar